



PATENT

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Applicant(s) : Alejandro M. Pilato
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APPEAL BRIEF UNDER 37 C.F.R. §41.37

Sir:

The Applicant respectfully submits this Appeal Brief in response to the Office Action of 3 July 2006 ("the Final Office Action") finally rejecting each of the pending claims 1-139. This Appeal Brief is in furtherance of the Notice of Appeal filed on 22 August 2006.

I. REAL PARTY IN INTEREST

The real party in interest is Traderisks, Inc., a corporation having a place of business at 9 East Loockerman Street, Dover, Delaware 19901.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

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III. STATUS OF CLAIMS

Claims 1-139 are pending in this application and have been at least twice rejected.

Claims 1-139 are the subject of this appeal.

IV. STATUS OF AMENDMENTS

A reply to non-final rejection dated 13 January 2006 was filed on 11 April 2006. That reply amended claims 1, 47-100, 112-114, and 136-139.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1

Claim 1 recites a computer-assisted method (see at least page 25, lines 1-25; FIGs. 1, 2, 3) for providing financial risk management functions by an agent (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3) for each of a plurality of institutional or corporate clients (see at least page 30, lines 7-9; page 17, lines 10-12; page 19, lines 8-13). The method comprises a plurality of activities (see at least FIG. 1), including, relating to a financial risk management function of each client (see at least page 1, lines 5-7):

demonstrating that more than one activity of the agent is transparent to the client (see at least FIG. 1, element 1010; page 11, line 4 to page 12, line 29; page 17, lines 27-28);

receiving financial information at a computer of the agent (see at least FIG. 1, element 1020; FIG. 2, element 2500; page 18, lines 3-10);

creating risk management information relating to the financial information (see at least FIG. 1, element 1040; page 19, line 29);

analyzing the risk management information in the context of the financial information (see at least FIG. 1, element 1050; page 21, line 25 through page 22, line 5);

determining an action based on the analysis (see at least FIG. 1, element 1060; page 22, lines 27-28);

facilitating implementation of the action on behalf of the client (see at least FIG. 1, element 1070; page 23, lines 19-20); and

communicating with the client (see at least FIG. 2, element 2100) through a network (see at least FIG. 2, element 2900) one or more activities of the agent (see at least FIG. 1, elements 1025, 1045, 1055, 1065, and 1075; page 25, lines 5-6).

Dependent claim 2

To independent claim 1, claim 2 adds the limitation that the financial information is received through a network (see at least FIG. 2, element 2900; page 8, line 28-page 9, line 2; page 11, lines 7-14).

Dependent claim 3

To independent claim 1, claim 3 adds the limitation that the activity of facilitating the action includes implementing the action on behalf of the client (see at least page 11, lines 7-14).

Dependent claim 4

To independent claim 1, claim 4 adds the limitation that the activity of facilitating the action includes instructing the client to implement the action (see at least page 11, lines 15-21).

Dependent claim 5

To independent claim 1, claim 5 adds the limitation that the activity of facilitating the action includes recommending that the client implement the action (see at least page 11, lines 15-21).

Dependent claim 6

To independent claim 1, claim 6 adds the limitation of notifying the client that an action will be implemented by the agent (see at least page 19, lines 8-15).

Dependent claim 7

To independent claim 1, claim 7 adds the limitation of notifying the client of the action implemented by the agent (see at least page 19, lines 8-15).

Dependent claim 8

To independent claim 1, claim 8 adds the limitation of receiving notification from the client of an action implemented by the client (see at least page 19, line 28-page 20, line 7).

Dependent claim 9

To independent claim 1, claim 9 adds the limitation that the action includes providing a notification (see at least page 19, lines 8-15).

Dependent claim 10

To independent claim 1, claim 10 adds the limitation that the action includes providing a report (see at least page 17, lines 8-15).

Dependent claim 11

To independent claim 1, claim 11 adds the limitation that the action includes providing an analysis (see at least page 19, lines 4-7).

Dependent claim 12

To independent claim 1, claim 12 adds the limitation that the action includes providing information (see at least page 17, lines 8-15; page 19, lines 4-7).

Dependent claim 13

To independent claim 1, claim 13 adds the limitation that the activity of communicating includes enabling the client to access information regarding one or more activities of the agent (see at least page 20, lines 13-28).

Dependent claim 14

To independent claim 1, claim 14 adds the limitation that the activity of communicating includes enabling the client to access information across a network regarding one or more activities of the agent (see at least page 20, lines 13-28; page 21, lines 5-18).

Dependent claim 15

To independent claim 1, claim 15 adds the limitation that the activity of communicating includes allowing the client to monitor across a network one or more activities of the agent (see at least page 11, lines 4-20; page 18, lines 1-2; page 25, lines 5-13).

Dependent claim 16

To independent claim 1, claim 16 adds the limitation that the activity of communicating includes allowing the client to monitor in real-time across a network one or more activities of the agent (see at least page 7, lines 11-19; page 11, lines 4-20; page 18, lines 1-2; page 25, lines 5-13).

Dependent claim 17

To independent claim 1, claim 17 adds the limitation that the activity of communicating includes allowing the client to monitor in near-real-time across a network one or more activities of the agent (see at least page 7, lines 11-19; page 11, lines 4-20; page 18, lines 1-2; page 25, lines 5-13).

Dependent claim 18

To independent claim 1, claim 18 adds the limitation that the activity of communicating includes reporting to the client across a network one or more activities of the agent (see at least page 20, lines 13-28; page 21, lines 5-18).

Dependent claim 19

To independent claim 1, claim 19 adds the limitation that the activity of communicating includes reporting to the client in real-time across a network one or more activities of the agent (see at least page 21, lines 5-18).

Dependent claim 20

To independent claim 1, claim 20 adds the limitation that the activity of communicating

includes reporting to the client in near-real-time across a network one or more activities of the agent (see at least page 21, lines 5-18).

Dependent claim 21

To independent claim 1, claim 21 adds the limitation of reporting one or more effects of the agent's action on the risk management information (see at least page 21, lines 5-18; page 31, lines 20-33).

Dependent claim 22

To independent claim 1, claim 22 adds the limitation of reporting one or more effects of an alternative action to the agent's action on the risk management information (see at least page 21, lines 5-18; page 31, lines 20-33).

Dependent claim 23

To independent claim 1, claim 23 adds the limitation of reporting one or more reasons behind an action determined by the agent (see at least page 20, lines 13-28).

Dependent claim 24

To independent claim 1, claim 24 adds the limitation that the activity of communicating includes informing the client of results of reviews of one or more of historical activities of the agent (see at least page 20, lines 13-28).

Dependent claim 25

To independent claim 1, claim 25 adds the limitation that the activity of communicating includes providing an audit log of one or more historical activities of the agent on behalf of the client (see at least page 20, lines 13-28).

Dependent claim 26

To independent claim 1, claim 26 adds the limitation that the activity of communicating includes seeking feedback from the client on reviews of one or more of historical activities of the

agent (see at least page 19, lines 4-7; page 20, lines 13-28).

Dependent claim 27

To independent claim 1, claim 27 adds the limitation that the agent is conflict-free (see at least page 14, lines 10-24).

Dependent claim 28

To independent claim 1, claim 28 adds the limitation of the agent receiving authority to implement the action on behalf of the client (see at least page 26, lines 15-29).

Dependent claim 29

To independent claim 1, claim 29 adds the limitation of the client agreeing to implement actions recommended by the agent (see at least page 11, lines 15-21).

Dependent claim 30

To independent claim 1, claim 30 adds the limitation of the client agreeing to implement actions instructed by the agent (see at least page 11, lines 15-21).

Dependent claim 31

To independent claim 1, claim 31 adds the limitation that facilitating the implementation of the action results in the negotiation of the terms of a trade (see at least page 19, line 28-page 20, line 7).

Dependent claim 32

To independent claim 1, claim 32 adds the limitation that the determination of the action includes an identification of a best rate or price at which the trade can be executed (see at least page 19, lines 16-24).

Dependent claim 33

To independent claim 1, claim 33 adds the limitation that the activity of determining the

action is performed automatically (see at least page 19, lines 16-24; page 21, lines 1-4).

Dependent claim 34

To independent claim 1, claim 34 adds the limitation that the implementation of the action results in execution of a trade (see at least page 19, line 28-page 20, line 7).

Dependent claim 35

To independent claim 1, claim 35 adds the limitation that the implementation of the action results in execution of a trade with a third party (see at least page 23, lines 19-page 24, line 2).

Dependent claim 36

To independent claim 1, claim 36 adds the limitation that the implementation of the action results in execution of a trade by the agent (see at least page 23, lines 19-page 24, line 2).

Dependent claim 37

To independent claim 1, claim 37 adds the limitation that the implementation of the action results in execution of a trade by the client (see at least page 23, lines 19-page 24, line 2).

Dependent claim 38

To independent claim 1, claim 38 adds the limitation that the action is implemented automatically (see at least page 25, lines 1-4).

Dependent claim 39

To independent claim 1, claim 39 adds the limitation that the financial information includes financial guidelines (see at least page 18, lines 3-10).

Dependent claim 40

To independent claim 1, claim 40 adds the limitation that the financial information includes one or more benchmarks (see at least page 18, lines 3-10).

Dependent claim 41

To independent claim 1, claim 41 adds the limitation that the financial information includes action guidelines (see at least page 18, lines 3-10).

Dependent claim 42

To independent claim 1, claim 42 adds the limitation that the financial information includes market risk limits (see at least page 18, lines 3-10).

Dependent claim 43

To independent claim 1, claim 43 adds the limitation that the financial information includes credit risk limits (see at least page 18, lines 15-19).

Dependent claim 44

To independent claim 1, claim 44 adds the limitation that the financial information includes liquidity guidelines (see at least page 18, lines 11-14).

Dependent claim 45

To independent claim 1, claim 45 adds the limitation that the financial information includes maturity guidelines (see at least page 29, line 20-page 30, line 6).

Dependent claim 46

To independent claim 1, claim 46 adds the limitation that the financial information includes credit guidelines (see at least page 18, lines 15-19).

Dependent claim 47

To independent claim 1, claim 47 adds the limitation that the financial risk management function includes short-term funding and cash management (see at least page 29, line 12-page 33, line 21).

Dependent claim 48

To independent claim 1, claim 48 adds the limitation that the financial risk management function includes cashflow management (see at least page 29, line 20-page 30, line 6).

Dependent claim 49

To independent claim 1, claim 49 adds the limitation that the financial risk management function includes liquidity management (see at least page 29, line 20-page 30, line 6).

Dependent claim 50

To independent claim 1, claim 50 adds the limitation that the financial risk management function includes cash management (see at least page 31, lines 4-10).

Dependent claim 51

To independent claim 1, claim 51 adds the limitation the financial risk management function includes investment management (see at least page 9, lines 10-22).

Dependent claim 52

To independent claim 1, claim 52 adds the limitation that the financial risk management function includes repo (repurchase agreement) funding (see at least page 32, lines 24-25).

Dependent claim 53

To independent claim 1, claim 53 adds the limitation that the financial risk management function includes debt management (see at least page 2, lines 18-20).

Dependent claim 54

To independent claim 1, claim 54 adds the limitation that the financial risk management function includes debt issuance (see at least page 32, lines 20-22).

Dependent claim 55

To independent claim 1, claim 55 adds the limitation that the financial risk management function includes asset and liability management (see at least page 2, lines 18-20).

Dependent claim 56

To independent claim 1, claim 56 adds the limitation that the financial risk management function includes asset and liability management and that the assets include insurance premia (see at least page 5, lines 14-28; and page 35, lines 21-30).

Dependent claim 57

To independent claim 1, claim 57 adds the limitation that the financial risk management function includes asset and liability management and that the liabilities include insurance claims (see at least page 5, lines 14-28; and page 35, lines 21-30).

Dependent claim 58

To independent claim 1, claim 58 adds the limitation that the financial risk management function includes asset and liability management and that the assets include life insurance premia (see at least page 5, lines 14-28; and page 35, lines 21-30).

Dependent claim 59

To independent claim 1, claim 59 adds the limitation that the financial risk management function includes asset and liability management and that the liabilities include life insurance claims (see at least page 5, lines 14-28; and page 35, lines 21-30).

Dependent claim 60

To independent claim 1, claim 60 adds the limitation that the financial risk management function includes asset and liability management and that the liabilities include pension claims (see at least page 5, lines 14-28; and page 35, lines 14-19).

Dependent claim 61

To independent claim 1, claim 61 adds the limitation that the financial risk management function includes asset and liability management and that the liabilities include legal claims (see at least page 5, lines 14-28; and page 40, lines 11-19).

Dependent claim 62

To independent claim 1, claim 62 adds the limitation that the financial risk management function includes asset and liability management that the assets include leases (see at least page 5, lines 14-28).

Dependent claim 63

To independent claim 1, claim 63 adds the limitation that the financial risk management function includes asset and liability management that the liabilities include leases (see at least page 5, lines 14-28).

Dependent claim 64

To independent claim 1, claim 64 adds the limitation that the financial risk management function includes asset and liability management that the assets include operational cashflows (see at least page 5, lines 14-28).

Dependent claim 65

To independent claim 1, claim 65 adds the limitation that the financial risk management function includes asset and liability management that the liabilities include operational cashflows (see at least page 5, lines 14-28).

Dependent claim 66

To independent claim 1, claim 66 adds the limitation that the financial risk management function includes treasury management (see at least page 2, lines 16-30).

Dependent claim 67

To independent claim 1, claim 67 adds the limitation that the financial risk management function includes credit management (see at least page 2, lines 16-30).

Dependent claim 68

To independent claim 1, claim 68 adds the limitation that the financial risk management function includes credit spread trading (see at least page 2, lines 16-30).

Dependent claim 69

To independent claim 1, claim 69 adds the limitation that the financial risk management function includes loan portfolio management (see at least page 2, lines 16-30).

Dependent claim 70

To independent claim 1, claim 70 adds the limitation that the financial risk management function includes equity portfolio management (see at least page 5, lines 14-28).

Dependent claim 71

To independent claim 1, claim 71 adds the limitation that the financial risk management function includes fixed income portfolio management (see at least page 35, lines 14-19).

Dependent claim 72

To independent claim 1, claim 72 adds the limitation that the financial risk management function includes funding (see at least page 2, lines 16-30).

Dependent claim 73

To independent claim 1, claim 73 adds the limitation that the financial risk management function includes collateral management (see at least page 2, lines 16-30).

Dependent claim 74

To independent claim 1, claim 74 adds the limitation that the financial risk management

function includes the lending of securities (see at least page 3, lines 22-24).

Dependent claim 75

To independent claim 1, claim 75 adds the limitation that the financial risk management function includes the borrowing of securities (see at least page 3, lines 22-24).

Dependent claim 76

To independent claim 1, claim 77 adds the limitation that the financial risk management function includes counterparty credit exposure management (see at least page 5, lines 14-28).

Dependent claim 78

To independent claim 1, claim 78 adds the limitation that the financial risk management function includes market risk management (see at least page 2, lines 16-30).

Dependent claim 79

To independent claim 1, claim 79 adds the limitation that the financial risk management function includes credit risk management (see at least page 2, lines 16-30).

Dependent claim 80

To independent claim 1, claim 80 adds the limitation that the financial risk management function includes commodity price risk management (see at least page 2, lines 16-30).

Dependent claim 81

To independent claim 1, claim 81 adds the limitation that the financial risk management function includes liquidity risk management (see at least page 2, lines 16-30).

Dependent claim 82

To independent claim 1, claim 82 adds the limitation that the financial risk management function includes operational risk management (see at least page 4, lines 12-16).

Dependent claim 83

To independent claim 1, claim 83 adds the limitation that the financial risk management function includes management of insurable risks (see at least page 5, lines 14-28).

Dependent claim 84

To independent claim 1, claim 84 adds the limitation that the financial risk management function includes electricity price risk management (see at least page 5, lines 14-28).

Dependent claim 85

To independent claim 1, claim 85 adds the limitation that the financial risk management function includes pension fund management (see at least page 5, lines 14-28).

Dependent claim 86

To independent claim 1, claim 86 adds the limitation that the financial risk management function includes real estate management (see at least page 5, lines 14-28).

Dependent claim 87

To independent claim 1, claim 87 adds the limitation that the financial risk management function includes hedging (see at least page 3, lines 1-8).

Dependent claim 88

To independent claim 1, claim 88 adds the limitation that the financial risk management function includes dynamic hedging (see at least page 3, lines 1-8; and page 14, lines 6-13).

Dependent claim 89

To independent claim 1, claim 89 adds the limitation that the financial risk management function includes mortgage pre-payment risk management (see at least page 34, lines 23-27).

Dependent claim 90

To independent claim 1, claim 90 adds the limitation that the financial risk management function includes front-office activities (see at least page 3, lines 1-8).

Dependent claim 91

To independent claim 1, claim 91 adds the limitation that the financial risk management function includes middle-office activities (see at least page 3, lines 1-3).

Dependent claim 92

To independent claim 1, claim 92 adds the limitation that the financial risk management function includes back-office activities (see at least page 3, lines 1-3).

Dependent claim 93

To independent claim 1, claim 93 adds the limitation that the financial risk management function includes front-office and middle-office activities (see at least page 3, lines 1-3).

Dependent claim 94

To independent claim 1, claim 94 adds the limitation that the financial risk management function includes middle-office and back-office activities (see at least page 3, lines 1-3).

Dependent claim 95

To independent claim 1, claim 95 adds the limitation that the financial risk management function includes front-office, middle-office and back-office activities (see at least page 3, lines 1-3).

Dependent claim 96

To independent claim 1, claim 96 adds the limitation that the financial information includes detailed information on financial instruments relevant to a financial risk management function (see at least page 18, lines 3-10).

Dependent claim 97

To independent claim 1, claim 97 adds the limitation that the financial information includes historical market data relevant to the financial risk management function (see at least page 10, lines 8-20).

Dependent claim 98

To independent claim 1, claim 98 adds the limitation that the financial information includes current market data relevant to the financial risk management function (see at least page 10, lines 8-20).

Dependent claim 99

To independent claim 1, claim 99 adds the limitation that the financial information includes economic information relevant to the financial risk management function (see at least page 21, line 25-page 22, line 4).

Dependent claim 100

To independent claim 1, claim 100 adds the limitation that the financial information includes information relevant to the financial risk management function (see at least page 21, line 25-page 22, line 4).

Dependent claim 101

To independent claim 1, claim 101 adds the limitation that the financial information includes strategic financial objectives (see at least page 30, lines 14-22).

Dependent claim 102

To independent claim 1, claim 102 adds the limitation that the client includes departments of the client (see at least page 30, lines 7-13).

Dependent claim 103

To independent claim 1, claim 103 adds the limitation that the client includes subsidiaries

of the client (see at least page 22, line 27-page 23, line 5).

Dependent claim 104

To independent claim 1, claim 104 adds the limitation that the client includes affiliates of the client (see at least page 22, line 27-page 23, line 5).

Dependent claim 105

To independent claim 1, claim 105 adds the limitation that the client includes clients of the client (see at least page 22, line 27-page 23, line 5).

Dependent claim 106

To independent claim 1, claim 106 adds the limitation that the client includes regulators of the client (see at least page 22, line 27-page 23, line 5).

Dependent claim 107

To independent claim 1, claim 107 adds the limitation that the client includes auditors of the client (see at least page 22, line 27-page 23, line 5).

Dependent claim 108

To independent claim 1, claim 108 adds the limitation that the client includes agents of the client (see at least page 22, line 27-page 23, line 5).

Dependent claim 109

To independent claim 1, claim 109 adds the limitation that the client includes advisors of the client (see at least page 22, line 27-page 23, line 5).

Dependent claim 109

To independent claim 1, claim 109 adds the limitation that the client includes counterparties of the client (see at least page 22, line 5-page 23, line 5).

Dependent claim 110

To independent claim 1, claim 110 adds the limitation that the client includes counterparties of the client (see at least page 1, lines 19-30).

Dependent claim 111

To independent claim 1, claim 111 adds the limitation that the client includes shareholders of the client (see at least page 1, lines 19-30).

Independent claim 112

Claim 112 recites a computer-readable medium (see at least FIG. 3, element 3300; page 28, lines 21-26) storing instructions (see at least FIG. 3, element 3400; page 28, lines 21-23) that, when executed by one or more processors (see at least FIG. 3, element 3200; page 28, lines 21-23), cause the one or more processors to perform activities (see at least page 28, lines 21-23).

Those activities comprise:

relating to a financial function (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3) of each of a plurality of institutional or corporate clients (see at least page 30, lines 7-9; page 17, lines 10-12; page 19, lines 8-13):

demonstrating that more than one activity of the agent is transparent to the client; (see at least FIG. 1, element 1010; page 11, line 4 to page 12, line 29; page 17, lines 27-28);

receiving financial information at a computer of the agent (see at least FIG. 1, element 1020; FIG. 2, element 2500; page 18, lines 3-10);

creating risk management information relating to the financial information (see at least FIG. 1, element 1040; page 19, line 29);

analyzing the risk management information in the context of the financial information (see at least FIG. 1, element 1050; page 21, line 25 through page 22, line 5);

determining an action based on the analysis (see at least FIG. 1, element 1060; page 22, lines 27-28);

facilitating implementation of the action on behalf of the client (see at least FIG. 1, element 1070; page 23, lines 19-20); and

communicating through a network (see at least FIG. 2, element 2900) with the client (see at least FIG. 2, element 2100) one or more activities of the agent (see at least FIG. 1, elements 1025, 1045, 1055, 1065, and 1075; page 25, lines 5-6).

Independent claim 113

Claim 113 recites an apparatus (see at least FIG. 2, element 2500; FIG. 3, elements 300) for providing financial functions by an agent (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3) for each of a plurality of institutional or corporate clients (see at least page 30, lines 7-9; page 17, lines 10-12; page 19, lines 8-13). The apparatus comprises:

- relating to a financial function of each client (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3):

- means for demonstrating that more than one activity of the agent is transparent to the client (see at least FIG. 1, element 1010; page 11, line 4 to page 12, line 29; page 17, lines 27-28; FIG. 2, element 2500; FIG. 3, element 300; page 25, line 27 to page 29, line 10);

- means for receiving financial information at a computer of the agent (see at least FIG. 1, element 1020; FIG. 2, element 2500; FIG. 3, element 300; page 18, lines 3-10; page 25, line 27 to page 29, line 10);

- means for creating risk management information relating to the financial information (see at least FIG. 1, element 1040; FIG. 2, element 2500; FIG. 3, element 300; page 19, line 29; page 25, line 27 to page 29, line 10);

- means for analyzing the risk management information in the context of the financial information (see at least FIG. 1, element 1050; FIG. 2, element 2500; FIG. 3, element 300; page 21, line 25 through page 22, line 5; page 25, line 27 to page 29, line 10);

- means for determining an action based on the analysis (see at least FIG. 1, element 1060; FIG. 2, element 2500; FIG. 3, element 300; page 22, lines 27-28; page 25, line 27 to page 29, line 10);

- means for facilitating implementation of the action on behalf of the client (see at least FIG. 1, element 1070; FIG. 2, element 2500; FIG. 3, element 300; page 23, lines 19-

20; page 25, line 27 to page 29, line 10); and

means for communicating to the client through a network one or more activities of the agent (see at least FIG. 1, elements 1025, 1045, 1055, 1065, and 1075; FIG. 2, elements 2100, 2500, 2900; FIG. 3, element 300; page 25, lines 1-25; page 25, line 27 to page 29, line 10).

A. Independent Claim 114

Claim 114 recites a computer-assisted method (see at least page 25, lines 1-4; FIGs. 1, 2, 3) for a client to outsource financial functions to an agent (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3) representing a plurality of institutional or corporate clients (see at least page 30, lines 7-9; page 17, lines 10-12; page 19, lines 8-13), comprising the activities of:

providing financial information on one or more financial functions of each client (see at least page 1, lines 5-7) to a computer of the agent (see at least FIG. 1, elements 1020, 1025; FIG. 2, elements 2100, 2900, 2500; page 18, lines 3-10; page 25, lines 1-25);

enabling the agent to determine an action based on an analysis of risk management information created from the financial information (see at least FIG. 1, element 1050; FIG. 2, element 2500; FIG. 3, element 300; page 21, line 25 through page 22, line 5); and

allowing the agent to facilitate the implementation of the action (see at least FIG. 1, element 1070; FIG. 2, element 2500; FIG. 3, element 300; page 23, lines 19-20).

Dependent claim 115

To independent claim 114, claim 115 adds the activity of receiving risk management information generated by the agent at the client (see at least page 26, lines 5-16).

Dependent claim 116

To independent claim 114, claim 116 adds the activity of receiving the agent's analysis at the client (see at least page 26, lines 5-16).

Dependent claim 117

To independent claim 114, claim 117 adds the activity of receiving an action instruction at the client (see at least page 26, lines 5-16).

Dependent claim 118

To independent claim 114, claim 118 adds the activity of receiving an action recommendation at the client (see at least page 26, lines 5-16).

Dependent claim 119

To independent claim 114, claim 119 adds the activity of receiving a notification at the client of an action that will be implemented by the agent (see at least page 26, lines 5-16).

Dependent claim 120

To independent claim 114, claim 120 adds the activity of receiving a notification at the client of an implemented action (see at least page 26, lines 5-16).

Dependent claim 121

To independent claim 114, claim 121 adds the activity of accessing information across a network on one or more of the agent's activities (see at least page 26, line 17-page 27, line 3).

Dependent claim 122

To independent claim 114, claim 121 adds the activity of monitoring across a network one or more of the agent's activities (see at least page 26, line 17-page 27, line 10).

Dependent claim 123

To independent claim 114, claim 123 adds the activity of silently monitoring across a network one or more of the agent's activities (see at least page 11, lines 14-20).

Dependent claim 124

To independent claim 114, claim 124 adds the activity of requesting notification of an

effect of one or more actions of the agent on the risk management analysis (see at least page 7, lines 16-18; page 11, lines 14-20; and page 24, lines 26-29).

Dependent claim 125

To independent claim 114, claim 125 adds the activity of requesting notification of the effect of one or more alternative actions of the agent on the risk management information (see at least page 7, lines 16-18; page 11, lines 14-20; and page 24, lines 26-29).

Dependent claim 126

To independent claim 114, claim 126 adds the activity of requesting information on one or more reasons behind an action determined by the agent (see at least page 24, lines 17-19).

Dependent claim 127

To independent claim 114, claim 127 adds the activity of requesting an audit log of one or more of historical activities of the agent on behalf of the client (see at least page 24, lines 9-25).

Dependent claim 128

To independent claim 114, claim 128 adds the activity of requesting a review of one or more of historical activities of the agent (see at least page 24, lines 9-25).

Dependent claim 129

To independent claim 114, claim 129 adds the activity of providing financial information to the agent (see at least page 26, lines 5-16).

Dependent claim 130

To independent claim 114, claim 130 adds the activity of providing new financial information to the agent based on a review of one or more of historical activities of the agent (see at least page 12, lines 16-23).

Dependent claim 131

To independent claim 114, claim 131 adds the activity of removing the agent's authority to undertake any action on behalf of the client (see at least page 31, line 23-page 32, line 8).

Dependent claim 132

To independent claim 114, claim 132 adds the activity of removing the authority of the agent in connection with one or more actions (see at least page 31, line 23-page 32, line 8).

Dependent claim 133

To independent claim 114, claim 133 adds the activity of requesting the agent to halt one or more actions (see at least page 31, line 23-page 32, line 8).

Dependent claim 134

To independent claim 114, claim 134 adds the activity of requesting, through a network, the agent to halt one or more actions (see at least page 31, line 23-page 32, line 8).

Dependent claim 135

To independent claim 114, claim 135 adds that the financial information is provided through a network (see at least page 26, lines 5-16; page 26, line 29-page 27, line 3).

Independent claim 136

Claim 136 recites a computer-readable medium (see at least FIG. 3, element 3300; page 28, lines 21-26) storing instructions (see at least FIG. 3, element 3400; page 28, lines 21-23) that, when executed by one or more processors (see at least FIG 3, element 3200; page 28, lines 21-23), cause the one or more processors to perform activities (see at least page 28, lines 21-23).

Those activities comprise:

providing financial information on one or more financial functions (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3) of an institutional or corporate client (see at least page 30, lines 7-9; page 17, lines 10-12; page 19, lines 8-13) to an agent (see at least

FIG. 1, elements 1020, 1025; FIG. 2, elements 2100, 2900, 2500; page 18, lines 3-10; page 25, lines 1-25);

enabling the agent to determine an action based on an analysis of risk management information created from the financial information (see at least FIG. 1, element 1050; FIG. 2, element 2500; FIG. 3, element 300; page 21, line 25 through page 22, line 5); and

allowing the agent to facilitate the implementation of the action (see at least FIG. 1, element 1070; FIG. 2, element 2500; FIG. 3, element 300; page 23, lines 19-20).

Independent claim 137

Claim 137 recites an apparatus (see at least FIG. 2, element 2500; FIG. 3, elements 300) for a client to outsource financial functions to an agent (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3) representing a plurality of institutional or corporate clients (see at least page 30, lines 7-9; page 17, lines 10-12; page 19, lines 8-13), comprising:

means for providing financial information on one or more financial functions of each client (see at least page 1, lines 5-7) to a computer of the agent (see at least FIG. 1, elements 1020, 1025; FIG. 2, elements 2100, 2900, 2500; page 18, lines 3-10; page 25, lines 1-25; page 25, lines 1-25; page 25, line 27 to page 29, line 10);

means for enabling the agent to determine an action based on an analysis of risk management information created from the financial information (see at least FIG. 1, element 1050; FIG. 2, element 2500; FIG. 3, element 300; page 21, line 25 through page 22, line 5; page 25, lines 1-25; page 25, line 27 to page 29, line 10); and

means for allowing the agent to facilitate the implementation of the action (see at least FIG. 1, element 1070; FIG. 2, element 2500; FIG. 3, element 300; page 23, lines 19-20; page 25, lines 1-25; page 25, line 27 to page 29, line 10).

Independent claim 138

Claim 138 recites a computer-assisted method (see at least page 25, lines 1-4; FIGs. 1, 2, 3) for an agent to provide financial functions (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3) to each (see at least page 16, line 28 through page 17, line 3) of a plurality of institutional or corporate clients (see at least page 30, lines 7-9; page 17, lines 10-12;

page 19, lines 8-13), comprising the activities of:

regarding a financial function of a client from the plurality of clients (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3):

demonstrating to the client the potential transparency of activities of the agent (see at least FIG. 1, element 1010; page 11, line 4 to page 12, line 29; page 17, lines 27-28);

receiving financial information at a computer of the agent (see at least FIG. 1, element 1020; FIG. 2, element 2500; page 18, lines 3-10);

analyzing risk management information created from, and in the context of, the financial information (see at least FIG. 1, element 1050; page 21, line 25 through page 22, line 5); and

facilitating implementation, on behalf of the client, of an agent's action based on the analysis (see at least FIG. 1, element 1070; page 23, lines 19-20).

Independent claim 139

Claim 139 recites a computer-assisted method (see at least page 25, lines 1-4; FIGs. 1, 2, 3) for an agent to provide financial functions to each (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3) of a plurality of institutional or corporate clients (see at least page 30, lines 7-9; page 17, lines 10-12; page 19, lines 8-13), comprising the activities of:

regarding a financial function of each client from the plurality of clients (see at least Title; page 1, lines 5-7; page 16, line 28 through page 17, line 3):

receiving financial information at a computer of the agent (see at least FIG. 1, element 1020; FIG. 2, element 2500; page 18, lines 3-10);

analyzing risk management information created from, and in the context of, the financial information (see at least FIG. 1, element 1050; page 21, line 25 through page 22, line 5);

facilitating implementation of a decision of the agent that is based on the analysis (see at least FIG. 1, element 1070; page 23, lines 19-20); and

enabling the client to monitor through a network activities of the agent (see at least FIG. 1, element 1010; page 11, line 4 to page 12, line 29; page 17,

lines 27-28).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Each of claims 1-139 was at least twice rejected as obvious under 35 U.S.C. 103(a). In support of the most recent rejections, “Financial Management: An Introduction” (“McMenamin”), “Strategic Issues Management: Organizations and Public Policy Challenges” (“Heath”), and allegedly “disclosed prior art” U.S. Patent No. 5,684,952 (“Stein”) were cited.

VII. ARGUMENT

A. Legal Standards

1. Claim Construction

Before the *prima facie* obviousness criteria can be applied, the words of each claim must be interpreted. The Federal Circuit, in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*), *cert. denied*, 2006 U.S. LEXIS 1154 (U.S. Feb. 21, 2006) has clarified that:

1. “[t]he Patent and Trademark Office (‘PTO’) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘**in light of the specification as it would be interpreted by one of ordinary skill in the art**’” (*Id.* at 1316);
2. the words of a claim “are generally given their ordinary and customary meaning” (*Id.* at 1312);
3. the ordinary and customary meaning of a claim term is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application” (*Id.* at 1313);
4. “the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but **in the context of the entire patent**, including the specification” (*Id.*);
5. even “the context in which a term is used in the asserted claim can be highly instructive” (*Id.* at 1314);
6. “the specification may reveal a special definition given to a claim term by the

- patentee that differs from the meaning it would otherwise possess. In such cases, **the inventor's lexicography governs**" (*Id.* at 1316);
7. even "when guidance is not provided in explicit definitional format, **the specification may define claim terms by implication** such that the meaning may be found in or ascertained by a reading of the patent documents" (*Id.* at 1321);
 8. an "invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office" (*Id.* at 1317 (*citing Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966))); and
 9. the "prosecution history... consists of the complete record of the proceedings before the PTO and **includes the prior art cited** during the examination of the patent" (*Id.* at 1317).

The rules established in *Phillips* apply to *ex parte* examination in the USPTO. *See, In re Kumar*, 418 F.2d 1361 (Fed. Cir. 2005).

2. Official Notice

Regarding Official Notice, MPEP § 2144.03.A states (emphasis added):

[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of **instant and unquestionable demonstration as being well-known**. For example, assertions of... specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. *See also In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979).

Further, if an applicant traverses the examiner's assertion of official notice, the examiner **must provide documentary evidence** in the next Office Action if the rejection is to be maintained. *See* 37 CFR 1.104(c)(2) and MPEP 2144.03C. *See also In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) ("[T]he Board cannot simply reach conclusions based on its own understanding or experience, or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.").

A bald assertion of knowledge generally available to one of ordinary skill in the art to bridge the evidentiary gap is improper. Such unfounded assertions are not permissible substitutes for evidence. *See In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). That is, deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.*

Applicant also notes that MPEP § 707.07(d) requires “[w]here a claim is refused for any reason relating to the merits thereof it should be ‘rejected’ and the ground of rejection fully and clearly stated, and the word “reject” must be used. Applicant respectfully also notes that, 37 C.F.R. § 1.111(b) requires:

In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner’s action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant’s or patent owner’s reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

3. Inherency

Inherency “requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002).

4. Allegedly “Disclosed Prior Art”

According to the Federal Circuit “[o]ne’s own work may **not** be considered prior art in the absence of a statutory basis”. *Riverwood International Corp. v. R. A. Jones & Co., Inc.*, 324 F.3d 1346, 66 USPQ2d 1331 (Fed. Cir. 2003).

5. *Prima Facie* Criteria

Over 50 years ago, in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

The Federal Circuit has applied *Graham*’s required factual inquiry in numerous legal precedents that are binding on the USPTO.

It is recognized that most patentable inventions arise from a combination of old elements and often, each element is found in the prior art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. *Id.* at 1355, 1357.

Instead, “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach... all the claim limitations.” *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

Moreover, the “Patent Office has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057, *reh’g denied*, 390 U.S. 1000 (1968). “It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis”. *Id.*

It is legal error to “substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results.” *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

“Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, ‘the burden of coming forward with evidence or argument shifts to the applicant.’” *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

6. Pertinent Prior Art References

The *Graham* analysis requires that, to rely on a prior art reference as a basis for a rejection, the USPTO must show that the reference is “reasonably pertinent to the particular problem with which the invention was involved.” *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664, 57 USPQ2d 1161, 1166 (Fed. Cir. 2000); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983); *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992); *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006).

“References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art.” *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (“[I]t is necessary to consider ‘the reality of the circumstances,’—in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor” (*quoting In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979))).

“If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his

invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.” *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (citing *In re Clay*, 966 F.2d 656, 659-60 (Fed. Cir. 1992)).

Yet “[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.” *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (quoting *Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000)).

7. Motivation or Suggestion to Combine Prior Art References

Under the *Graham* analysis, the “examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” See, MPEP 2142. The requirements for meeting this burden are clear.

To factually support a *prima facie* conclusion of obviousness, an Office Action must clearly and objectively prove “the reasons one of ordinary skill in the art would have been motivated to select the references”. *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998); *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006).

Further, “the examiner **must show reasons** that the skilled artisan, **confronted with the same problems** as the inventor and with no knowledge of the claimed invention, **would select the elements** from the cited prior art references for combination **in the manner claimed**” (emphasis added). *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *In re Sang-Su Lee*, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

To show these reasons, “[p]articular findings must be made”. *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Such factual findings must be supported by “concrete evidence in the record”. *In re Zurko*, 258 F.3d 1379, 1385-86, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Moreover, a showing of combinability must be “clear and particular”. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 161(Fed. Cir. 1999). That strong showing is needed because, “**obviousness requires proof** ‘that the skilled artisan . . . would select the elements from the cited prior art references for combination in the manner claimed’”. *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006) (quotation omitted) (emphasis added).

Thus, the Office Action must clearly, particularly, and objectively prove some

“suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; and

“combine [those teachings] in the way that would produce the claimed” subject matter.

In re Johnston, 435 F.3d 1381 (Fed. Cir. 2006) (internal citations omitted). *See also, In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (discussing “the test of whether it would have been obvious to select **specific** teachings and combine them as did the applicant”) (emphasis added); and *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (“When prior art references require selective combination... to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.”). “The absence of . . . a suggestion to combine is dispositive in an obviousness determination.” *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997).

Further, these requirements apply regardless of whether the Office Action relies upon modifying or combining purported teachings.

Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious modification of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the **desirability** of the modification.... It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-1784 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); and *In re Fine*, 837

F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) (internal quotations omitted) (emphasis added)).

8. Unfounded Assertions

A bald assertion of knowledge generally available to one of ordinary skill in the art to bridge the evidentiary gap is improper. Such unfounded assertions are not permissible substitutes for evidence. *See In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). That is, deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.*

9. Reasonable Expectation of Success

“[I]f all the elements of [a claim] are found in a combination of prior art references”, “a proper analysis under § 103 requires, *inter alia*, consideration of ... whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success”” *Medichem, S.A. v. Rolabo, S.L.* (Fed. Cir. February 3, 2006) (quoting *Velander v. Garner*, 348 F.3d 1359, 1363 (Fed. Cir. 2003) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 1

7 (1966))).

“[T]o have a reasonable expectation of success, one must be motivated to do more than merely to ‘vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.’” *Medichem, S.A. v. Rolabo, S.L.* (Fed. Cir. February 3, 2006) (quoting *In re O’Farrell*, 853 F.2d 894, 903 (Fed. Cir. 1988)). “Similarly, prior art fails to provide the requisite ‘reasonable expectation’ of success where it teaches merely to pursue a ‘general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it.’” *Id.*

B. Analysis**1. Claim 1****a) Claim Construction**

In the present Application, the customary meaning for the phrase “financial risk management function” is implicitly defined in the specification and the properly cited prior art. That definition must control examination of those claims that recite this phrase.

At least at page 1, lines 5-7, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]he present invention relates to the field of financial risk management and trading, and, **more particularly**, to a method and system for clients to outsource financial functions to an agent.”

At least at page 2, lines 16-17, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]ypical financial functions are treasury, credit management, risk management, and trading, together with several of their associated sub-functions.”

At least at page 3, lines 1-3, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]he activities that make up these financial functions are the relevant daily operations of the front-office trading departments and the associated middle-office risk management and back-office support departments.”

Thus, the phrase “financial risk management function” should be construed as one of ordinary skill in the relevant art would interpret the definition provided in the specification.

Applicant respectfully notes a discussion regarding lexicography on Pages 26-27 of the Final Office Action. Page 26 of the Final Office Action recites:

Although the argued elements are found as examples and/or embodiments in the specification, they were not claimed explicitly in the disputed claim(s). Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. Therefore although the claims are interpreted in

light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed Cir. 1993) and MPEP §2111.01.

Furthermore, while applicants may be their own lexicographer, any special meaning assigned to a term ‘must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.’ *See Multiform Desiccants Inc v. Medzam Ltd.*, 133 F3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). Examiner asserts that the specification fails to indicate a clear or obvious departure from the common and ordinary definition of the disputed claim term, and, therefore, the common and ordinary definition of the disputed claim term was properly utilized for application of prior art.

Applicant respectfully notes that *Phillips*, as an *en banc* decision, supersedes any prior or subsequent Federal Circuit case adjudicated by any panel that is not *en banc*. As a result, to the extent that *In re Van Geuns*, *Multiform*, or *In re Prater* differs from *Phillips*, they have been superseded thereby. The Final Office Action further alleges at pages 26-27:

For example, the specification states ‘[t]he present invention relates to the field of financial risk management and trading, and, more particularly, to a method and system for clients to outsource financial functions to an agent.’ (see p. 1, lines 5 - 7). Such statements indicate that the “financial functions” are a subset of “financial risk management” functions. However, the specification also states “[t]ypical financial functions are treasury, credit management, risk management, and trading, together with several of their associated sub-functions.” (emphasis added - see p 2, lines 16 - 17). Such statement indicates that “risk management” functions are a subset of “financial functions.” Such a contradiction falls far short of a clearly expressed desire to define claim terminology.

Applicant respectfully traverses this argument as fallacious. No evidence been presented, nor does it follow from logic alone, that the phrase “[t]he present invention relates to the field of financial risk management and trading, and, more particularly, to a method and

system for clients to outsource financial functions to an agent” necessarily means that “financial functions” are a subset of “financial risk management” or of the claimed “financial risk management function”. Instead, the above-recited phrase can be reasonably and logically read that “[t]he present invention relates to” (a) “the field of financial risk management and trading” and “[t]he present invention relates to” (b) “a method and system for clients to outsource financial functions to an agent”, with (a) related in any manner, including possibly being completely unrelated, to (b), even though the description of (b) is presented “more particularly”.

Likewise, no evidence has been presented, nor does it follow from logic alone, that “risk management”, as used in the context of “financial functions”, such as “treasury”, “credit management”, and “trading”, necessarily means “financial risk management” as used in the context of “the field of financial risk management and trading”.

Similarly, no evidence has been presented, nor does it follow from logic alone, that “risk management”, as used in the context of “financial functions”, such as “treasury”, “credit management”, and “trading”, necessarily means the claimed “financial risk management function”.

Thus, the above-recited allegation of the Final Office Action lacks a proper evidentiary foundation and lacks logical validity. Accordingly, Applicant respectfully submits that claim construction regarding the phrase “financial risk management function” must be construed as one of ordinary skill in the relevant art would interpret that phrase as defined and/or guided by the entire specification. Since the Final Office Action fails to provide such a construction, Applicant respectfully requests a reversal of the rejection of claim 1.

b) Official Notice

The Final Office Action alleges, at Pages 27-28, that Applicants Office Action Reply dated 11 April 2006:

In response to the applicant's traversal of Official Notice finding(s) in previous office action, examiner asserts that the traversal is inadequate Adequate traversal is a two-step process. First, applicant(s) must state their traversal on the record. Second and in accordance with 37 C.F.R. 1.111(b) which requires

applicant(s) to specifically point out the supposed errors in the Office Action, applicant(s) must state why the Official Notice statement(s) are not to be considered common knowledge or well known in the art.

In this application, while applicant(s) have clearly met step (1), applicant(s) have failed step (2) since they have failed to argue why the Official Notice statement(s) are not to be considered common knowledge or well known in the art. Because Applicant(s)' traversal is inadequate, the Official Notice statement(s) are taken to be admitted as prior art. See MPEP 2144.03.

In the applicant's response, the applicant merely made a blanket statement that '(to the extent that Official Notice is explicitly or implicitly utilized to support any rejection' and failed to even specify which claims the applicant is contesting, never mind articulating a basis for the applicant's arguments against the taking of Official Notice.

For example, should the applicant decide to traverse the taking of Official Notice in regards to Claim 39, applicant should argue that it is not common knowledge nor well known in the art to utilize financial information including financial guidelines when making a financial decision. Or should the applicant decide to traverse the taking of Official Notice in regards to Claim 48, applicant should argue that it is not common knowledge nor well known in the art that financial management, either manual or automated financial management, involves cashflow management

Applicant respectfully traverses these allegations. Applicant respectfully notes that the phrase "Official Notice" does not appear whatsoever in any of the claim rejections of the Final Office Action or the prior Office Action dated 13 January 2006. Applicant respectfully submits that if, indeed, it was the intention of either Office Action to take Official Notice regarding any of the articulated grounds of rejection, that both Office Actions utterly fail to comply with the requirements of MPEP § 707.07(d) since neither provides "ground[s] of rejection [that are] fully and clearly stated". For example, if either Office Action intended to rely upon Official Notice for rejecting claim 39 and/or claim 48, as implied on Page 28 of the Final Office Action, each respective Office Action based thereupon was required to clearly state Official Notice as a

grounds of rejection for each of those claims. Applicant respectfully notes that neither 37 C.F.R. 1.111 nor the MPEP require Applicant to be clairvoyant regarding the grounds of rejection of an Office Action.

Applicant respectfully submits that the Office Action Reply dated 11 April 2006 was “reduced to a writing” and “distinctly and specifically point[ed] out the supposed errors in the examiner’s action” and “repl[ied] to every ground of objection and rejection in the prior Office action.” As such, the Office Action Reply dated 11 April 2006 fully complied with 37 C.F.R. 1.111(b). Applicant respectfully submits that the allegations of the Final Office Action such as, *inter alia*, “should the applicant decide to traverse the taking of Official Notice in regards to Claim 39, applicant should argue that it is not common knowledge nor well known in the art to utilize financial information including financial guidelines when making a financial decision”, are without legal basis under 37 C.F.R. 1.111(b).

In addition, since Applicant has traversed the use of Official Notice, to the extent that Official Notice was used in rejecting the claims, “the examiner **must provide documentary evidence in the next Office Action** if the rejection is to be maintained. *See* 37 CFR 1.104(c)(2) and MPEP 2144.03C. *See also In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Since the Final Office Action utterly fails to provide any such reference for any claim, and appears to indicate that Official Notice was used in the rejections (at least of claims 27-32, 34-37, 39-111, 131, and 132, *see* Page 33), Applicant respectfully submits that each rejection based upon Official Notice must be reversed for at least that reason.

c) Inherency

To the extent that either Office Action relied on inherency to support a claim rejection, Applicant respectfully traverses and requests a reversal of each rejection based thereon since a detailed explanation has not been provided demonstrating that the “missing descriptive material is necessarily present, not merely probably or possibly present”, in any prior art reference cited to supporting such rejection.

d) Allegedly “Disclosed Prior Art”

The Final Office Action asserts, “applicant’s specification, pp. 1-2” is “Disclosed Prior Art”. Applicant respectfully traverses this assertion.

Although Applicant has submitted multiple Information Disclosure Statements that potentially list “prior art”, Applicant does **not** admit that pages 1-2 of Applicant’s specification describe “prior art”, nor has any evidence been presented that any aspect of pages 1-2 of Applicant’s specification can be used as prior art. Thus, no statement on pages 1-2 of Applicant’s specification can serve as a proper basis for claim rejections under 35 U.S.C. 103(a) and the attempt to do so in the Final Office Action is improper and should be withdrawn.

The Final Office Action alleges, at Page 28:

In response to the applicant's argument that the specification does not constitute Disclosed Prior Art, the MPEP states that when “the specification's background of the invention describes information as being known or conventional, [it] may be considered as an admission of prior art.” MPEP § 704.11 (a). To that end, the background does utilize terminology that indicates the disclosed information is known or conventional through the use of language such as “commonly”, “frequently”, “conventionally” and/or “traditionally.” Therefore, examiner asserts that information contained within the specification under the title “Background of the Invention” is an admission of prior art and, therefore, Disclosed Prior Art.

With all due respect, the Federal Circuit has held that “[o]ne's own work may **not** be considered prior art in the absence of a statutory basis”. The MPEP is not a statute, nor does it have sufficient legal authority to overcome a Federal Circuit holding. Applicant respectfully submits that the Final Office Action provides no statutory basis for the use of Applicant’s disclosure as prior art.

For at least these reasons, Applicant respectfully submits that no “admitted prior art” is comprised by the present Application.

e) Missing Claim Limitations

Independent claim 1 recites, *inter alia*, at least one “financial risk management function”. The applied portions of McMenamin, Heath, and Stein do not teach a “financial risk management function”.

Independent claim 1 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, a “computer-assisted method for providing financial risk management functions by an agent for each of a plurality of institutional or corporate clients”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

f) No Motivation or Suggestion to Combine the Applied References

Instead, regarding selected proffered combinations, the Final Office Action improperly states that “McMenamin discloses a method for providing financial functions (financial management)”. This is a mischaracterization of McMenamin and the claimed subject matter. At most, the cited portions of McMenamin allegedly provide an “introduction” to “financial management”. The cited portions of McMenamin do not teach or disclose any “computer-assisted methods” for providing “financial risk management functions” by “an agent”, and Applicant respectfully submits that Office Action presents no reasons, and certainly no “concrete evidence” that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from McMenamin.

The Final Office Action asserts, at Page 4:

McMenamin does not teach that providing financial functions comprising said steps is automated. However, it would have been obvious to one of ordinary skill

in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Applicant respectfully points out that *In re Venner* was decided in 1958. As such, *In re Venner* did not apply the *Graham* test, *see supra*, regarding obviousness. As a result, Applicant respectfully submits that no evidence is presented that the proposition for which *In re Venner* is cited is still valid law. Applicant respectfully notes that the Federal Circuit has failed to cite *In re Venner* in any case whatsoever. Moreover, even if *In re Venner* were still valid for the point of law for which it is presented, no *prima facie* case is presented that the claimed subject matter of the present application is disclosed in any of the applied portions of the relied upon references as a “manual activity that accomplishes the same result.”

Applicant respectfully notes the facial absurdity of the legal premise that the Final Office Action attempts to establish based upon *In re Venner*. For example, consider a manual activity of driving an automobile to a grocery store and purchasing a gallon of milk. Applicant respectfully submits that substantially more than “routine skill in the art” would be required for automating this activity. To Applicant’s knowledge, no one in the world at present would be able to effect such automation. Accordingly, Applicant respectfully submits that the blanket assertion of the Final Office Action makes and uses this archaic case to support is not generally valid.

Moreover, Applicant respectfully submits that Office Action presents no reasons that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from Heath. Instead, it seems quite likely that one of skill in the art would instantly reject Heath as completely irrelevant, since Heath is a reference allegedly directed to the “public policy challenges” facing “organizations”, rather than “financial risk management functions”. Heath explains that “the heart of issues management 'is reconciliation of conflicting internal interests on public policy issues of strategic importance in order to make a coherent external advocacy'”. Applicant respectfully asks how the “reconciliation of conflicting internal interests on public policy issues” relates in the least to the claimed subject matter? Applicant also respectfully asks where is the concrete evidence that

Heath is “within the field of the inventor's endeavor”, and if not, “is reasonably pertinent to the **particular problem** with which the inventor was involved”?

Similarly, Applicant respectfully submits that Office Action presents no reasons, and certainly no “concrete evidence”, that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from Stein.

Furthermore, even assuming, *arguendo*, that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” McMenamin, Heath, and Stein, the Office Action presents no concrete evidence of a suggestion, motivation, or teaching **in the prior art** that would have led a person of ordinary skill in the art to combine these references in the manner claimed.

In addition, Applicant respectfully notes that the Final Office Action impermissibly relies on Applicant’s disclosure on Page 5 in rejecting claim 1. As noted, *supra*, Applicant does not admit that any of contents of the present Application is prior art. Accordingly, Applicant respectfully traverses the impermissible use of “p. 2, lines 4-9” of the present Application as “prior art” by the Final Office Action.

The Final Office Action asserts at Pages 30 and 31:

In response to applicant's argument that there is no suggestion to combine the references, the Courts have stated that “[a]suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references ... The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art ... there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (emphasis added). *In re Kahn*, 78 USPQ2d 1329, 1336 (CA FC 2006). Examiner asserts that he can and/or has provided such “articulated reasoning to support the legal conclusion of obviousness.

Applicant respectfully submits that the legal analysis presented in *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006), requires that “underlying factual findings” of the USPTO, “including a

finding of a motivation to combine” must be supported by “substantial evidence *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000)). Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence. *Id.* at 1312 (citing *Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229-30 (1938)). According to the Federal Circuit “[t]he presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact.” *Alza Corp. v. Mylan Laboratories, Inc.*, 2006 U.S. App. LEXIS 22616 (Fed. Cir. 2006) (citing *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000)); accord *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 (Fed. Cir. 2000). Likewise, the presence or absence of a “reasonable expectation of success” from making such a combination is also a pure question of fact. *Alza Corp. v. Mylan Laboratories, Inc.*, 2006 U.S. App. LEXIS 22616 (Fed. Cir. 2006) (citing *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006)).

The allegations of the Final Office Action regarding the alleged suggestions or motivations for modifying and/or combining references comprise little more than bald assertions and do not appear to be supported by even a “mere scintilla of evidence”. That is, the Final Office Action presents **no factual basis** upon which the allegations regarding suggestions or motivations to combine references are based. Applicant respectfully reiterates that a “bald assertion of knowledge generally available to one of ordinary skill in the art to bridge the evidentiary gap is improper. Such unfounded assertions are not permissible substitutes for evidence. *See In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). In other words, deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.*

For at least this reason, Applicant respectfully submits that the allegations responding to Applicant’s argument presented in the Office Action Reply dated 11 April 2006 are unsupported and fail to provide any evidentiary support or factual basis upon which a conclusion of a suggestion or motivation to combine the applied portions of the relied upon references could be based.

g) No Reasonable Expectation of Success

The Final Office Action attempts to, impermissibly, combine portions of Applicants own disclosure and three additional references in rejecting claim 1, McMenamin, Heath, and Stein.

Applicant respectfully submits that McMenamin is allegedly directed to an “introduction to the basic principles, practices and concepts of modern financial management.” *See* Page 1.

By contrast, Heath is allegedly directed toward “issues management”, which is described as “the product of turbulent criticism and change that angry publics seek to impose on business policies and practices.” *See* Page 1.

In further contrast, Stein’s Abstract allegedly recites that:

[a] supervisory control system for a networked multimedia computing system permits a teacher or network administrator to quickly and easily update system software on selected destination workstations with the system software currently residing on the master workstation. In one mode of operation, only basic system software is updated, while user-defined preferences are unchanged. In a second mode of operation, both the system software and all user-controlled settings are replaced, to permit the remote workstations to be configured in a desired manner.

Applicant’s disclosure is not available as a reference and even if it was, doesn’t overcome the deficiencies of the applied portions of the remaining relied upon references.

The Final Office Action presents no evidence that one having ordinary skill in the art would have had any expectation of success, let alone a reasonable expectation of success, in combining the applied portions of the relied upon references. At most, the applied portions of the relied upon references provide “only general guidance as to the particular form of the claimed invention or how to achieve it.”

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, expressly or inherently teach or suggest **every** limitation of claim 1 (another assumption that is respectfully traversed), there is still no evidence indicating a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action, and consequently, the Office Action fails to establish a *prima facie* case of obviousness.

h) Improper Reliance on *In re Venner*

The Final Office Action recites, at Pages 33-34:

Now to the argued claim limitations specifically, a known manual financial decision-making methodology was disclosed by McMenamin. Such prior art reference was modified through automation via *In re Venner*, to capture the benefits natural to such automation - speed, uniformity and/or reliability. Automation would have constituted the use of a computer to make such automation possible, an argument buttressed by the use of a computer network, as disclosed by Stein. The outsourcing of this financial function, either the outsourcing of the manual or the computerized process, would have been obvious in light of Disclosed Prior Art. Finally, a supervision system that allowed management to oversee their agents and/or employees at their individual workstations, is disclosed by Stein, serving to monitor and provide transparency concerning the actions of the agents.

Applicant again traverses the continued use of *In re Venner* in the rejection of any of the claimed subject matter of the present Application. Applicant reiterates that, as a case decided in 1958, *In re Venner* fails to properly consider the Graham factors regarding obviousness. As such it is no longer binding precedent and has at least been superseded by *Graham*.

i) Improper Reliance on Stein as a Reference

A proper Office Action must be complete as to all matters, must provide a clear explanation of all actions taken, and **must answer in detail** the substance of each of Applicant's submitted arguments (emphasis added). See MPEP 707.07(f).

In the Office Action Reply dated 11 April 2006, Applicant respectfully stated, at Page 30, "[s]imilarly, Applicant respectfully submits that Office Action presents no reasons, and certainly no "concrete evidence", that "the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select" anything from Stein. The Final Office Action is silent regarding this argument.

Stein allegedly recites, at the Abstract:

A supervisory control system for a networked multimedia computing system permits a teacher or network administrator to quickly and easily update system software on selected destination workstations with the system software currently residing on the master workstation. In one mode of operation, only basic system software is updated, while user-defined preferences are unchanged. In a second mode of operation, both the system software and all user-controlled settings are replaced, to permit the remote workstations to be configured in a desired manner.

No argument is advanced in either Office Action as to why one skilled in the art would select a reference directed to updating “basic system software” and “system software and all user-controlled settings” in a method relating to financial risk management.

Since the Final Office Action is silent regarding the argument regarding Stein, Applicant submits that the Final Office Action concedes that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention” would not select anything from Stein.

j) Conclusion

For at least the reasons mentioned above, a reversal of the rejection of claim 1 is respectfully requested. Also, a reversal of each rejection of claims 2-111, each of which depends upon claim 1.

2. Claim 2

Since claim 2 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 2, at Page 6:

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating the ability to receive financial information, as disclosed by McMenamin, via a network as disclosed by Stein, allowing for fast

and efficient communication to the computer's utilized by the agents.

Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 2.

3. Claim 3

Since claim 3 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 3, at Pages 6-7:

[w]hile McMenamin does not explicitly state the implementation of said decision, however, it is old and well-known in the art that implementation of said decision is a fundamental and basic component, in fact the end result of the entire decision-making process, as evidenced by Heath (see p. 86). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating an implementation stage, as disclosed by Heath, allowing for actual implementation of the strategic decision formulated in said financial function.

Principal-agent relationships and the outsourcing of functions and/or activities to said agents is old and well known in the arts of business and strategic planning,

and principal-agent relationships, as evidenced by Disclosed Prior Art (see p. 2, lines 4-9). It would have been obvious one of ordinary skill in the art at the time of the invention to have modified McMenamin, Heath, Disclosed Prior Art and Stein to incorporate the ability to allow for the implementation of action to be carried out by the agent on behalf on the client, or to inform the client of the agent's findings, allowing the client to carry out implementation themselves.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that "p. 2, lines 4-9" is prior art.

Further, Applicant respectfully submits that these unfounded assertions fail to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 3.

4. Claim 4

Since claim 4 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 4, at Pages 6-7:

[w]hile McMenamin does not explicitly state the implementation of said decision, however, it is old and well-known in the art that implementation of said decision is a fundamental and basic component, in fact the end result of the entire decision-

making process, as evidenced by Heath (see p. 86). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating an implementation stage, as disclosed by Heath, allowing for actual implementation of the strategic decision formulated in said financial function.

Principal-agent relationships and the outsourcing of functions and/or activities to said agents is old and well known in the arts of business and strategic planning, and principal-agent relationships, as evidenced by Disclosed Prior Art (see p. 2, lines 4-9). It would have been obvious one of ordinary skill in the art at the time of the invention to have modified McMenamin, Heath, Disclosed Prior Art and Stein to incorporate the ability to allow for the implementation of action to be carried out by the agent on behalf on the client, or to inform the client of the agent's findings, allowing the client to carry out implementation themselves.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that "p. 2, lines 4-9" is prior art.

Further, Applicant respectfully submits that these unfounded assertions fail to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 4.

5. Claim 5

Since claim 5 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 5, at Pages 6-7:

[w]hile McMenamin does not explicitly state the implementation of said decision, however, it is old and well-known in the art that implementation of said decision is a fundamental and basic component, in fact the end result of the entire decision-making process, as evidenced by Heath (see p. 86). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating an implementation stage, as disclosed by Heath, allowing for actual implementation of the strategic decision formulated in said financial function.

Principal-agent relationships and the outsourcing of functions and/or activities to said agents is old and well known in the arts of business and strategic planning, and principal-agent relationships, as evidenced by Disclosed Prior Art (see p. 2, lines 4-9). It would have been obvious one of ordinary skill in the art at the time of the invention to have modified McMenamin, Heath, Disclosed Prior Art and Stein to incorporate the ability to allow for the implementation of action to be carried out by the agent on behalf on the client, or to inform the client of the agent's findings, allowing the client to carry out implementation themselves.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that "p. 2, lines 4-9" is prior art.

Further, Applicant respectfully submits that these unfounded assertions fail to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 5.

6. Claim 6

Since claim 6 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 6, at Pages 8:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating an ability for said parties, such as the client and agent, to communicate through the system, as disclosed by Stein, to allowing for said parties to be fully informed and in continuous communication about their activities.

Communication between a principal and an agent in a principal-agent relationship, concerning the activities or the planned activities of said parties having an impact on their relationship, is old and well in the arts of business and strategic planning, and principal-agent relationships. It would have been obvious one of ordinary skill in the art at the time of the invention to have modified McMenamin, Heath, Disclosed Prior Art and Stein to incorporate the ability for the agent to notify the client concerning the planned implementation and/or completed implementation of an action taken by the agent, on the client's behalf, and for the client to notify the agent concerning the planned implementation and/or completed implementation of an action taken by the client, allowing for said parties to be fully informed concerning implementation of actions which may have an impact upon their relationship.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this

rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that these unfounded assertions fail to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 6.

7. Claim 7

Since claim 7 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 7, at Pages 8:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating an ability for said parties, such as the client and agent, to communicate through the system, as disclosed by Stein, to allowing for said parties to be fully informed and in continuous communication about their activities.

Communication between a principal and an agent in a principal-agent relationship, concerning the activities or the planned activities of said parties having an impact on their relationship, is old and well in the arts of business and strategic planning, and principal-agent relationships. It would have been

obvious one of ordinary skill in the art at the time of the invention to have modified McMenamin, Heath, Disclosed Prior Art and Stein to incorporate the ability for the agent to notify the client concerning the planned implementation and/or completed implementation of an action taken by the agent, on the client's behalf, and for the client to notify the agent concerning the planned implementation and/or completed implementation of an action taken by the client, allowing for said parties to be fully informed concerning implementation of actions which may have an impact upon their relationship.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that these unfounded assertions fail to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 7.

8. Claim 8

Since claim 8 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 6, at Pages 8:

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating an ability for said parties, such as the client and agent, to communicate through the system, as disclosed by Stein, to allowing for said parties to be fully informed and in continuous communication about their activities.

Communication between a principal and an agent in a principal-agent relationship, concerning the activities or the planned activities of said parties having an impact on their relationship, is old and well in the arts of business and strategic planning, and principal-agent relationships. It would have been obvious one of ordinary skill in the art at the time of the invention to have modified McMenamin, Heath, Disclosed Prior Art and Stein to incorporate the ability for the agent to notify the client concerning the planned implementation and/or completed implementation of an action taken by the agent, on the client's behalf, and for the client to notify the agent concerning the planned implementation and/or completed implementation of an action taken by the client, allowing for said parties to be fully informed concerning implementation of actions which may have an impact upon their relationship.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that these unfounded assertions fail to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 8.

9. Claim 9

Since claim 9 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing *Claim* Limitations

Claim 9 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, a “wherein the action includes providing a notification”. The Final Office Action alleges, at Page 8, that this claimed subject matter is taught by McMenamin at “p. 15”. Yet this applied portion of McMenamin merely recites (quality of image is as provided to Applicant):

INTRODUCTION

15

The financial management process

Having acknowledged the critical importance of financial information in decision-making, we can now proceed with our analysis of the financial management process. At this point we are only concerned with an overview of the various stages in the process; a fuller discussion of each key stage will follow in later, relevant chapters.

A model of the financial management process is presented in Figure 1.3 and attempts to illustrate its continuous, cyclical nature. The role of financial information is shown as a key input into the process.

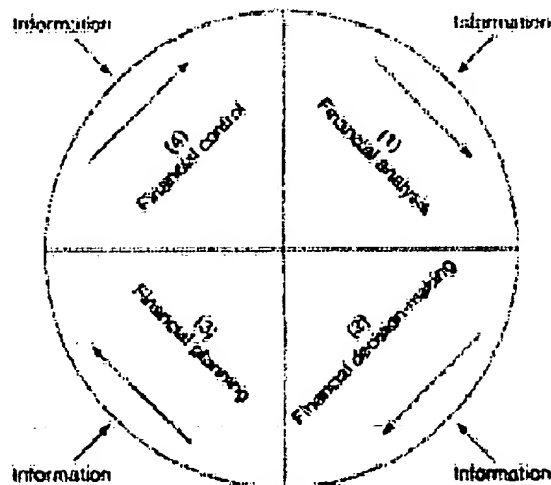


Figure 1.3
The financial
management process

This model of the financial management process forms the basic structure and framework for most of our approach to financial management in this text. It will be developed and refined as we progress through the book. In Parts 3 through 6 we analyze individual aspects of the process, mainly in a strategic context, while Part 7, which deals with financial management in the short-term, explores how the process functions in an operational context.

Financial analysis

This is the preliminary, diagnostic stage and will include: a financial analysis and review to determine the current financial performance and condition of the business; an identification of any particular financial problems, risks, constraints or limitations; and an assessment of financial Strengths, Weaknesses, Opportunities and Threats (a financial SWOT analysis). Any additional financial information that may be needed to complete the review will also be sought. Financial analysis will be further explored in Chapter 9.

Applicant respectfully submits that this applied portion of McMenamin does not teach any "notification" whatsoever. Accordingly, Applicant respectfully submits that McMenamin does not teach "wherein the action includes providing a notification".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying

the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action fails to provide, regarding the additional claimed subject matter of claim 9, any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 9.

10. Claim 10

Since claim 10 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 10 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, a “wherein the action includes providing a report”. The Final Office Action alleges, at Page 8, that this claimed subject matter is taught by McMenamin at “p. 15”. Yet this applied portion of McMenamin is provided, *supra*, regarding the traversal of the rejection of claim 9.

Applicant respectfully submits that this applied portion of McMenamin does not teach any “report” whatsoever. Accordingly, Applicant respectfully submits that McMenamin does not teach “wherein the action includes providing a report”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action fails to provide, regarding the additional claimed subject matter of claim 10, any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 10.

11. Claim 11

Since claim 11 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action fails to provide, regarding the additional claimed subject matter of claim 11, any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 11.

12. Claim 12

Since claim 12 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action fails to provide, regarding the additional claimed subject matter of claim 12, any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 12.

13. Claim 13

Since claim 13 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 13, at Pages 11:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenanim [sic], Heath, Disclosed Prior Art and Stein by incorporating the ability to allow the client to monitor activities of their agents, as disclosed Stein, to allow for supervisory control and monitoring of agents.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 13.

14. Claim 14

Since claim 14 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 14, at Pages 11:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenanim [sic], Heath, Disclosed Prior Art and Stein by incorporating the ability to allow the client to monitor activities of their agents, as disclosed Stein, to allow for supervisory control and monitoring of agents.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 14.

15. Claim 15

Since claim 15 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 15, at Pages 11:

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to have modified McMenanim [sic], Heath, Disclosed Prior Art and Stein by incorporating the ability to allow the client to monitor activities of their agents, as disclosed Stein, to allow for supervisory control and monitoring of agents.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 15.

16. Claim 16

Since claim 16 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 16, at Pages 11:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenanim [sic], Heath, Disclosed Prior Art and Stein by incorporating the ability to allow the client to monitor activities of their agents, as disclosed Stein, to allow for supervisory control and monitoring of agents.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 16.

17. Claim 17

Since claim 17 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 17, at Pages 11:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenanim [sic], Heath, Disclosed Prior Art and Stein by incorporating the ability to allow the client to monitor activities of their agents, as disclosed Stein, to allow for supervisory control and monitoring of agents.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill

in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 17.

18. Claim 18

Since claim 18 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 18, at Pages 11:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenanim [sic], Heath, Disclosed Prior Art and Stein by incorporating the ability to allow the client to monitor activities of their agents, as disclosed Stein, to allow for supervisory control and monitoring of agents.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject

matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 18.

19. Claim 19

Since claim 19 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 19, at Pages 11:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenanim [sic], Heath, Disclosed Prior Art and Stein by incorporating the ability to allow the client to monitor activities of their agents, as disclosed Stein, to allow for supervisory control and monitoring of agents.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of

claim 19.

20. Claim 20

Since claim 20 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 20, at Pages 11:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenanim [sic], Heath, Disclosed Prior Art and Stein by incorporating the ability to allow the client to monitor activities of their agents, as disclosed Stein, to allow for supervisory control and monitoring of agents.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 20.

21. Claim 21

Since claim 21 depends from claim 1, Applicant respectfully incorporates by reference

each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 21, at Pages 12:

Principal-agent relationships and the outsourcing of functions and/or activities to said agents is old and well known in the arts of business and strategic planning, and principal-agent relationships, as evidenced by Disclosed Prior Art (see p. 2, lines 4 - 9). It would have been obvious one of ordinary skill in the art at the time of the invention to have modified McMenamin, Heath, Disclosed Prior Art and Stein to incorporate the ability to allow for the examination of the effect of and/or reasons for an action caused by an agent, as disclosed by Disclosed Prior Art, to capture the financial and/or flexibility benefits of outsourcing such functions

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 21.

22. Claim 22

Since claim 22 depends from claim 1, Applicant respectfully incorporates by reference

each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 22, at Pages 12:

Principal-agent relationships and the outsourcing of functions and/or activities to said agents is old and well known in the arts of business and strategic planning, and principal-agent relationships, as evidenced by Disclosed Prior Art (see p. 2, lines 4 - 9). It would have been obvious one of ordinary skill in the art at the time of the invention to have modified McMenamin, Heath, Disclosed Prior Art and Stein to incorporate the ability to allow for the examination of the effect of and/or reasons for an action caused by an agent, as disclosed by Disclosed Prior Art, to capture the financial and/or flexibility benefits of outsourcing such functions

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 22.

23. Claim 23

Since claim 23 depends from claim 1, Applicant respectfully incorporates by reference

each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 23, at Pages 12:

Principal-agent relationships and the outsourcing of functions and/or activities to said agents is old and well known in the arts of business and strategic planning, and principal-agent relationships, as evidenced by Disclosed Prior Art (see p. 2, lines 4 - 9). It would have been obvious one of ordinary skill in the art at the time of the invention to have modified McMenamin, Heath, Disclosed Prior Art and Stein to incorporate the ability to allow for the examination of the effect of and/or reasons for an action caused by an agent, as disclosed by Disclosed Prior Art, to capture the financial and/or flexibility benefits of outsourcing such functions

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 23.

24. Claim 24

Since claim 24 depends from claim 1, Applicant respectfully incorporates by reference

each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 24, at Pages 12 and 13:

Obtaining historical information concerning an employee, agent and/or consultant, presenting said information to a client and/or employer for examination, and obtaining feedback from said client and/or employer about said employee, agent and/or consultant is old and well known in the art of human resources management and strategic planning, such as providing a potential employer with a resume for assessment or having an client update a performance review based upon their agent's activities. It would be obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenanin [sic], Heath, Disclosed Prior Art and Stein by incorporating the ability to provide historical information to the client for review, allowing the client to gauge the reliability and/or effectiveness of said agent, and collecting feedback from said client concerning said agent, allowing the historical information to be updated and/or complete.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of

claim 24.

25. Claim 25

Since claim 25 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 25, at Pages 12 and 13:

Obtaining historical information concerning an employee, agent and/or consultant, presenting said information to a client and/or employer for examination, and obtaining feedback from said client and/or employer about said employee, agent and/or consultant is old and well known in the art of human resources management and strategic planning, such as providing a potential employer with a resume for assessment or having an client update a performance review based upon their agent's activities. It would be obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenanin [sic], Heath, Disclosed Prior Art and Stein by incorporating the ability to provide historical information to the client for review, allowing the client to gauge the reliability and/or effectiveness of said agent, and collecting feedback from said client concerning said agent, allowing the historical information to be updated and/or complete.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject

matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 25.

26. Claim 26

Since claim 26 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 26, at Pages 12 and 13:

Obtaining historical information concerning an employee, agent and/or consultant, presenting said information to a client and/or employer for examination, and obtaining feedback from said client and/or employer about said employee, agent and/or consultant is old and well known in the art of human resources management and strategic planning, such as providing a potential employer with a resume for assessment or having an client update a performance review based upon their agent's activities. It would be obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenanin [sic], Heath, Disclosed Prior Art and Stein by incorporating the ability to provide historical information to the client for review, allowing the client to gauge the reliability and/or effectiveness of said agent, and collecting feedback from said client concerning said agent, allowing the historical information to be updated and/or complete.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill

in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 26.

27. Claim 27

Since claim 27 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 27 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the agent is conflict-free”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 27, at Page 13:

The benefits of a conflict-free agent operating in a principal-agent relationship is old and well known in the art of human resource management and principal-agent relationships. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenanin [sic], Heath, Disclosed Prior Art and Stein by incorporating an agent that is conflict-free, allowing the client to capture the benefits inherent in having a conflict-free agent, as is old and well known.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Regarding Applicant's prior traversal regarding inherency, the Final Office Action recites, at Page 29, "inherency was not utilized to state that a claim limitation was inherently present in the disclosed prior art but to state that the motivation was inherent on the basis of the claim language, itself".

As an initial matter, Applicant respectfully submits that it is facially absurd to use Applicant's claim as prior art for rejecting Applicant's claim. Moreover Applicant respectfully submits that since human interactions are not necessarily "conflict free", the assertion of the Final Office Action on Page 29 regarding "allowing the client to capture the benefits inherent in having a conflict-free agent" fails to meet the legal standard regarding inherency, namely, that benefits in having a conflict-free agent are not necessarily present in the prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of

claim 27.

28. Claim 28

Since claim 28 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 28 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “the agent receiving authority to implement the action on behalf of the client”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 28, at Pages 13-14:

Establishing the scope and/or authority of an agent in a principal-agent relationship is old and well known in the art of principal-agent relationships and agency law. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin [sic], Heath, Disclosed Prior Art and Stein to allow and/or contract for any scope of agency authority that the inventor desired.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this

rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 28.

29. Claim 29

Since claim 29 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 29 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “the client agreeing to implement actions recommended by the agent”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 29, at Page 14:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin [sic], Heath, Disclosed Prior Art and Stein to allow and/or contract for any response to the agents' recommendations/instructions that the inventor desired, such as agreement with or disregarding of agents' recommendations/instructions.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 29.

30. Claim 30

Since claim 30 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 30 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, "the client agreeing to implement actions instructed by the agent".

Thus, even if there were motivation or suggestion to modify or combine the applied

portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 30, at Page 14:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenanin [sic], Heath, Disclosed Prior Art and Stein to allow and/or contract for any response to the agents' recommendations/instructions that the inventor desired, such as agreement with or disregarding of agents' recommendations/instructions.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 30.

31. Claim 31

Since claim 31 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 31 recites, *inter alia*, yet the combined applied portions of McMEnamin, Heath, and Stein do not teach, “wherein facilitating the implementation of the action results in the negotiation of the terms of a trade”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 31, at Page 14:

Said actions are old and well known in the art of business transactions and financial management. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMEnanin [sic], Heath, Disclosed Prior Art and Stein to allow and/or contract for the agent to implement and/or determine any action that the inventor desired, such executing trades, conducting sales or manufacturing widgets.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 31.

32. Claim 32

Since claim 32 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 32 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the determination of the action includes an identification of a best rate or price at which the trade can be executed”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 32, at Page 14:

Said actions are old and well known in the art of business transactions and financial management. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenanin [sic], Heath, Disclosed Prior Art and Stein to allow and/or contract for the agent to implement and/or determine any action that the inventor desired, such as executing trades, conducting sales or manufacturing widgets.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 32.

33. Claim 33

Since claim 33 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 33, at Page 15:

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art.

In re Venner, 120 USPQ 192.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Applicant further traverses the use of the 1958 case of *In re Venner* as supporting this rejection. As indicated in Applicant's traversal of claim 1, supra, *In re Venner* predated *Graham* and as a result did not use the *Graham* analysis for obviousness, which is now required as a matter of law. Applicant respectfully submits that *In re Venner* was superseded by *Graham* to the extent that it is inconsistent therewith. Applicant again notes that the *In re Venner* has not been cited by the Federal Circuit in a single case.

In addition, Applicant respectfully submits that no *prima facie* case has been made that the claimed subject matter of 33 is taught by any combination of the applied portion of the relied upon references as "a manual activity".

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 33.

34. Claim 34

Since claim 34 depends from claim 1, Applicant respectfully incorporates by reference

each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 34 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the implementation of the action results in execution of a trade”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 34, at Page 14:

Said actions are old and well known in the art of business transactions and financial management. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin [sic], Heath, Disclosed Prior Art and Stein to allow and/or contract for the agent to implement and/or determine any action that the inventor desired, such as executing trades, conducting sales or manufacturing widgets.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 34.

35. Claim 35

Since claim 35 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 35 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the implementation of the action results in execution of a trade with a third party”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 35, at Page 14:

Said actions are old and well known in the art of business transactions and financial management. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenantin [sic], Heath, Disclosed Prior Art and Stein to allow and/or contract for the agent to implement and/or determine any action that the inventor desired, such as executing trades, conducting sales or manufacturing widgets.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 35.

36. Claim 36

Since claim 36 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 36 recites, *inter alia*, yet the combined applied portions of McMenantin, Heath, and Stein do not teach, "wherein the implementation of the action results in execution of a trade by the agent".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully

traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 36, at Page 14:

Said actions are old and well known in the art of business transactions and financial management. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenanin [sic], Heath, Disclosed Prior Art and Stein to allow and/or contract for the agent to implement and/or determine any action that the inventor desired, such as executing trades, conducting sales or manufacturing widgets.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 36.

37. Claim 37

Since claim 37 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 37 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the implementation of the action results in execution of a trade by the client”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 37, at Page 14:

Said actions are old and well known in the art of business transactions and financial management. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin [sic], Heath, Disclosed Prior Art and Stein to allow and/or contract for the agent to implement and/or determine any action that the inventor desired, such as executing trades, conducting sales or manufacturing widgets.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 37.

38. Claim 38

Since claim 38 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 38, at Page 15:

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art.

In re Venner, 120 USPQ 192.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Applicant further traverses the use of the 1958 case of *In re Venner* as supporting this rejection. As indicated in Applicant’s traversal of claim 1, supra, *In re Venner* predated *Graham* and as a result did not use the *Graham* analysis for obviousness, which is now required as a matter of law. Applicant respectfully submits that *In re Venner* was superseded by *Graham* to

the extent that it is inconsistent therewith. Applicant again notes that the *In re Venner* has not been cited by the Federal Circuit in a single case.

In addition, Applicant respectfully submits that no *prima facie* case has been made that the claimed subject matter of 38 is taught by any combination of the applied portion of the relied upon references as “a manual activity”.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 38.

39. Claim 39

Since claim 39 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 39 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial information includes financial guidelines”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or

inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 39, at Page 16:

Said financial information sources are old and well known in the art of financial analysis and strategic planning. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial information, as is old and well known, to provide ‘any additional information that may be needed to complete the review’ (see p. 15), as disclosed by McMenamin.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 39.

40. Claim 40

Since claim 40 depends from claim 1, Applicant respectfully incorporates by reference

each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 40 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial information includes one or more benchmarks”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 40, at Page 16:

Said financial information sources are old and well known in the art of financial analysis and strategic planning. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial information, as is old and well known, to provide ‘any additional information that may be needed to complete the review’ (see p. 15), as disclosed by McMenamin.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 40.

41. Claim 41

Since claim 41 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 41 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial information includes action guidelines”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 41, at Page 16:

Said financial information sources are old and well known in the art of

financial analysis and strategic planning. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial information, as is old and well known, to provide ‘any additional information that may be needed to complete the review’ (see p. 15), as disclosed by McMenamin.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 41.

42. Claim 42

Since claim 42 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 42 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial information includes market risk limits”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying

the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 42, at Page 16:

Said financial information sources are old and well known in the art of financial analysis and strategic planning. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial information, as is old and well known, to provide ‘any additional information that may be needed to complete the review’ (see p. 15), as disclosed by McMenamin.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 42.

43. Claim 43

Since claim 43 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 43 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial information includes credit risk limits”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 43, at Page 16:

Said financial information sources are old and well known in the art of financial analysis and strategic planning. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial information, as is old and well known, to provide ‘any additional information that may be needed to complete the review’ (see p. 15), as disclosed by McMenamin.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 43.

44. Claim 44

Since claim 44 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 44 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial information includes liquidity guidelines”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 44, at Page 16:

Said financial information sources are old and well known in the art of financial analysis and strategic planning. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial information, as is old and well known, to provide ‘any additional information that may be needed to complete the review’ (see p. 15), as disclosed by McMenamin.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 44.

45. Claim 45

Since claim 45 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 45 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath,

and Stein do not teach, “wherein the financial information includes maturity guidelines”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 45, at Page 16:

Said financial information sources are old and well known in the art of financial analysis and strategic planning. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial information, as is old and well known, to provide ‘any additional information that may be needed to complete the review’ (see p. 15), as disclosed by McMenamin.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 45.

46. Claim 46

Since claim 46 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 46 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial information includes credit guidelines”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 46, at Page 16:

Said financial information sources are old and well known in the art of financial analysis and strategic planning. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial information, as is old and well known, to provide ‘any additional

information that may be needed to complete the review’ (see p. 15), as disclosed by McMenamin.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 46.

47. Claim 47

Since claim 47 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 47 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes short-term funding and cash management”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or

inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 47, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenemy, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenemy, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 47.

48. Claim 48

Since claim 48 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 48 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes cashflow management”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 48, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 48.

49. Claim 49

Since claim 49 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 49 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, "wherein the financial risk management function includes liquidity management".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above,

reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 49, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenemy, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenemy, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 49.

50. Claim 50

Since claim 50 depends from claim 1, Applicant respectfully incorporates by reference

each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 50 recites, *inter alia*, yet the combined applied portions of McMnamin, Heath, and Stein do not teach, “wherein the financial risk management function includes cash management”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 50, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMnamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMnamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 50.

51. Claim 51

Since claim 51 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 51 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes investment management”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 51, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMEnamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMEnamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 51.

52. Claim 52

Since claim 52 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 52 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes repo (repurchase agreement) funding”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 52, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill

in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 52.

53. Claim 53

Since claim 53 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 53 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes debt management”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 53, at Pages

18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenemy, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenemy, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 53.

54. Claim 54

Since claim 54 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 54 recites, *inter alia*, yet the combined applied portions of McMenemy, Heath,

and Stein do not teach, “wherein the financial risk management function includes debt issuance”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 54, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenemy, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenemy, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 54.

55. Claim 55

Since claim 55 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 55 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes asset and liability management”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 55, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person,

or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenemy, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenemy, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 55.

56. Claim 56

Since claim 56 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 56 recites, *inter alia*, yet the combined applied portions of McMenemy, Heath, and Stein do not teach, "wherein the financial risk management function includes asset and liability management and wherein the assets include insurance premia".

Thus, even if there were motivation or suggestion to modify or combine the applied

portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 56, at Pages 19-20:

Said assets and liabilities, and their use in asset and liability management, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said assets and liabilities, as are old and well known, into the asset and liability management process, allowing for accurate and precise computations and, therefore, accurate and precise asset and liabilities management decisions.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 56.

57. Claim 57

Since claim 57 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 57 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes asset and liability management and wherein the liabilities include insurance claims”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 57, at Pages 19-20:

Said assets and liabilities, and their use in asset and liability management, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said assets and liabilities, as are

old and well known, into the asset and liability management process, allowing for accurate and precise computations and, therefore, accurate and precise asset and liabilities management decisions.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 57.

58. Claim 58

Since claim 58 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 58 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, "wherein the financial risk management function includes asset and liability management and wherein the assets include life insurance premia".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as

attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 58, at Pages 19-20:

Said assets and liabilities, and their use in asset and liability management, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said assets and liabilities, as are old and well known, into the asset and liability management process, allowing for accurate and precise computations and, therefore, accurate and precise asset and liabilities management decisions.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 58.

59. Claim 59

Since claim 59 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 59 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes asset and liability management and wherein the liabilities include life insurance claims”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 59, at Pages 19-20:

Said assets and liabilities, and their use in asset and liability management, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said assets and liabilities, as are old and well known, into the asset and liability management process, allowing for accurate and precise computations and, therefore, accurate and precise asset and liabilities management decisions.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this

rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 59.

60. Claim 60

Since claim 60 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 60 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes asset and liability management and wherein the liabilities include pension claims”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 60, at Pages 19-20:

Said assets and liabilities, and their use in asset and liability management, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said assets and liabilities, as are old and well known, into the asset and liability management process, allowing for accurate and precise computations and, therefore, accurate and precise asset and liabilities management decisions.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 60.

61. Claim 61

Since claim 61 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 61 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes asset and liability management and wherein the liabilities include legal claims”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 61, at Pages 19-20:

Said assets and liabilities, and their use in asset and liability management, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said assets and liabilities, as are old and well known, into the asset and liability management process, allowing for accurate and precise computations and, therefore, accurate and precise asset and liabilities management decisions.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;
“select the teachings of [the] separate references”; or
“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 61.

62. Claim 62

Since claim 62 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 62 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes asset and liability management wherein the assets include leases”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 62, at Pages 19-20:

Said assets and liabilities, and their use in asset and liability management, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said assets and liabilities, as are old and well known, into the asset and liability management process, allowing for accurate and precise computations and, therefore, accurate and precise asset and liabilities management decisions.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 62.

63. Claim 63

Since claim 63 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 63 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, "wherein the financial risk management function includes asset and liability management wherein the liabilities include leases".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 63, at Pages 19-20:

Said assets and liabilities, and their use in asset and liability management, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said assets and liabilities, as are old and well known, into the asset and liability management process, allowing for accurate and precise computations and, therefore, accurate and precise asset and liabilities management decisions.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 63.

64. Claim 64

Since claim 64 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 64 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes asset and liability management wherein the assets include operational cashflows”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 64, at Pages 19-20:

Said assets and liabilities, and their use in asset and liability management, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath,

Disclosed Prior Art and Stein by incorporating said assets and liabilities, as are old and well known, into the asset and liability management process, allowing for accurate and precise computations and, therefore, accurate and precise asset and liabilities management decisions.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 64.

65. Claim 65

Since claim 65 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 65 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, "wherein the financial risk management function includes asset and liability management wherein the liabilities include operational cashflows".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is

respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 65, at Pages 19-20:

Said assets and liabilities, and their use in asset and liability management, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said assets and liabilities, as are old and well known, into the asset and liability management process, allowing for accurate and precise computations and, therefore, accurate and precise asset and liabilities management decisions.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 65.

66. Claim 66

Since claim 66 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 66 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes treasury management”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 66, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard

computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 66.

67. Claim 67

Since claim 67 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 67 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, "wherein the financial risk management function includes credit management".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a

prima facie case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 67, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 67.

68. Claim 68

Since claim 68 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 68 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes credit spread trading”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 68, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 68.

69. Claim 69

Since claim 69 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 69 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, "wherein the financial risk management function includes loan portfolio management".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above,

reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 69, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 69.

70. Claim 70

Since claim 70 depends from claim 1, Applicant respectfully incorporates by reference

each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 70 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes equity portfolio management”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 70, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 70.

71. Claim 71

Since claim 71 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 71 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes fixed income portfolio management”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 71, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 71.

72. Claim 72

Since claim 72 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 72 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes funding”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 72, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;
“select the teachings of [the] separate references”; or
“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 72.

73. Claim 73

Since claim 73 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 73 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes collateral management”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 73, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenemy, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenemy, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 73.

74. Claim 74

Since claim 74 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 74 recites, *inter alia*, yet the combined applied portions of McMenemy, Heath, and Stein do not teach, "wherein the financial risk management function includes the lending of

securities”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 74, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 74.

75. Claim 75

Since claim 75 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 75 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes the borrowing of securities”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 75, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person,

or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenemy, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenemy, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 75.

76. Claim 76

Since claim 76 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 76 recites, *inter alia*, yet the combined applied portions of McMenemy, Heath, and Stein do not teach, "wherein the financial risk management function includes counterparty credit exposure management".

Thus, even if there were motivation or suggestion to modify or combine the applied

portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 76, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenemy, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenemy, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 76.

77. Claim 77

Since claim 77 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 77 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes financial risk management”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 77, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one

of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 77.

78. Claim 78

Since claim 78 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 78 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, "wherein the financial risk management function includes market risk management".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying

the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 78, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 78.

79. Claim 79

Since claim 79 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 79 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes credit risk management”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 79, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified

McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 79.

80. Claim 80

Since claim 80 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 80 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, "wherein the financial risk management function includes commodity price risk management".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is

respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 80, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of

claim 80.

81. Claim 81

Since claim 81 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 81 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes liquidity risk management”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 81, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management

process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 81.

82. Claim 82

Since claim 82 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 82 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, "wherein the financial risk management function includes operational risk management".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or

inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 82, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenemy, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenemy, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 82.

83. Claim 83

Since claim 83 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 83 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes management of insurable risks”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 83, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 83.

84. Claim 84

Since claim 84 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 84 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, "wherein the financial risk management function includes electricity price risk management".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above,

reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 84, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenemy, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenemy, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 84.

85. Claim 85

Since claim 85 depends from claim 1, Applicant respectfully incorporates by reference

each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 85 recites, *inter alia*, yet the combined applied portions of McMnamin, Heath, and Stein do not teach, “wherein the financial risk management function includes pension fund management”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 85, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMnamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMnamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 85.

86. Claim 86

Since claim 86 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 86 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes real estate management”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 86, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 86.

87. Claim 87

Since claim 87 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 87 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes hedging”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 87, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;
“select the teachings of [the] separate references”; or
“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 87.

88. Claim 88

Since claim 88 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 88 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes dynamic hedging”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 88, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenemy, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenemy, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 88.

89. Claim 89

Since claim 89 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 89 recites, *inter alia*, yet the combined applied portions of McMenemy, Heath, and Stein do not teach, "wherein the financial risk management function includes mortgage pre-

portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 89, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

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payment risk management”.

Thus, even if there were motivation or suggestion to modify or combine the applied

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 89.

90. Claim 90

Since claim 90 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 90 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes front-office activities”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 90, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person,

or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenemy, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenemy, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 90.

91. Claim 91

Since claim 91 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 91 recites, *inter alia*, yet the combined applied portions of McMenemy, Heath, and Stein do not teach, "wherein the financial risk management function includes middle-office activities".

Thus, even if there were motivation or suggestion to modify or combine the applied

portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 91, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 91.

92. Claim 92

Since claim 92 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 92 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes back-office activities”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 92, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one

of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 92.

93. Claim 93

Since claim 93 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 93 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, "wherein the financial risk management function includes front-office and middle-office activities".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying

the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 93, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenemy, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenemy, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 93.

94. Claim 94

Since claim 94 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 94 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial risk management function includes middle-office and back-office activities”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 94, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified

McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenamin, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 94.

95. Claim 95

Since claim 95 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 95 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, "wherein the financial risk management function includes front-office, middle-office and back-office activities".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is

respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 95, at Pages 18-19:

Said financial functions, either as a manual function, utilizing pen and paper, a mental function, performing mental computations within the head of a person, or as a computerized function, are old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenemy, Heath, Disclosed Prior Art and Stein by incorporating said financial functions, as are old and well known, into the financial management process, as disclosed by McMenemy, allowing the application of standard computations and financial processing into the financial management process.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of

claim 95.

96. Claim 96

Since claim 96 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 96 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial information includes detailed information on financial instruments relevant to a financial risk management function”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 96, at Page 20:

Said financial information, and their use in a financial function and/or financial decision making process, is old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial information, as are old and well known, as incoming information in the financial management process, as disclosed by McMenamin, allowing for

accurate and precise computations and, therefore, accurate and precise asset and liabilities management decisions.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 96.

97. Claim 97

Since claim 97 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 97 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, "wherein the financial information includes historical market data relevant to the financial risk management function".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or

inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 97, at Pages 18-19:

Said financial information, and their use in a financial function and/or financial decision making process, is old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenemy, Heath, Disclosed Prior Art and Stein by incorporating said financial information, as are old and well known, as incoming information in the financial management process, as disclosed by McMenemy, allowing for accurate and precise computations and, therefore, accurate and precise asset and liabilities management decisions.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 97.

98. Claim 98

Since claim 98 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 98 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial information includes current market data relevant to the financial risk management function”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 98, at Pages 18-19:

Said financial information, and their use in a financial function and/or financial decision making process, is old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial information, as are old and well known, as incoming information in the financial management process, as disclosed by McMenamin, allowing for accurate and precise computations and, therefore, accurate and precise asset and liabilities management decisions.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 98.

99. Claim 99

Since claim 99 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 99 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, "wherein the financial information includes economic information relevant to the financial risk management function".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above,

reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 99, at Pages 18-19:

Said financial information, and their use in a financial function and/or financial decision making process, is old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenemy, Heath, Disclosed Prior Art and Stein by incorporating said financial information, as are old and well known, as incoming information in the financial management process, as disclosed by McMenemy, allowing for accurate and precise computations and, therefore, accurate and precise asset and liabilities management decisions.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 99.

100. Claim 100

Since claim 100 depends from claim 1, Applicant respectfully incorporates by reference

each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 100 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial information includes information relevant to the financial risk management function”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 100, at Pages 18-19:

Said financial information, and their use in a financial function and/or financial decision making process, is old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating said financial information, as are old and well known, as incoming information in the financial management process, as disclosed by McMenamin, allowing for accurate and precise computations and, therefore, accurate and precise asset and liabilities management decisions.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 100.

101. Claim 101

Since claim 101 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 101 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the financial information includes strategic financial objectives”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 101, at Pages 18-19:

Said financial information, and their use in a financial function and/or financial decision making process, is old and well known in the arts of financial management and accounting management. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenemy, Heath, Disclosed Prior Art and Stein by incorporating said financial information, as are old and well known, as incoming information in the financial management process, as disclosed by McMenemy, allowing for accurate and precise computations and, therefore, accurate and precise asset and liabilities management decisions.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 101.

102. Claim 102

Since claim 102 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 102 recites, *inter alia*, yet the combined applied portions of McMnamin, Heath, and Stein do not teach, “wherein the client includes departments of the client”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 102, at Page 21:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMnamin, Heath, Disclosed Prior Art and Stein to allow for any client that the inventor desired.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 102.

103. Claim 103

Since claim 103 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 103 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the client includes subsidiaries of the client”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 103, at Page 21:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein to allow for any client that the inventor desired.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any

“suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 103.

104. Claim 104

Since claim 104 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 104 recites, *inter alia*, yet the combined applied portions of McMnamin, Heath, and Stein do not teach, “wherein the client includes affiliates of the client”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 104, at Page

21:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein to allow for any client that the inventor desired.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 104.

105. Claim 105

Since claim 105 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 105 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, "wherein the client includes clients of the client".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as

attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 105, at Page 21:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein to allow for any client that the inventor desired.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 105.

106. Claim 106

Since claim 106 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 106 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the client includes regulators of the client”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 106, at Page 21:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein to allow for any client that the inventor desired.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 106.

107. Claim 107

Since claim 107 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 107 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the client includes auditors of the client”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 107, at Page 21:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein to allow for any client that the inventor desired.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any

“suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 107.

108. Claim 108

Since claim 108 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 108 recites, *inter alia*, yet the combined applied portions of McMnamin, Heath, and Stein do not teach, “wherein the client includes agents of the client”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 108, at Page

21:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein to allow for any client that the inventor desired.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 108.

109. Claim 109

Since claim 109 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 109 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, "wherein the client includes advisors of the client".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as

attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 109, at Page 21:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenemy, Heath, Disclosed Prior Art and Stein to allow for any client that the inventor desired.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 109.

110. Claim 110

Since claim 110 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 110 recites, *inter alia*, yet the combined applied portions of McMEnamin, Heath, and Stein do not teach, “wherein the client includes counterparties of the client”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 110, at Page 21:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMEnamin, Heath, Disclosed Prior Art and Stein to allow for any client that the inventor desired.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 110.

111. Claim 111

Since claim 111 depends from claim 1, Applicant respectfully incorporates by reference each rejection traversal regarding claim 1.

a) Missing Claim Limitations

Claim 111 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, “wherein the client includes shareholders of the client”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 111, at Page 21:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein to allow for any client that the inventor desired.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any

“suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 111.

112. Claim 112

a) Claim Construction

In the present Application, the customary meaning for the phrase “financial risk management function” is implicitly defined in the specification and the properly cited prior art. That definition must control examination of those claims that recite this phrase.

At least at page 1, lines 5-7, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]he present invention relates to the field of financial risk management and trading, and, **more particularly**, to a method and system for clients to outsource financial functions to an agent.”

At least at page 2, lines 16-17, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]ypical financial functions are treasury, credit management, risk management, and trading, together with several of their associated sub-functions.”

At least at page 3, lines 1-3, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]he activities that make up these financial functions are the relevant daily operations of the front-office trading departments and the associated middle-office risk management and back-office support departments.”

Thus, the phrase “financial risk management function” should be construed as one of ordinary skill in the relevant art would interpret the definition provided in the specification.

Applicant respectfully notes a discussion regarding lexicography on Pages 26-27 of the Final Office Action. Page 26 of the Final Office Action recites:

Although the argued elements are found as examples and/or embodiments in the specification, they were not claimed explicitly in the disputed claim(s). Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. Therefore although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed Cir. 1993) and MPEP §2111.01.

Furthermore, while applicants may be their own lexicographer, any special meaning assigned to a term ‘must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.’ *See Multiform Desiccants Inc v. Medzam Ltd.*, 133 F3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). Examiner asserts that the specification fails to indicate a clear or obvious departure from the common and ordinary definition of the disputed claim term, and, therefore, the common and ordinary definition of the disputed claim term was properly utilized for application of prior art.

Applicant respectfully notes that *Phillips*, as an *en banc* decision, supersedes any prior or subsequent Federal Circuit case adjudicated by any panel that is not *en banc*. As a result, to the extent that *In re Van Geuns*, *Multiform*, or *In re Prater* differs from *Phillips*, they have been superseded thereby. The Final Office Action further alleges at pages 26-27:

For example, the specification states ‘[t]he present invention relates to the field of financial risk management and trading, and, more particularly, to a method and system for clients to outsource financial functions to an agent.’ (see p. 1, lines 5 - 7). Such statements indicate that the “financial functions” are a subset of “financial risk management” functions. However, the specification

also states “[t]ypical financial functions are treasury, credit management, risk management, and trading, together with several of their associated sub-functions.” (emphasis added - see p 2, lines 16 - 17). Such statement indicates that “risk management” functions are a subset of “financial functions.” Such a contradiction falls far short of a clearly expressed desire to define claim terminology.

Applicant respectfully traverses this argument as fallacious. It is not necessarily follow that the phrase “[t]he present invention relates to the field of financial risk management and trading, and, more particularly, to a method and system for clients to outsource financial functions to an agent” necessarily means that “financial functions” are a subset of “financial risk management” or of “financial risk management” functions. Thus, the above-recited allegation of the Final Office Action lacks a proper foundation and is not valid.

Accordingly, Applicant respectfully submits that claim construction regarding the phrase “financial risk management function” must be construed as one of ordinary skill in the relevant art would interpret that phrase as defined and/or guided by the specification. Since the Final Office Action fails to provide such a construction, Applicant respectfully requests a reversal of the rejection of claim 112.

b) Official Notice

The Final Office Action alleges, at Pages 27-28, that Applicants Office Action Reply dated 11 April 2006:

In response to the applicant's traversal of Official Notice finding(s) in previous office action, examiner asserts that the traversal is inadequate Adequate traversal is a two-step process. First, applicant(s) must state their traversal on the record. Second and in accordance with 37 C.F.R. 1.111(b) which requires applicant(s) to specifically point out the supposed errors in the Office Action, applicant(s) must state why the Official Notice statement(s) are not to be considered common knowledge or well known in the art.

In this application, while applicant(s) have clearly met step (1), applicant(s) have failed step (2) since they have failed to argue why the Official Notice

statement(s) are not to be considered common knowledge or well known in the art. Because Applicant(s)' traversal is inadequate, the Official Notice statement(s) are taken to be admitted as prior art. See MPEP 2144.03.

In the applicant's response, the applicant merely made a blanket statement that '(to the extent that Official Notice is explicitly or implicitly utilized to support any rejection' and failed to even specify which claims the applicant is contesting, never mind articulating a basis for the applicant's arguments against the taking of Official Notice.

For example, should the applicant decide to traverse the taking of Official Notice in regards to Claim 39, applicant should argue that it is not common knowledge nor well known in the art to utilize financial information including financial guidelines when making a financial decision. Or should the applicant decide to traverse the taking of Official Notice in regards to Claim 48, applicant should argue that it is not common knowledge nor well known in the art that financial management, either manual or automated financial management, involves cashflow management

Applicant respectfully traverses these allegations. Applicant respectfully notes that the phrase "Official Notice" does not appear whatsoever in any of the claim rejections of the Final Office Action or the prior Office Action dated 13 January 2006. Applicant respectfully submits that if, indeed, it was the intention of either Office Action to take Official Notice regarding any of the articulated grounds of rejection, that both Office Actions utterly fail to comply with the requirements of MPEP § 707.07(d) since neither provides "ground[s] of rejection [that are] fully and clearly stated". For example, if either Office Action intended to rely upon Official Notice for rejecting claim 39 and/or claim 48, as implied on Page 28 of the Final Office Action, each respective Office Action based thereupon was required to clearly state Official Notice as a grounds of rejection for each of those claims. Applicant respectfully notes that neither 37 C.F.R. 1.111 nor the MPEP require Applicant to be clairvoyant regarding the grounds of rejection of an Office Action.

Applicant respectfully submits that the Office Action Reply dated 11 April 2006 was "reduced to a writing" and "distinctly and specifically point[ed] out the supposed errors in the

examiner's action" and "repl[ied] to every ground of objection and rejection in the prior Office action." As such, the Office Action Reply dated 11 April 2006 fully complied with 37 C.F.R. 1.111(b). Applicant respectfully submits that the allegations of the Final Office Action such as, *inter alia*, "should the applicant decide to traverse the taking of Official Notice in regards to Claim 39, applicant should argue that it is not common knowledge nor well known in the art to utilize financial information including financial guidelines when making a financial decision", are without legal basis under 37 C.F.R. 1.111(b).

In addition, since Applicant has traversed the use of Official Notice, to the extent that Official Notice was used in rejecting the claims, "the examiner **must provide documentary evidence in the next Office Action** if the rejection is to be maintained. *See* 37 CFR 1.104(c)(2) and MPEP 2144.03C. *See also In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Since the Final Office Action utterly fails to provide any such reference for any claim, and appears to indicate that Official Notice was used in the rejections (at least of claims 27-32, 34-37, 39-111, 131, and 132, *see* Page 33), Applicant respectfully submits that each rejection based upon Official Notice must be reversed for at least that reason.

c) Inherency

To the extent that either Office Action relied on inherency to support a claim rejection, Applicant respectfully traverses and requests a reversal of each rejection based thereon since a detailed explanation has not been provided demonstrating that the "missing descriptive material is necessarily present, not merely probably or possibly present", in any prior art reference cited to supporting such rejection.

d) Allegedly "Disclosed Prior Art"

The Final Office Action asserts, "applicant's specification, pp. 1-2" is "Disclosed Prior Art". Applicant respectfully traverses this assertion.

Although Applicant has submitted multiple Information Disclosure Statements that potentially list "prior art", Applicant does **not** admit that pages 1-2 of Applicant's specification describe "prior art", nor has any evidence been presented that any aspect of pages 1-2 of Applicant's specification can be used as prior art. Thus, no statement on pages 1-2 of

Applicant's specification can serve as a proper basis for claim rejections under 35 U.S.C. 103(a) and the attempt to do so in the Final Office Action is improper and should be withdrawn.

The Final Office Action alleges, at Page 28:

In response to the applicant's argument that the specification does not constitute Disclosed Prior Art, the MPEP states that when "the specification's background of the invention describes information as being known or conventional, [it] may be considered as an admission of prior art." MPEP § 704.11 (a). To that end, the background does utilize terminology that indicates the disclosed information is known or conventional through the use of language such as "commonly", "frequently", conventionally" and/or "traditionally." Therefore, examiner asserts that information contained within the specification under the title "Background of the Invention" is an admission of prior art and, therefore, Disclosed Prior Art.

With all due respect, the Federal Circuit has held that "[o]ne's own work may **not** be considered prior art in the absence of a statutory basis". The MPEP is not a statute, nor does it have sufficient legal authority to overcome a Federal Circuit holding. Applicant respectfully submits that the Final Office Action provides no statutory basis for the use of Applicant's disclosure as prior art.

e) Missing *Claim* Limitations

Claim 112 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach or suggest, expressly or inherently, a **"computer-readable medium storing instructions that, when executed by one or more processors, cause the one or more processors to perform activities comprising: relating to a financial risk management function of each of a plurality of institutional or corporate clients: demonstrating that more than one activity of the agent is transparent to the client"**.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is

respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

f) No Motivation or Suggestion to Combine the Applied References

Instead, regarding selected proffered combinations, the Final Office Action improperly states that “McMenamin discloses a method for providing financial functions (financial management)”. This is a mischaracterization of McMenamin and the claimed subject matter. At most, the cited portions of McMenamin allegedly provide an “introduction” to “financial management”. The cited portions of McMenamin do not teach or disclose any “computer-assisted methods” for providing “financial risk management functions” by “an agent”, and Applicant respectfully submits that Office Action presents no reasons, and certainly no “concrete evidence” that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from McMenamin.

The Final Office Action asserts, at Page 4:

McMenamin does not teach that providing financial functions comprising said steps is automated. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Applicant respectfully points out that *In re Venner* was decided in 1958. As such, *In re Venner* did not apply the *Graham* test, *see supra*, regarding obviousness. As a result, Applicant respectfully submits that no evidence is presented that the proposition for which *In re Venner* is cited is still valid law. Applicant respectfully notes that the Federal Circuit has failed to cite *In re Venner* in any case whatsoever. Moreover, even if *In re Venner* were still valid for the point of law for which it is presented, no *prima facie* case is presented that the claimed subject matter of the present application is disclosed in any of the applied portions of the relied upon references

as a “manual activity that accomplishes the same result.”

Moreover, Applicant respectfully submits that Office Action presents no reasons that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from Heath. Instead, it seems quite likely that one of skill in the art would instantly reject Heath as completely irrelevant, since Heath is a reference allegedly directed to the “public policy challenges” facing “organizations”, rather than “financial risk management functions”. Heath explains that “the heart of issues management 'is reconciliation of conflicting internal interests on public policy issues of strategic importance in order to make a coherent external advocacy'”. Applicant respectfully asks how the “reconciliation of conflicting internal interests on public policy issues” relates in the least to the claimed subject matter? Applicant also respectfully asks where is the concrete evidence that Heath is “within the field of the inventor’s endeavor”, and if not, “is reasonably pertinent to the **particular problem** with which the inventor was involved”?

Similarly, Applicant respectfully submits that Office Action presents no reasons, and certainly no “concrete evidence”, that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from Stein.

Furthermore, even assuming, *arguendo*, that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” McMenamin, Heath, and Stein, the Office Action presents no concrete evidence of a suggestion, motivation, or teaching **in the prior art** that would have led a person of ordinary skill in the art to combine these references in the manner claimed.

In addition, Applicant respectfully notes that the Final Office Action impermissibly relies on Applicant’s disclosure on Page 5 in rejecting claim 112. As noted, *supra*, Applicant does not admit that any of contents of the present Application is prior art. Accordingly, Applicant respectfully traverses the impermissible use of “p. 2, lines 4-9) of the present Application as prior art by the Final Office Action.

The Final Office Action asserts at Pages 30 and 31:

In response to applicant's argument that there is no suggestion to combine the references, the Courts have stated that “[a]suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly

in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references ... The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art ... there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (emphasis added). *In re Kahn*, 78 USPQ2d 1329, 1336 (CA FC 2006). Examiner asserts that he can and/or has provided such “articulated reasoning to support the legal conclusion of obviousness.

Applicant respectfully submits that the legal analysis presented in *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006), requires that “underlying factual findings” of the USPTO, “including a finding of a motivation to combine” must be supported by “substantial evidence *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000)). Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence. *Id.* at 1312 (citing *Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229-30 (1938)). According to the Federal Circuit “[t]he presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact.” *Alza Corp. v. Mylan Laboratories, Inc.*, 2006 U.S. App. LEXIS 22616 (Fed. Cir. 2006) (citing *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000)); accord *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 (Fed. Cir. 2000). Likewise, the presence or absence of a “reasonable expectation of success” from making such a combination is also a pure question of fact. *Alza Corp. v. Mylan Laboratories, Inc.*, 2006 U.S. App. LEXIS 22616 (Fed. Cir. 2006) (citing *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006)).

The allegations of the Final Office Action regarding the alleged suggestions or motivations for modifying and/or combining references comprise little more than bald assertions and do not appear to be supported by even a “mere scintilla of evidence”. That is, the Final Office Action presents **no factual basis** upon which the allegations regarding suggestions or motivations to combine references are based. Applicant respectfully reiterates that a “bald assertion of knowledge generally available to one of ordinary skill in the art to bridge the evidentiary gap is improper. Such unfounded assertions are not permissible substitutes for evidence. *See In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). In other

words, deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.*

For at least this reason, Applicant respectfully submits that the allegations responding to Applicant's argument presented in the Office Action Reply dated 11 April 2006 are unsupported and fail to provide any evidentiary support regarding any suggestion or motivation to combine the applied portions of the relied upon references.

g) No Reasonable Expectation of Success

The Final Office Action attempts to, impermissibly, combine portions of Applicants own disclosure and three additional references in rejecting claim 1, McMenamin, Heath, and Stein.

Applicant respectfully submits that McMenamin is allegedly directed to an "introduction to the basic principles, practices and concepts of modern financial management." *See* Page 1.

By contrast, Heath is allegedly directed toward "issues management", which is described as "the product of turbulent criticism and change that angry publics seek to impose on business policies and practices." *See* Page 1.

In further contrast, Stein's Abstract allegedly recites that:

[a] supervisory control system for a networked multimedia computing system permits a teacher or network administrator to quickly and easily update system software on selected destination workstations with the system software currently residing on the master workstation. In one mode of operation, only basic system software is updated, while user-defined preferences are unchanged. In a second mode of operation, both the system software and all user-controlled settings are replaced, to permit the remote workstations to be configured in a desired manner.

Applicant's disclosure is not available as a reference and even if it was, doesn't overcome the deficiencies of the applied portions of the remaining relied upon references.

The Final Office Action presents no evidence that one having ordinary skill in the art would have had any expectation of success, let alone a reasonable expectation of success, in combining the applied portions of the relied upon references. At most, the applied portions of

the relied upon references provide “only general guidance as to the particular form of the claimed invention or how to achieve it.”

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, expressly or inherently teach or suggest **every** limitation of claim 1 (another assumption that is respectfully traversed), there is still no evidence indicating a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action, and consequently, the Office Action fails to establish a *prima facie* case of obviousness.

h) Improper Reliance on *In re Venner*

The Final Office Action recites, at Pages 33-34:

Now to the argued claim limitations specifically, a known manual financial decision-making methodology was disclosed by McMenamin. Such prior art reference was modified through automation via *In re Venner*, to capture the benefits natural to such automation - speed, uniformity and/or reliability. Automation would have constituted the use of a computer to make such automation possible, an argument buttressed by the use of a computer network, as disclosed by Stein. The outsourcing of this financial function, either the outsourcing of the manual or the computerized process, would have been obvious in light of Disclosed Prior Art. Finally, a supervision system that allowed management to oversee their agents and/or employees at their individual workstations, is disclosed by Stein, serving to monitor and provide transparency concerning the actions of the agents.

Applicant again traverses the continued use of *In re Venner* in the rejection of any of the claimed subject matter of the present Application. Applicant reiterates that, as a case decided in 1958, *In re Venner* fails to properly consider the Graham factors regarding obviousness. As such it is no longer binding precedent and has at least been superseded by *Graham*.

i) Improper Reliance on Stein as a Reference

A proper Office Action must be complete as to all matters, must provide a clear explanation of all actions taken, and **must answer in detail** the substance of each of Applicant's submitted arguments (emphasis added). *See* MPEP 707.07(f).

In the Office Action Reply dated 11 April 2006, Applicant respectfully stated, at Page 30, "[s]imilarly, Applicant respectfully submits that Office Action presents no reasons, and certainly no "concrete evidence", that "the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select" anything from Stein. The Final Office Action is silent regarding this argument.

Stein allegedly recites, at the Abstract:

A supervisory control system for a networked multimedia computing system permits a teacher or network administrator to quickly and easily update system software on selected destination workstations with the system software currently residing on the master workstation. In one mode of operation, only basic system software is updated, while user-defined preferences are unchanged. In a second mode of operation, both the system software and all user-controlled settings are replaced, to permit the remote workstations to be configured in a desired manner.

No argument is advanced in either Office Action as to why one skilled in the art would select a reference directed to updating "basic system software" and "system software and all user-controlled settings" in a method relating to financial risk management.

Since the Final Office Action is silent regarding the argument regarding Stein, Applicant submits that the Final Office Action concedes that "the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention" would not select anything from Stein.

j) Conclusion

For at least the reasons mentioned above, a reversal of the rejection of claim 112 is respectfully requested.

113. Claim 113**a) Claim Construction**

In the present Application, the customary meaning for the phrase “financial risk management function” is implicitly defined in the specification and the properly cited prior art. That definition must control examination of those claims that recite this phrase.

At least at page 1, lines 5-7, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]he present invention relates to the field of financial risk management and trading, and, **more particularly**, to a method and system for clients to outsource financial functions to an agent.”

At least at page 2, lines 16-17, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]ypical financial functions are treasury, credit management, risk management, and trading, together with several of their associated sub-functions.”

At least at page 3, lines 1-3, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]he activities that make up these financial functions are the relevant daily operations of the front-office trading departments and the associated middle-office risk management and back-office support departments.”

Thus, the phrase “financial risk management function” should be construed as one of ordinary skill in the relevant art would interpret the definition provided in the specification.

Applicant respectfully notes a discussion regarding lexicography on Pages 26-27 of the Final Office Action. Page 26 of the Final Office Action recites:

Although the argued elements are found as examples and/or embodiments in the specification, they were not claimed explicitly in the disputed claim(s). Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. Therefore although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed Cir.

1993) and MPEP §2111.01.

Furthermore, while applicants may be their own lexicographer, any special meaning assigned to a term ‘must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.’ See *Multiform Desiccants Inc v. Medzam Ltd.*, 133 F3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). Examiner asserts that the specification fails to indicate a clear or obvious departure from the common and ordinary definition of the disputed claim term, and, therefore, the common and ordinary definition of the disputed claim term was properly utilized for application of prior art.

Applicant respectfully notes that *Phillips*, as an *en banc* decision, supersedes any prior or subsequent Federal Circuit case adjudicated by any panel that is not *en banc*. As a result, to the extent that *In re Van Geuns*, *Multiform*, or *In re Prater* differs from *Phillips*, they have been superseded thereby. The Final Office Action further alleges at pages 26-27:

For example, the specification states ‘[t]he present invention relates to the field of financial risk management and trading, and, more particularly, to a method and system for clients to outsource financial functions to an agent.’ (see p. 1, lines 5 - 7). Such statements indicate that the “financial functions” are a subset of “financial risk management” functions. However, the specification also states “[t]ypical financial functions are treasury, credit management, risk management, and trading, together with several of their associated sub-functions.” (emphasis added - see p 2, lines 16 - 17). Such statement indicates that “risk management” functions are a subset of “financial functions.” Such a contradiction falls far short of a clearly expressed desire to define claim terminology.

Applicant respectfully traverses this argument as fallacious. It is not necessarily follow that the phrase “[t]he present invention relates to the field of financial risk management and trading, and, more particularly, to a method and system for clients to outsource financial functions to an agent” necessarily means that “financial functions” are a

subset of “financial risk management” or of “financial risk management” functions. Thus, the above-recited allegation of the Final Office Action lacks a proper foundation and is not valid.

Accordingly, Applicant respectfully submits that claim construction regarding the phrase “financial risk management function” must be construed as one of ordinary skill in the relevant art would interpret that phrase as defined and/or guided by the specification. Since the Final Office Action fails to provide such a construction, Applicant respectfully requests a reversal of the rejection of claim 113.

b) Official Notice

The Final Office Action alleges, at Pages 27-28, that Applicants Office Action Reply dated 11 April 2006:

In response to the applicant's traversal of Official Notice finding(s) in previous office action, examiner asserts that the traversal is inadequate Adequate traversal is a two-step process. First, applicant(s) must state their traversal on the record. Second and in accordance with 37 C.F.R. 1.111(b) which requires applicant(s) to specifically point out the supposed errors in the Office Action, applicant(s) must state why the Official Notice statement(s) are not to be considered common knowledge or well known in the art.

In this application, while applicant(s) have clearly met step (1), applicant(s) have failed step (2) since they have failed to argue why the Official Notice statement(s) are not to be considered common knowledge or well known in the art. Because Applicant(s)' traversal is inadequate, the Official Notice statement(s) are taken to be admitted as prior art. See MPEP 2144.03.

In the applicant's response, the applicant merely made a blanket statement that '(to the extent that Official Notice is explicitly or implicitly utilized to support any rejection' and failed to even specify which claims the applicant is contesting, never mind articulating a basis for the applicant's arguments against the taking of Official Notice.

For example, should the applicant decide to traverse the taking of Official Notice in regards to Claim 39, applicant should argue that it is not common

knowledge nor well known in the art to utilize financial information including financial guidelines when making a financial decision. Or should the applicant decide to traverse the taking of Official Notice in regards to Claim 48, applicant should argue that it is not common knowledge nor well known in the art that financial management, either manual or automated financial management, involves cashflow management

Applicant respectfully traverses these allegations. Applicant respectfully notes that the phrase "Official Notice" does not appear whatsoever in any of the claim rejections of the Final Office Action or the prior Office Action dated 13 January 2006. Applicant respectfully submits that if, indeed, it was the intention of either Office Action to take Official Notice regarding any of the articulated grounds of rejection, that both Office Actions utterly fail to comply with the requirements of MPEP § 707.07(d) since neither provides "ground[s] of rejection [that are] fully and clearly stated". For example, if either Office Action intended to rely upon Official Notice for rejecting claim 39 and/or claim 48, as implied on Page 28 of the Final Office Action, each respective Office Action based thereupon was required to clearly state Official Notice as a grounds of rejection for each of those claims. Applicant respectfully notes that neither 37 C.F.R. 1.111 nor the MPEP require Applicant to be clairvoyant regarding the grounds of rejection of an Office Action.

Applicant respectfully submits that the Office Action Reply dated 11 April 2006 was "reduced to a writing" and "distinctly and specifically point[ed] out the supposed errors in the examiner's action" and "repl[ied] to every ground of objection and rejection in the prior Office action." As such, the Office Action Reply dated 11 April 2006 fully complied with 37 C.F.R. 1.111(b). Applicant respectfully submits that the allegations of the Final Office Action such as, *inter alia*, "should the applicant decide to traverse the taking of Official Notice in regards to Claim 39, applicant should argue that it is not common knowledge nor well known in the art to utilize financial information including financial guidelines when making a financial decision", are without legal basis under 37 C.F.R. 1.111(b).

In addition, since Applicant has traversed the use of Official Notice, to the extent that Official Notice was used in rejecting the claims, "the examiner **must provide documentary evidence in the next Office Action** if the rejection is to be maintained. *See* 37 CFR 1.104(c)(2)

and MPEP 2144.03C. *See also In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Since the Final Office Action utterly fails to provide any such reference for any claim, and appears to indicate that Official Notice was used in the rejections (at least of claims 27-32, 34-37, 39-111, 131, and 132, *see* Page 33), Applicant respectfully submits that each rejection based upon Official Notice must be reversed for at least that reason.

c) Inherency

To the extent that either Office Action relied on inherency to support a claim rejection, Applicant respectfully traverses and requests a reversal of each rejection based thereon since a detailed explanation has not been provided demonstrating that the “missing descriptive material is necessarily present, not merely probably or possibly present”, in any prior art reference cited to supporting such rejection.

d) Allegedly “Disclosed Prior Art”

The Final Office Action asserts, “applicant’s specification, pp. 1-2” is “Disclosed Prior Art”. Applicant respectfully traverses this assertion.

Although Applicant has submitted multiple Information Disclosure Statements that potentially list “prior art”, Applicant does **not** admit that pages 1-2 of Applicant’s specification describe “prior art”, nor has any evidence been presented that any aspect of pages 1-2 of Applicant’s specification can be used as prior art. Thus, no statement on pages 1-2 of Applicant’s specification can serve as a proper basis for claim rejections under 35 U.S.C. 103(a) and the attempt to do so in the Final Office Action is improper and should be withdrawn.

The Final Office Action alleges, at Page 28:

In response to the applicant's argument that the specification does not constitute Disclosed Prior Art, the MPEP states that when “the specification's background of the invention describes information as being known or conventional, [it] may be considered as an admission of prior art.” MPEP § 704.11 (a). To that end, the background does utilize terminology that indicates the disclosed information is known or conventional through the use of language such as “commonly”, “frequently”, “conventionally” and/or “traditionally.” Therefore,

examiner asserts that information contained within the specification under the title “Background of the Invention” is an admission of prior art and, therefore, Disclosed Prior Art.

With all due respect, the Federal Circuit has held that “[o]ne's own work may **not** be considered prior art in the absence of a statutory basis”. The MPEP is not a statute, nor does it have sufficient legal authority to overcome a Federal Circuit holding. Applicant respectfully submits that the Final Office Action provides no statutory basis for the use of Applicant's disclosure as prior art.

e) Missing *Claim* Limitations

Claim 113 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach or suggest, expressly or inherently, an “apparatus for providing financial risk management functions by an agent for each of a plurality of institutional or corporate clients”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

f) No Motivation or Suggestion to Combine the Applied References

Instead, regarding selected proffered combinations, the Final Office Action improperly states that “McMenamin discloses a method for providing financial functions (financial management)”. This is a mischaracterization of McMenamin and the claimed subject matter. At most, the cited portions of McMenamin allegedly provide an “introduction” to “financial management”. The cited portions of McMenamin do not teach or disclose any “computer-

assisted methods” for providing “financial risk management functions” by “an agent”, and Applicant respectfully submits that Office Action presents no reasons, and certainly no “concrete evidence” that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from McMenamin.

The Final Office Action asserts, at Page 4:

McMenamin does not teach that providing financial functions comprising said steps is automated. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Applicant respectfully points out that *In re Venner* was decided in 1958. As such, *In re Venner* did not apply the *Graham* test, *see supra*, regarding obviousness. As a result, Applicant respectfully submits that no evidence is presented that the proposition for which *In re Venner* is cited is still valid law. Applicant respectfully notes that the Federal Circuit has failed to cite *In re Venner* in any case whatsoever. Moreover, even if *In re Venner* were still valid for the point of law for which it is presented, no *prima facie* case is presented that the claimed subject matter of the present application is disclosed in any of the applied portions of the relied upon references as a “manual activity that accomplishes the same result.”

Moreover, Applicant respectfully submits that Office Action presents no reasons that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from Heath. Instead, it seems quite likely that one of skill in the art would instantly reject Heath as completely irrelevant, since Heath is a reference allegedly directed to the “public policy challenges” facing “organizations”, rather than “financial risk management functions”. Heath explains that “the heart of issues management 'is reconciliation of conflicting internal interests on public policy issues of strategic importance in order to make a coherent external advocacy'”. Applicant respectfully asks how the “reconciliation of conflicting internal interests on public policy issues” relates in the least to the claimed subject matter? Applicant also respectfully asks where is the concrete evidence that Heath is “within the field of the inventor's endeavor”, and if not, “is reasonably pertinent to the

particular problem with which the inventor was involved”?

Similarly, Applicant respectfully submits that Office Action presents no reasons, and certainly no “concrete evidence”, that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from Stein.

Furthermore, even assuming, *arguendo*, that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” McMenemy, Heath, and Stein, the Office Action presents no concrete evidence of a suggestion, motivation, or teaching **in the prior art** that would have led a person of ordinary skill in the art to combine these references in the manner claimed.

In addition, Applicant respectfully notes that the Final Office Action impermissibly relies on Applicant’s disclosure on Page 5 in rejecting claim 113. As noted, *supra*, Applicant does not admit that any of contents of the present Application is prior art. Accordingly, Applicant respectfully traverses the impermissible use of “p. 2, lines 4-9) of the present Application as prior art by the Final Office Action.

The Final Office Action asserts at Pages 30 and 31:

In response to applicant's argument that there is no suggestion to combine the references, the Courts have stated that “[a] suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references ... The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art ... there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (emphasis added). *In re Kahn*, 78 USPQ2d 1329, 1336 (CA FC 2006). Examiner asserts that he can and/or has provided such “articulated reasoning to support the legal conclusion of obviousness.

Applicant respectfully submits that the legal analysis presented in *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006), requires that “underlying factual findings” of the USPTO, “including a finding of a motivation to combine” must be supported by “substantial evidence *In re Gartside*,

203 F.3d 1305, 1316 (Fed. Cir. 2000)). Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence. *Id.* at 1312 (*citing Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229-30 (1938)). According to the Federal Circuit “[t]he presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact.” *Alza Corp. v. Mylan Laboratories, Inc.*, 2006 U.S. App. LEXIS 22616 (Fed. Cir. 2006) (*citing In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000)); *accord Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 (Fed. Cir. 2000). Likewise, the presence or absence of a “reasonable expectation of success” from making such a combination is also a pure question of fact. *Alza Corp. v. Mylan Laboratories, Inc.*, 2006 U.S. App. LEXIS 22616 (Fed. Cir. 2006) (*citing Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006)).

The allegations of the Final Office Action regarding the alleged suggestions or motivations for modifying and/or combining references comprise little more than bald assertions and do not appear to be supported by even a “mere scintilla of evidence”. That is, the Final Office Action presents **no factual basis** upon which the allegations regarding suggestions or motivations to combine references are based. Applicant respectfully reiterates that a “bald assertion of knowledge generally available to one of ordinary skill in the art to bridge the evidentiary gap is improper. Such unfounded assertions are not permissible substitutes for evidence. *See In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). In other words, deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.*

For at least this reason, Applicant respectfully submits that the allegations responding to Applicant’s argument presented in the Office Action Reply dated 11 April 2006 are unsupported and fail to provide any evidentiary support regarding any suggestion or motivation to combine the applied portions of the relied upon references.

g) No Reasonable Expectation of Success

The Final Office Action attempts to, impermissibly, combine portions of Applicants own disclosure and three additional references in rejecting claim 1, McMenamin, Heath, and Stein.

Applicant respectfully submits that McMenamin is allegedly directed to an “introduction to the basic principles, practices and concepts of modern financial management.” *See* Page 1.

By contrast, Heath is allegedly directed toward “issues management”, which is described as “the product of turbulent criticism and change that angry publics seek to impose on business policies and practices.” *See* Page 1.

In further contrast, Stein’s Abstract allegedly recites that:

[a] supervisory control system for a networked multimedia computing system permits a teacher or network administrator to quickly and easily update system software on selected destination workstations with the system software currently residing on the master workstation. In one mode of operation, only basic system software is updated, while user-defined preferences are unchanged. In a second mode of operation, both the system software and all user-controlled settings are replaced, to permit the remote workstations to be configured in a desired manner.

Applicant’s disclosure is not available as a reference and even if it was, doesn’t overcome the deficiencies of the applied portions of the remaining relied upon references.

The Final Office Action presents no evidence that one having ordinary skill in the art would have had any expectation of success, let alone a reasonable expectation of success, in combining the applied portions of the relied upon references. At most, the applied portions of the relied upon references provide “only general guidance as to the particular form of the claimed invention or how to achieve it.”

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, expressly or inherently teach or suggest **every** limitation of claim 1 (another assumption that is respectfully traversed), there is still no evidence indicating a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action, and consequently, the Office Action fails to establish a *prima facie* case of obviousness.

h) Improper Reliance on *In re Venner*

The Final Office Action recites, at Pages 33-34:

Now to the argued claim limitations specifically, a known manual financial decision-making methodology was disclosed by McMenamin. Such prior art reference was modified through automation via *In re Venner*, to capture the benefits natural to such automation - speed, uniformity and/or reliability. Automation would have constituted the use of a computer to make such automation possible, an argument buttressed by the use of a computer network, as disclosed by Stein. The outsourcing of this financial function, either the outsourcing of the manual or the computerized process, would have been obvious in light of Disclosed Prior Art. Finally, a supervision system that allowed management to oversee their agents and/or employees at their individual workstations, is disclosed by Stein, serving to monitor and provide transparency concerning the actions of the agents.

Applicant again traverses the continued use of *In re Venner* in the rejection of any of the claimed subject matter of the present Application. Applicant reiterates that, as a case decided in 1958, *In re Venner* fails to properly consider the Graham factors regarding obviousness. As such it is no longer binding precedent and has at least been superseded by *Graham*.

i) Improper Reliance on Stein as a Reference

A proper Office Action must be complete as to all matters, must provide a clear explanation of all actions taken, and **must answer in detail** the substance of each of Applicant's submitted arguments (emphasis added). See MPEP 707.07(f).

In the Office Action Reply dated 11 April 2006, Applicant respectfully stated, at Page 30, "[s]imilarly, Applicant respectfully submits that Office Action presents no reasons, and certainly no "concrete evidence", that "the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select" anything from Stein. The Final Office Action is silent regarding this argument.

Stein allegedly recites, at the Abstract:

A supervisory control system for a networked multimedia computing system permits a teacher or network administrator to quickly and easily update system software on selected destination workstations with the system software currently residing on the master workstation. In one mode of operation, only basic system software is updated, while user-defined preferences are unchanged. In a second mode of operation, both the system software and all user-controlled settings are replaced, to permit the remote workstations to be configured in a desired manner.

No argument is advanced in either Office Action as to why one skilled in the art would select a reference directed to updating “basic system software” and “system software and all user-controlled settings” in a method relating to financial risk management.

Since the Final Office Action is silent regarding the argument regarding Stein, Applicant submits that the Final Office Action concedes that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention” would not select anything from Stein.

j) Conclusion

For at least the reasons mentioned above, a reversal of the rejection of claim 113 is respectfully requested.

114. Claim 114

a) Claim Construction

In the present Application, the customary meaning for the phrase “financial risk management function” is implicitly defined in the specification and the properly cited prior art. That definition must control examination of those claims that recite this phrase.

At least at page 1, lines 5-7, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]he present invention relates to the field of financial risk management and trading, and, **more particularly**, to a method and system for clients to outsource financial functions to an agent.”

At least at page 2, lines 16-17, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]ypical financial

functions are treasury, credit management, risk management, and trading, together with several of their associated sub-functions.”

At least at page 3, lines 1-3, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]he activities that make up these financial functions are the relevant daily operations of the front-office trading departments and the associated middle-office risk management and back-office support departments.”

Thus, the phrase “financial risk management function” should be construed as one of ordinary skill in the relevant art would interpret the definition provided in the specification.

Applicant respectfully notes a discussion regarding lexicography on Pages 26-27 of the Final Office Action. Page 26 of the Final Office Action recites:

Although the argued elements are found as examples and/or embodiments in the specification, they were not claimed explicitly in the disputed claim(s). Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. Therefore although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed Cir. 1993) and MPEP §2111.01.

Furthermore, while applicants may be their own lexicographer, any special meaning assigned to a term ‘must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.’ *See Multifarm Desiccants Inc v. Medzam Ltd.*, 133 F3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). Examiner asserts that the specification fails to indicate a clear or obvious departure from the common and ordinary definition of the disputed claim term, and, therefore, the common and ordinary definition of the disputed claim term was properly utilized for application of prior art.

Applicant respectfully notes that *Phillips*, as an *en banc* decision, supersedes any prior or subsequent Federal Circuit case adjudicated by any panel that is not *en banc*. As a result, to the extent that *In re Van Geuns*, *Multiform*, or *In re Prater* differs from *Phillips*, they have been superseded thereby. The Final Office Action further alleges at pages 26-27:

For example, the specification states ‘[t]he present invention relates to the field of financial risk management and trading, and, more particularly, to a method and system for clients to outsource financial functions to an agent.’ (see p. 1, lines 5 - 7). Such statements indicate that the “financial functions” are a subset of “financial risk management” functions. However, the specification also states “[t]ypical financial functions are treasury, credit management, risk management, and trading, together with several of their associated sub-functions.” (emphasis added - see p 2, lines 16 - 17). Such statement indicates that “risk management” functions are a subset of “financial functions.” Such a contradiction falls far short of a clearly expressed desire to define claim terminology.

Applicant respectfully traverses this argument as fallacious. It is not necessarily follow that the phrase “[t]he present invention relates to the field of financial risk management and trading, and, more particularly, to a method and system for clients to outsource financial functions to an agent” necessarily means that “financial functions” are a subset of “financial risk management” or of “financial risk management” functions. Thus, the above-recited allegation of the Final Office Action lacks a proper foundation and is not valid.

Accordingly, Applicant respectfully submits that claim construction regarding the phrase “financial risk management function” must be construed as one of ordinary skill in the relevant art would interpret that phrase as defined and/or guided by the specification. Since the Final Office Action fails to provide such a construction, Applicant respectfully requests a reversal of the rejection of claim 114.

b) Official Notice

The Final Office Action alleges, at Pages 27-28, that Applicants Office Action Reply dated 11 April 2006:

In response to the applicant's traversal of Official Notice finding(s) in previous office action, examiner asserts that the traversal is inadequate. Adequate traversal is a two-step process. First, applicant(s) must state their traversal on the record. Second and in accordance with 37 C.F.R. 1.111(b) which requires applicant(s) to specifically point out the supposed errors in the Office Action, applicant(s) must state why the Official Notice statement(s) are not to be considered common knowledge or well known in the art.

In this application, while applicant(s) have clearly met step (1), applicant(s) have failed step (2) since they have failed to argue why the Official Notice statement(s) are not to be considered common knowledge or well known in the art. Because Applicant(s)' traversal is inadequate, the Official Notice statement(s) are taken to be admitted as prior art. See MPEP 2144.03.

In the applicant's response, the applicant merely made a blanket statement that '(to the extent that Official Notice is explicitly or implicitly utilized to support any rejection' and failed to even specify which claims the applicant is contesting, never mind articulating a basis for the applicant's arguments against the taking of Official Notice.

For example, should the applicant decide to traverse the taking of Official Notice in regards to Claim 39, applicant should argue that it is not common knowledge nor well known in the art to utilize financial information including financial guidelines when making a financial decision. Or should the applicant decide to traverse the taking of Official Notice in regards to Claim 48, applicant should argue that it is not common knowledge nor well known in the art that financial management, either manual or automated financial management, involves cashflow management.

Applicant respectfully traverses these allegations. Applicant respectfully notes that the phrase "Official Notice" does not appear whatsoever in any of the claim rejections of the Final Office Action or the prior Office Action dated 13 January 2006. Applicant respectfully submits that if, indeed, it was the intention of either Office Action to take Official Notice regarding any of the articulated grounds of rejection, that both Office Actions utterly fail to comply with the

requirements of MPEP § 707.07(d) since neither provides “ground[s] of rejection [that are] fully and clearly stated”. For example, if either Office Action intended to rely upon Official Notice for rejecting claim 39 and/or claim 48, as implied on Page 28 of the Final Office Action, each respective Office Action based thereupon was required to clearly state Official Notice as a grounds of rejection for each of those claims. Applicant respectfully notes that neither 37 C.F.R. 1.111 nor the MPEP require Applicant to be clairvoyant regarding the grounds of rejection of an Office Action.

Applicant respectfully submits that the Office Action Reply dated 11 April 2006 was “reduced to a writing” and “distinctly and specifically point[ed] out the supposed errors in the examiner’s action” and “repl[ied] to every ground of objection and rejection in the prior Office action.” As such, the Office Action Reply dated 11 April 2006 fully complied with 37 C.F.R. 1.111(b). Applicant respectfully submits that the allegations of the Final Office Action such as, *inter alia*, “should the applicant decide to traverse the taking of Official Notice in regards to Claim 39, applicant should argue that it is not common knowledge nor well known in the art to utilize financial information including financial guidelines when making a financial decision”, are without legal basis under 37 C.F.R. 1.111(b).

In addition, since Applicant has traversed the use of Official Notice, to the extent that Official Notice was used in rejecting the claims, “the examiner **must provide documentary evidence in the next Office Action** if the rejection is to be maintained. *See* 37 CFR 1.104(c)(2) and MPEP 2144.03C. *See also In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Since the Final Office Action utterly fails to provide any such reference for any claim, and appears to indicate that Official Notice was used in the rejections (at least of claims 27-32, 34-37, 39-111, 131, and 132, *see* Page 33), Applicant respectfully submits that each rejection based upon Official Notice must be reversed for at least that reason.

c) Inherency

To the extent that either Office Action relied on inherency to support a claim rejection, Applicant respectfully traverses and requests a reversal of each rejection based thereon since a detailed explanation has not been provided demonstrating that the “missing descriptive material

is necessarily present, not merely probably or possibly present”, in any prior art reference cited to supporting such rejection.

d) Allegedly “Disclosed Prior Art”

The Final Office Action asserts, “applicant’s specification, pp. 1-2” is “Disclosed Prior Art”. Applicant respectfully traverses this assertion.

Although Applicant has submitted multiple Information Disclosure Statements that potentially list “prior art”, Applicant does **not** admit that pages 1-2 of Applicant’s specification describe “prior art”, nor has any evidence been presented that any aspect of pages 1-2 of Applicant’s specification can be used as prior art. Thus, no statement on pages 1-2 of Applicant’s specification can serve as a proper basis for claim rejections under 35 U.S.C. 103(a) and the attempt to do so in the Final Office Action is improper and should be withdrawn.

The Final Office Action alleges, at Page 28:

In response to the applicant's argument that the specification does not constitute Disclosed Prior Art, the MPEP states that when “the specification's background of the invention describes information as being known or conventional, [it] may be considered as an admission of prior art.” MPEP § 704.11 (a). To that end, the background does utilize terminology that indicates the disclosed information is known or conventional through the use of language such as “commonly”, “frequently”, conventionally” and/or “traditionally.” Therefore, examiner asserts that information contained within the specification under the title “Background of the Invention” is an admission of prior art and, therefore, Disclosed Prior Art.

With all due respect, the Federal Circuit has held that “[o]ne's own work may **not** be considered prior art in the absence of a statutory basis”. The MPEP is not a statute, nor does it have sufficient legal authority to overcome a Federal Circuit holding. Applicant respectfully submits that the Final Office Action provides no statutory basis for the use of Applicant’s disclosure as prior art.

e) **Missing Claim Limitations**

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d).

For example, claim 114 states, *inter alia*, that “providing financial information on one or more financial risk management functions of each client to a computer of the agent”. The omnibus rejection of claim groups by the references relied upon in the Office Action makes no mention of “providing financial information on one or more financial risk management functions of each client to a computer of the agent”, and fails to point out where, in any of the references, that limitation is disclosed.

In addition, claim 114 states, *inter alia*, that “enabling the agent to determine an action based on an analysis of risk management information created from the financial information”. The omnibus rejection of claim groups by the references relied upon in the Office Action makes no mention of “enabling the agent to determine an action based on an analysis of risk management information created from the financial information”, and fails to point out where, in any of the references, that limitation is disclosed.

Moreover, claim 114 states, *inter alia*, that “allowing the agent to facilitate the implementation of the action”. The omnibus rejection of claim groups by the references relied upon in the Office Action makes no mention of “allowing the agent to facilitate the implementation of the action”, and fails to point out where, in any of the references, that limitation is disclosed.

Claim 114 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach or suggest, expressly or inherently, a “computer-assisted method for a client to **outsource financial risk management functions to an agent** representing a plurality of institutional or corporate clients”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as

attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

f) No Motivation or Suggestion to Combine the Applied References

Instead, regarding selected proffered combinations, the Final Office Action improperly states that “McMenamin discloses a method for providing financial functions (financial management)”. This is a mischaracterization of McMenamin and the claimed subject matter. At most, the cited portions of McMenamin allegedly provide an “introduction” to “financial management”. The cited portions of McMenamin do not teach or disclose any “computer-assisted methods” for providing “financial risk management functions” by “an agent”, and Applicant respectfully submits that Office Action presents no reasons, and certainly no “concrete evidence” that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from McMenamin.

The Final Office Action asserts, at Page 4:

McMenamin does not teach that providing financial functions comprising said steps is automated. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Applicant respectfully points out that *In re Venner* was decided in 1958. As such, *In re Venner* did not apply the *Graham* test, *see supra*, regarding obviousness. As a result, Applicant respectfully submits that no evidence is presented that the proposition for which *In re Venner* is cited is still valid law. Applicant respectfully notes that the Federal Circuit has failed to cite *In re Venner* in any case whatsoever. Moreover, even if *In re Venner* were still valid for the point of law for which it is presented, no *prima facie* case is presented that the claimed subject matter of the present application is disclosed in any of the applied portions of the relied upon references as a “manual activity that accomplishes the same result.”

Moreover, Applicant respectfully submits that Office Action presents no reasons that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from Heath. Instead, it seems quite likely that one of skill in the art would instantly reject Heath as completely irrelevant, since Heath is a reference allegedly directed to the “public policy challenges” facing “organizations”, rather than “financial risk management functions”. Heath explains that “the heart of issues management 'is reconciliation of conflicting internal interests on public policy issues of strategic importance in order to make a coherent external advocacy'”. Applicant respectfully asks how the “reconciliation of conflicting internal interests on public policy issues” relates in the least to the claimed subject matter? Applicant also respectfully asks where is the concrete evidence that Heath is “within the field of the inventor's endeavor”, and if not, “is reasonably pertinent to the **particular problem** with which the inventor was involved”?

Similarly, Applicant respectfully submits that Office Action presents no reasons, and certainly no “concrete evidence”, that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from Stein.

Furthermore, even assuming, *arguendo*, that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” McMenamin, Heath, and Stein, the Office Action presents no concrete evidence of a suggestion, motivation, or teaching **in the prior art** that would have led a person of ordinary skill in the art to combine these references in the manner claimed.

In addition, Applicant respectfully notes that the Final Office Action impermissibly relies on Applicant's disclosure on Page 5 in rejecting claim 114. As noted, *supra*, Applicant does not admit that any of contents of the present Application is prior art. Accordingly, Applicant respectfully traverses the impermissible use of “p. 2, lines 4-9) of the present Application as prior art by the Final Office Action.

The Final Office Action asserts at Pages 30 and 31:

In response to applicant's argument that there is no suggestion to combine the references, the Courts have stated that “[a] suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from

the prior art as a whole, rather than expressly stated in the references ... The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art ... there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (emphasis added). *In re Kahn*, 78 USPQ2d 1329, 1336 (CA FC 2006). Examiner asserts that he can and/or has provided such “articulated reasoning to support the legal conclusion of obviousness.

Applicant respectfully submits that the legal analysis presented in *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006), requires that “underlying factual findings” of the USPTO, “including a finding of a motivation to combine” must be supported by “substantial evidence *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000)). Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence. *Id.* at 1312 (citing *Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229-30 (1938)). According to the Federal Circuit “[t]he presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact.” *Alza Corp. v. Mylan Laboratories, Inc.*, 2006 U.S. App. LEXIS 22616 (Fed. Cir. 2006) (citing *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000)); accord *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 (Fed. Cir. 2000). Likewise, the presence or absence of a “reasonable expectation of success” from making such a combination is also a pure question of fact. *Alza Corp. v. Mylan Laboratories, Inc.*, 2006 U.S. App. LEXIS 22616 (Fed. Cir. 2006) (citing *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006)).

The allegations of the Final Office Action regarding the alleged suggestions or motivations for modifying and/or combining references comprise little more than bald assertions and do not appear to be supported by even a “mere scintilla of evidence”. That is, the Final Office Action presents **no factual basis** upon which the allegations regarding suggestions or motivations to combine references are based. Applicant respectfully reiterates that a “bald assertion of knowledge generally available to one of ordinary skill in the art to bridge the evidentiary gap is improper. Such unfounded assertions are not permissible substitutes for evidence. See *In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). In other words, deficiencies of the cited references can not be remedied by general conclusions about

what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.*

For at least this reason, Applicant respectfully submits that the allegations responding to Applicant's argument presented in the Office Action Reply dated 11 April 2006 are unsupported and fail to provide any evidentiary support regarding any suggestion or motivation to combine the applied portions of the relied upon references.

g) No Reasonable Expectation of Success

The Final Office Action attempts to, impermissibly, combine portions of Applicants own disclosure and three additional references in rejecting claim 1, McMenamin, Heath, and Stein.

Applicant respectfully submits that McMenamin is allegedly directed to an "introduction to the basic principles, practices and concepts of modern financial management." *See* Page 1.

By contrast, Heath is allegedly directed toward "issues management", which is described as "the product of turbulent criticism and change that angry publics seek to impose on business policies and practices." *See* Page 1.

In further contrast, Stein's Abstract allegedly recites that:

[a] supervisory control system for a networked multimedia computing system permits a teacher or network administrator to quickly and easily update system software on selected destination workstations with the system software currently residing on the master workstation. In one mode of operation, only basic system software is updated, while user-defined preferences are unchanged. In a second mode of operation, both the system software and all user-controlled settings are replaced, to permit the remote workstations to be configured in a desired manner.

Applicant's disclosure is not available as a reference and even if it was, doesn't overcome the deficiencies of the applied portions of the remaining relied upon references.

The Final Office Action presents no evidence that one having ordinary skill in the art would have had any expectation of success, let alone a reasonable expectation of success, in combining the applied portions of the relied upon references. At most, the applied portions of the relied upon references provide "only general guidance as to the particular form of the

claimed invention or how to achieve it.”

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, expressly or inherently teach or suggest **every** limitation of claim 1 (another assumption that is respectfully traversed), there is still no evidence indicating a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action, and consequently, the Office Action fails to establish a *prima facie* case of obviousness.

h) Improper Reliance on *In re Venner*

The Final Office Action recites, at Pages 33-34:

Now to the argued claim limitations specifically, a known manual financial decision-making methodology was disclosed by McMenamin. Such prior art reference was modified through automation via *In re Venner*, to capture the benefits natural to such automation - speed, uniformity and/or reliability. Automation would have constituted the use of a computer to make such automation possible, an argument buttressed by the use of a computer network, as disclosed by Stein. The outsourcing of this financial function, either the outsourcing of the manual or the computerized process, would have been obvious in light of Disclosed Prior Art. Finally, a supervision system that allowed management to oversee their agents and/or employees at their individual workstations, is disclosed by Stein, serving to monitor and provide transparency concerning the actions of the agents.

Applicant again traverses the continued use of *In re Venner* in the rejection of any of the claimed subject matter of the present Application. Applicant reiterates that, as a case decided in 1958, *In re Venner* fails to properly consider the Graham factors regarding obviousness. As such it is no longer binding precedent and has at least been superseded by *Graham*.

i) Improper Reliance on Stein as a Reference

A proper Office Action must be complete as to all matters, must provide a clear explanation of all actions taken, and **must answer in detail** the substance of each of Applicant's submitted arguments (emphasis added). *See* MPEP 707.07(f).

In the Office Action Reply dated 11 April 2006, Applicant respectfully stated, at Page 30, "[s]imilarly, Applicant respectfully submits that Office Action presents no reasons, and certainly no "concrete evidence", that "the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select" anything from Stein. The Final Office Action is silent regarding this argument.

Stein allegedly recites, at the Abstract:

A supervisory control system for a networked multimedia computing system permits a teacher or network administrator to quickly and easily update system software on selected destination workstations with the system software currently residing on the master workstation. In one mode of operation, only basic system software is updated, while user-defined preferences are unchanged. In a second mode of operation, both the system software and all user-controlled settings are replaced, to permit the remote workstations to be configured in a desired manner.

No argument is advanced in either Office Action as to why one skilled in the art would select a reference directed to updating "basic system software" and "system software and all user-controlled settings" in a method relating to financial risk management.

Since the Final Office Action is silent regarding the argument regarding Stein, Applicant submits that the Final Office Action concedes that "the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention" would not select anything from Stein.

j) Conclusion

For at least the reasons mentioned above, a reversal of the rejection of claim 114 is respectfully requested. A reversal of each rejection of claims 115-135, each depending from claim 114 is also respectfully requested.

115. Claim 115

Since claim 115 depends from claim 114, Applicant respectfully incorporates by reference each rejection traversal regarding claim 114.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 115, at Page 22:

Principal-agent relationships and the outsourcing of functions and/or activities to said agents is old and well known in the arts of business and strategic planning, and principal-agent relationships, as evidenced by Disclosed Prior Art (see p. 2, lines 4 - 9). Furthermore, communication and/or delivery of agent output to the principal are old and well known in the arts of business and strategic planning, and principal-agent relationships. It would have been obvious one of ordinary skill in the art at the time of the invention to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating the ability to allow for the communication and/or delivery of information generated by the agent to the client, to allow the principal to have the end results and/or output of agents' activities.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of

claim 115.

116. Claim 116

Since claim 116 depends from claim 114, Applicant respectfully incorporates by reference each rejection traversal regarding claim 114.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 116, at Page 22:

Principal-agent relationships and the outsourcing of functions and/or activities to said agents is old and well known in the arts of business and strategic planning, and principal-agent relationships, as evidenced by Disclosed Prior Art (see p. 2, lines 4 - 9). Furthermore, communication and/or delivery of agent output to the principal are old and well known in the arts of business and strategic planning, and principal-agent relationships. It would have been obvious one of ordinary skill in the art at the time of the invention to have modified McMenamin, Heath, Disclosed Prior Art and Stein by incorporating the ability to allow for the communication and/or delivery of information generated by the agent to the client, to allow the principal to have the end results and/or output of agents' activities.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 116.

117. Claim 117

Since claim 117 depends from claim 114, Applicant respectfully incorporates by reference each rejection traversal regarding claim 114.

a) Claim 117 is Impermissibly Grouped

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d). Applicant has respectfully indicated that the claimed subject matter for claim 114 is different than the claimed subject matter for claim 1. Therefore, the claimed subject matter for claim 117 cannot be the same as for any of “Claims 5-7” as alleged in the Final Office Action at page 22.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 117.

118. Claim 118

Since claim 118 depends from claim 114, Applicant respectfully incorporates by reference each rejection traversal regarding claim 114.

a) Claim 118 is Impermissibly Grouped

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d). Applicant has respectfully indicated that the claimed subject matter for claim 114 is different than the claimed subject matter for claim 1. Therefore, the claimed subject matter for claim 118 cannot be the same as for any of “Claims 5-7” as

alleged in the Final Office Action at page 22.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 118.

119. Claim 119

Since claim 119 depends from claim 114, Applicant respectfully incorporates by reference each rejection traversal regarding claim 119.

a) Claim 119 is Impermissibly Grouped

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d). Applicant has respectfully indicated that the claimed subject matter for claim 119 is different than the claimed subject matter for claim 1. Therefore, the claimed subject matter for claim 119 cannot be the same as for any of “Claims 5-7” as alleged in the Final Office Action at page 22.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 119.

120. Claim 120

Since claim 120 depends from claim 114, Applicant respectfully incorporates by reference each rejection traversal regarding claim 114.

a) Claim 120 is Impermissibly Grouped

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d). Applicant has respectfully indicated that the claimed

subject matter for claim 114 is different than the claimed subject matter for claim 1. Therefore, the claimed subject matter for claim 120 cannot be the same as for any of “Claims 5-7” as alleged in the Final Office Action at page 22.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 120.

121. Claim 121

Since claim 121 depends from claim 114, Applicant respectfully incorporates by reference each rejection traversal regarding claim 114.

a) Claim 121 is Impermissibly Grouped

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d). Applicant has respectfully indicated that the claimed subject matter for claim 114 is different than the claimed subject matter for claim 1. Therefore, the claimed subject matter for claim 121 cannot be the same as for any of “Claims 13-20” as alleged in the Final Office Action at page 23.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 121.

122. Claim 122

Since claim 122 depends from claim 114, Applicant respectfully incorporates by reference each rejection traversal regarding claim 114.

a) Claim 122 is Impermissibly Grouped

The Office Action appears to improperly group claims together in a common rejection

without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d). Applicant has respectfully indicated that the claimed subject matter for claim 114 is different than the claimed subject matter for claim 1. Therefore, the claimed subject matter for claim 122 cannot be the same as for any of “Claims 13-20” as alleged in the Final Office Action at page 23.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 122.

123. Claim 123

Since claim 123 depends from claim 114, Applicant respectfully incorporates by reference each rejection traversal regarding claim 114.

a) Claim 123 is Impermissibly Grouped

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d). Applicant has respectfully indicated that the claimed subject matter for claim 114 is different than the claimed subject matter for claim 1. Therefore, the claimed subject matter for claim 123 cannot be the same as for any of “Claims 13-20” as alleged in the Final Office Action at page 23.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 123.

124. Claim 124

Since claim 124 depends from claim 114, Applicant respectfully incorporates by reference each rejection traversal regarding claim 114.

a) Claim 124 is Impermissibly Grouped

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d). Applicant has respectfully indicated that the claimed subject matter for claim 114 is different than the claimed subject matter for claim 1. Therefore, the claimed subject matter for claim 124 cannot be the same as for any of “Claims 21-23” as alleged in the Final Office Action at page 23.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 124.

125. Claim 125

Since claim 125 depends from claim 114, Applicant respectfully incorporates by reference each rejection traversal regarding claim 114.

a) Claim 125 is Impermissibly Grouped

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d). Applicant has respectfully indicated that the claimed subject matter for claim 114 is different than the claimed subject matter for claim 1. Therefore, the claimed subject matter for claim 125 cannot be the same as for any of “Claims 21-23” as alleged in the Final Office Action at page 23.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 125.

126. Claim 126

Since claim 126 depends from claim 114, Applicant respectfully incorporates by

reference each rejection traversal regarding claim 114.

a) Claim 126 is Impermissibly Grouped

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d). Applicant has respectfully indicated that the claimed subject matter for claim 114 is different than the claimed subject matter for claim 1. Therefore, the claimed subject matter for claim 126 cannot be the same as for any of “Claims 21-23” as alleged in the Final Office Action at page 23.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 126.

127. Claim 127

Since claim 127 depends from claim 114, Applicant respectfully incorporates by reference each rejection traversal regarding claim 114.

a) Claim 127 is Impermissibly Grouped

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d). Applicant has respectfully indicated that the claimed subject matter for claim 114 is different than the claimed subject matter for claim 1. Therefore, the claimed subject matter for claim 127 cannot be the same as for any of “Claims 24-26” as alleged in the Final Office Action at page 23.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 127.

128. Claim 128

Since claim 128 depends from claim 114, Applicant respectfully incorporates by reference each rejection traversal regarding claim 114.

a) Claim 128 is Impermissibly Grouped

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d). Applicant has respectfully indicated that the claimed subject matter for claim 114 is different than the claimed subject matter for claim 1. Therefore, the claimed subject matter for claim 128 cannot be the same as for any of “Claims 24-26” as alleged in the Final Office Action at page 23.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 128.

129. Claim 129

Since claim 129 depends from claim 114, Applicant respectfully incorporates by reference each rejection traversal regarding claim 114.

a) Claim 129 is Impermissibly Grouped

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d). Applicant has respectfully indicated that the claimed subject matter for claim 114 is different than the claimed subject matter for claim 1. Therefore, the claimed subject matter for claim 129 cannot be the same as for “Claim 1” as alleged in the Final Office Action at page 23.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of

claim 129.

130. Claim 130

Since claim 130 depends from claim 114, Applicant respectfully incorporates by reference each rejection traversal regarding claim 114.

a) Claim 130 is Impermissibly Grouped

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d). Applicant has respectfully indicated that the claimed subject matter for claim 114 is different than the claimed subject matter for claim 1. Therefore, the claimed subject matter for claim 130 cannot be the same as for “Claims 1 and 25” as alleged in the Final Office Action at page 23.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 116, at Page 23:

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenamin, Heath, Disclosed Prior Art and Stein to allow condition and/or reasoning for the provision of “new financial information” as under Claim 1 that the inventor desired.

Applicant respectfully traverses the impermissible use of Applicant’s disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; or

“combine [those teachings] in the way that would produce the claimed” subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 130.

131. Claim 131

Since claim 131 depends from claim 114, Applicant respectfully incorporates by reference each rejection traversal regarding claim 114.

a) Missing Claim Limitations

Claim 131 recites, *inter alia*, yet the combined applied portions of McMnamin, Heath, and Stein do not teach, “removing the agent’s authority to undertake any action on behalf of the client”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 131, at Page 24:

Establishing the scope and/or authority of an agent in a principal-agent relationship is old and well known in the art of principal-agent relationships and agency law. It would have been obvious to one of ordinary skill in the art

at the time the invention was made to have modified McMenamin [sic], Heath, Disclosed Prior Art and Stein to allow and/or contract for any scope of agency authority that the inventor desired.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 131.

132. Claim 132

Since claim 132 depends from claim 114, Applicant respectfully incorporates by reference each rejection traversal regarding claim 114.

a) Missing Claim Limitations

Claim 132 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach, "removing the authority of the agent in connection with one or more actions".

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as

attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

b) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 132, at Page 24:

Establishing the scope and/or authority of an agent in a principal-agent relationship is old and well known in the art of principal-agent relationships and agency law. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenanin [sic], Heath, Disclosed Prior Art and Stein to allow and/or contract for any scope of agency authority that the inventor desired.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

c) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 132.

133. Claim 133

Since claim 133 depends from claim 114, Applicant respectfully incorporates by

reference each rejection traversal regarding claim 114.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 133, at Page 24:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenanin [sic], Heath, Disclosed Prior Art and Stein to allow and/or contract for any response to the agents' recommendations/instructions that the inventor desired, such as agreement with or disregarding of agents' recommendations/instructions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenanin [sic], Heath, Disclosed Prior Art and Stein by incorporating the ability to transmit said information via the network, as disclosed by Stein, to allow for fast and efficient communication of said information.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 133.

134. Claim 134

Since claim 134 depends from claim 114, Applicant respectfully incorporates by reference each rejection traversal regarding claim 114.

a) No Motivation or Suggestion to Combine the Applied References

The Final Office Action states, regarding the claimed subject matter of claim 134, at Page 24:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenanin [sic], Heath, Disclosed Prior Art and Stein to allow and/or contract for any response to the agents' recommendations/instructions that the inventor desired, such as agreement with or disregarding of agents' recommendations/instructions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified McMenanin [sic], Heath, Disclosed Prior Art and Stein by incorporating the ability to transmit said information via the network, as disclosed by Stein, to allow for fast and efficient communication of said information.

Applicant respectfully traverses the impermissible use of Applicant's disclosure in this rejection. Applicant does not admit that any of the present Application whatsoever is prior art.

Further, Applicant respectfully submits that this unfounded assertion fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; or

"combine [those teachings] in the way that would produce the claimed" subject matter.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 134.

135. Claim 135

Since claim 135 depends from claim 114, Applicant respectfully incorporates by reference each rejection traversal regarding claim 114.

a) Claim 135 is Impermissibly Grouped

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d). Applicant has respectfully indicated that the claimed subject matter for claim 114 is different than the claimed subject matter for claim 1. Therefore, the claimed subject matter for claim 135 cannot be the same as for “Claim 2” as alleged in the Final Office Action at page 25.

b) Conclusion

For at least these reasons, Applicant respectfully requests a reversal of the rejection of claim 135.

136. Claim 136**a) Claim Construction**

In the present Application, the customary meaning for the phrase “financial risk management function” is implicitly defined in the specification and the properly cited prior art. That definition must control examination of those claims that recite this phrase.

At least at page 1, lines 5-7, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]he present invention relates to the field of financial risk management and trading, and, **more particularly**, to a method and system for clients to outsource financial functions to an agent.”

At least at page 2, lines 16-17, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]ypical financial functions are treasury, credit management, risk management, and trading, together with several of their associated sub-functions.”

At least at page 3, lines 1-3, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]he activities that make up these financial functions are the relevant daily operations of the front-office trading departments and the associated middle-office risk management and back-office support departments.”

Thus, the phrase “financial risk management function” should be construed as one of ordinary skill in the relevant art would interpret the definition provided in the specification.

Applicant respectfully notes a discussion regarding lexicography on Pages 26-27 of the Final Office Action. Page 26 of the Final Office Action recites:

Although the argued elements are found as examples and/or embodiments in the specification, they were not claimed explicitly in the disputed claim(s). Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. Therefore although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed Cir. 1993) and MPEP §2111.01.

Furthermore, while applicants may be their own lexicographer, any special meaning assigned to a term ‘must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.’ *See Multiform Desiccants Inc v. Medzam Ltd.*, 133 F3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). Examiner asserts that the specification fails to indicate a clear or obvious departure from the common and ordinary definition of the disputed claim term, and, therefore, the common and ordinary definition of the disputed claim term was properly utilized for application of prior art.

Applicant respectfully notes that *Phillips*, as an *en banc* decision, supersedes any prior or subsequent Federal Circuit case adjudicated by any panel that is not *en banc*. As a result,

to the extent that *In re Van Geuns*, *Multiform*, or *In re Prater* differs from *Phillips*, they have been superseded thereby. The Final Office Action further alleges at pages 26-27:

For example, the specification states '[t]he present invention relates to the field of financial risk management and trading, and, more particularly, to a method and system for clients to outsource financial functions to an agent.' (see p. 1, lines 5 - 7). Such statements indicate that the "financial functions" are a subset of "financial risk management" functions. However, the specification also states "[t]ypical financial functions are treasury, credit management, risk management, and trading, together with several of their associated sub-functions." (emphasis added - see p 2, lines 16 - 17). Such statement indicates that "risk management" functions are a subset of "financial functions." Such a contradiction falls far short of a clearly expressed desire to define claim terminology.

Applicant respectfully traverses this argument as fallacious. It is not necessarily follow that the phrase "[t]he present invention relates to the field of financial risk management and trading, and, more particularly, to a method and system for clients to outsource financial functions to an agent" necessarily means that "financial functions" are a subset of "financial risk management" or of "financial risk management" functions. Thus, the above-recited allegation of the Final Office Action lacks a proper foundation and is not valid.

Accordingly, Applicant respectfully submits that claim construction regarding the phrase "financial risk management function" must be construed as one of ordinary skill in the relevant art would interpret that phrase as defined and/or guided by the specification. Since the Final Office Action fails to provide such a construction, Applicant respectfully requests a reversal of the rejection of claim 136.

b) Official Notice

The Final Office Action alleges, at Pages 27-28, that Applicants Office Action Reply dated 11 April 2006:

In response to the applicant's traversal of Official Notice finding(s) in previous office action, examiner asserts that the traversal is inadequate Adequate

traversal is a two-step process. First, applicant(s) must state their traversal on the record. Second and in accordance with 37 C.F.R. 1.111(b) which requires applicant(s) to specifically point out the supposed errors in the Office Action, applicant(s) must state why the Official Notice statement(s) are not to be considered common knowledge or well known in the art.

In this application, while applicant(s) have clearly met step (1), applicant(s) have failed step (2) since they have failed to argue why the Official Notice statement(s) are not to be considered common knowledge or well known in the art. Because Applicant(s)' traversal is inadequate, the Official Notice statement(s) are taken to be admitted as prior art. See MPEP 2144.03.

In the applicant's response, the applicant merely made a blanket statement that '(to the extent that Official Notice is explicitly or implicitly utilized to support any rejection' and failed to even specify which claims the applicant is contesting, never mind articulating a basis for the applicant's arguments against the taking of Official Notice.

For example, should the applicant decide to traverse the taking of Official Notice in regards to Claim 39, applicant should argue that it is not common knowledge nor well known in the art to utilize financial information including financial guidelines when making a financial decision. Or should the applicant decide to traverse the taking of Official Notice in regards to Claim 48, applicant should argue that it is not common knowledge nor well known in the art that financial management, either manual or automated financial management, involves cashflow management

Applicant respectfully traverses these allegations. Applicant respectfully notes that the phrase "Official Notice" does not appear whatsoever in any of the claim rejections of the Final Office Action or the prior Office Action dated 13 January 2006. Applicant respectfully submits that if, indeed, it was the intention of either Office Action to take Official Notice regarding any of the articulated grounds of rejection, that both Office Actions utterly fail to comply with the requirements of MPEP § 707.07(d) since neither provides "ground[s] of rejection [that are] fully and clearly stated". For example, if either Office Action intended to rely upon Official Notice

for rejecting claim 39 and/or claim 48, as implied on Page 28 of the Final Office Action, each respective Office Action based thereupon was required to clearly state Official Notice as a grounds of rejection for each of those claims. Applicant respectfully notes that neither 37 C.F.R. 1.111 nor the MPEP require Applicant to be clairvoyant regarding the grounds of rejection of an Office Action.

Applicant respectfully submits that the Office Action Reply dated 11 April 2006 was “reduced to a writing” and “distinctly and specifically point[ed] out the supposed errors in the examiner’s action” and “repl[ied] to every ground of objection and rejection in the prior Office action.” As such, the Office Action Reply dated 11 April 2006 fully complied with 37 C.F.R. 1.111(b). Applicant respectfully submits that the allegations of the Final Office Action such as, *inter alia*, “should the applicant decide to traverse the taking of Official Notice in regards to Claim 39, applicant should argue that it is not common knowledge nor well known in the art to utilize financial information including financial guidelines when making a financial decision”, are without legal basis under 37 C.F.R. 1.111(b).

In addition, since Applicant has traversed the use of Official Notice, to the extent that Official Notice was used in rejecting the claims, “the examiner **must provide documentary evidence in the next Office Action** if the rejection is to be maintained. *See* 37 CFR 1.104(c)(2) and MPEP 2144.03C. *See also In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Since the Final Office Action utterly fails to provide any such reference for any claim, and appears to indicate that Official Notice was used in the rejections (at least of claims 27-32, 34-37, 39-111, 131, and 132, *see* Page 33), Applicant respectfully submits that each rejection based upon Official Notice must be reversed for at least that reason.

c) Inherency

To the extent that either Office Action relied on inherency to support a claim rejection, Applicant respectfully traverses and requests a reversal of each rejection based thereon since a detailed explanation has not been provided demonstrating that the “missing descriptive material is necessarily present, not merely probably or possibly present”, in any prior art reference cited to supporting such rejection.

d) Allegedly “Disclosed Prior Art”

The Final Office Action asserts, “applicant’s specification, pp. 1-2” is “Disclosed Prior Art”. Applicant respectfully traverses this assertion.

Although Applicant has submitted multiple Information Disclosure Statements that potentially list “prior art”, Applicant does **not** admit that pages 1-2 of Applicant’s specification describe “prior art”, nor has any evidence been presented that any aspect of pages 1-2 of Applicant’s specification can be used as prior art. Thus, no statement on pages 1-2 of Applicant’s specification can serve as a proper basis for claim rejections under 35 U.S.C. 103(a) and the attempt to do so in the Final Office Action is improper and should be withdrawn.

The Final Office Action alleges, at Page 28:

In response to the applicant's argument that the specification does not constitute Disclosed Prior Art, the MPEP states that when “the specification's background of the invention describes information as being known or conventional, [it] may be considered as an admission of prior art.” MPEP § 704.11 (a). To that end, the background does utilize terminology that indicates the disclosed information is known or conventional through the use of language such as “commonly”, “frequently”, conventionally” and/or “traditionally.” Therefore, examiner asserts that information contained within the specification under the title “Background of the Invention” is an admission of prior art and, therefore, Disclosed Prior Art.

With all due respect, the Federal Circuit has held that “[o]ne's own work may **not** be considered prior art in the absence of a statutory basis”. The MPEP is not a statute, nor does it have sufficient legal authority to overcome a Federal Circuit holding. Applicant respectfully submits that the Final Office Action provides no statutory basis for the use of Applicant’s disclosure as prior art.

e) Missing *Claim* Limitations

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d).

For example, claim 136 states, *inter alia*, that “providing financial information on one or more financial risk management functions of each client to a computer of the agent”. The omnibus rejection of claim groups by the references relied upon in the Office Action makes no mention of “providing financial information on one or more financial risk management functions of each client to a computer of the agent”, and fails to point out where, in any of the references, that limitation is disclosed.

In addition, claim 136 states, *inter alia*, that “enabling the agent to determine an action based on an analysis of risk management information created from the financial information”. The omnibus rejection of claim groups by the references relied upon in the Office Action makes no mention of “enabling the agent to determine an action based on an analysis of risk management information created from the financial information”, and fails to point out where, in any of the references, that limitation is disclosed.

In addition, claim 136 states, *inter alia*, that “allowing the agent to facilitate the implementation of the action”. The omnibus rejection of claim groups by the references relied upon in the Office Action makes no mention of “allowing the agent to facilitate the implementation of the action”, and fails to point out where, in any of the references, that limitation is disclosed.

Claim 136 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach or suggest, expressly or inherently, a “computer-readable medium storing instructions that, when executed by one or more processors, cause the one or more processors to perform activities comprising: providing financial information on one or more financial risk management functions of an institutional or corporate client to an agent”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a

prima facie case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

f) No Motivation or Suggestion to Combine the Applied References

Instead, regarding selected proffered combinations, the Final Office Action improperly states that “McMenamin discloses a method for providing financial functions (financial management)”. This is a mischaracterization of McMenamin and the claimed subject matter. At most, the cited portions of McMenamin allegedly provide an “introduction” to “financial management”. The cited portions of McMenamin do not teach or disclose any “computer-assisted methods” for providing “financial risk management functions” by “an agent”, and Applicant respectfully submits that Office Action presents no reasons, and certainly no “concrete evidence” that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from McMenamin.

The Final Office Action asserts, at Page 4:

McMenamin does not teach that providing financial functions comprising said steps is automated. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Applicant respectfully points out that *In re Venner* was decided in 1958. As such, *In re Venner* did not apply the *Graham* test, *see supra*, regarding obviousness. As a result, Applicant respectfully submits that no evidence is presented that the proposition for which *In re Venner* is cited is still valid law. Applicant respectfully notes that the Federal Circuit has failed to cite *In re Venner* in any case whatsoever. Moreover, even if *In re Venner* were still valid for the point of law for which it is presented, no *prima facie* case is presented that the claimed subject matter of the present application is disclosed in any of the applied portions of the relied upon references as a “manual activity that accomplishes the same result.”

Moreover, Applicant respectfully submits that Office Action presents no reasons that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the

claimed invention, would select” anything from Heath. Instead, it seems quite likely that one of skill in the art would instantly reject Heath as completely irrelevant, since Heath is a reference allegedly directed to the “public policy challenges” facing “organizations”, rather than “financial risk management functions”. Heath explains that “the heart of issues management 'is reconciliation of conflicting internal interests on public policy issues of strategic importance in order to make a coherent external advocacy'“. Applicant respectfully asks how the “reconciliation of conflicting internal interests on public policy issues” relates in the least to the claimed subject matter? Applicant also respectfully asks where is the concrete evidence that Heath is “within the field of the inventor's endeavor”, and if not, “is reasonably pertinent to the **particular problem** with which the inventor was involved”?

Similarly, Applicant respectfully submits that Office Action presents no reasons, and certainly no “concrete evidence”, that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from Stein.

Furthermore, even assuming, *arguendo*, that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” McMenamin, Heath, and Stein, the Office Action presents no concrete evidence of a suggestion, motivation, or teaching **in the prior art** that would have led a person of ordinary skill in the art to combine these references in the manner claimed.

In addition, Applicant respectfully notes that the Final Office Action impermissibly relies on Applicant's disclosure on Page 5 in rejecting claim 136. As noted, *supra*, Applicant does not admit that any of contents of the present Application is prior art. Accordingly, Applicant respectfully traverses the impermissible use of “p. 2, lines 4-9) of the present Application as prior art by the Final Office Action.

The Final Office Action asserts at Pages 30 and 31:

In response to applicant's argument that there is no suggestion to combine the references, the Courts have stated that “[a] suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references ... The test for an implicit showing is what the combined teachings, knowledge of one

of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art ... there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (emphasis added). *In re Kahn*, 78 USPQ2d 1329, 1336 (CA FC 2006). Examiner asserts that he can and/or has provided such “articulated reasoning to support the legal conclusion of obviousness.

Applicant respectfully submits that the legal analysis presented in *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006), requires that “underlying factual findings” of the USPTO, “including a finding of a motivation to combine” must be supported by “substantial evidence *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000)). Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence. *Id.* at 1312 (citing *Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229-30 (1938)). According to the Federal Circuit “[t]he presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact.” *Alza Corp. v. Mylan Laboratories, Inc.*, 2006 U.S. App. LEXIS 22616 (Fed. Cir. 2006) (citing *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000)); accord *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 (Fed. Cir. 2000). Likewise, the presence or absence of a “reasonable expectation of success” from making such a combination is also a pure question of fact. *Alza Corp. v. Mylan Laboratories, Inc.*, 2006 U.S. App. LEXIS 22616 (Fed. Cir. 2006) (citing *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006)).

The allegations of the Final Office Action regarding the alleged suggestions or motivations for modifying and/or combining references comprise little more than bald assertions and do not appear to be supported by even a “mere scintilla of evidence”. That is, the Final Office Action presents **no factual basis** upon which the allegations regarding suggestions or motivations to combine references are based. Applicant respectfully reiterates that a “bald assertion of knowledge generally available to one of ordinary skill in the art to bridge the evidentiary gap is improper. Such unfounded assertions are not permissible substitutes for evidence. *See In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). In other words, deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258

F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.*

For at least this reason, Applicant respectfully submits that the allegations responding to Applicant's argument presented in the Office Action Reply dated 11 April 2006 are unsupported and fail to provide any evidentiary support regarding any suggestion or motivation to combine the applied portions of the relied upon references.

g) No Reasonable Expectation of Success

The Final Office Action attempts to, impermissibly, combine portions of Applicants own disclosure and three additional references in rejecting claim 1, McMenamin, Heath, and Stein.

Applicant respectfully submits that McMenamin is allegedly directed to an "introduction to the basic principles, practices and concepts of modern financial management." *See* Page 1.

By contrast, Heath is allegedly directed toward "issues management", which is described as "the product of turbulent criticism and change that angry publics seek to impose on business policies and practices." *See* Page 1.

In further contrast, Stein's Abstract allegedly recites that:

[a] supervisory control system for a networked multimedia computing system permits a teacher or network administrator to quickly and easily update system software on selected destination workstations with the system software currently residing on the master workstation. In one mode of operation, only basic system software is updated, while user-defined preferences are unchanged. In a second mode of operation, both the system software and all user-controlled settings are replaced, to permit the remote workstations to be configured in a desired manner.

Applicant's disclosure is not available as a reference and even if it was, doesn't overcome the deficiencies of the applied portions of the remaining relied upon references.

The Final Office Action presents no evidence that one having ordinary skill in the art would have had any expectation of success, let alone a reasonable expectation of success, in combining the applied portions of the relied upon references. At most, the applied portions of the relied upon references provide "only general guidance as to the particular form of the claimed invention or how to achieve it."

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, expressly or inherently teach or suggest **every** limitation of claim 1 (another assumption that is respectfully traversed), there is still no evidence indicating a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action, and consequently, the Office Action fails to establish a *prima facie* case of obviousness.

h) Improper Reliance on *In re Venner*

The Final Office Action recites, at Pages 33-34:

Now to the argued claim limitations specifically, a known manual financial decision-making methodology was disclosed by McMenamin. Such prior art reference was modified through automation via *In re Venner*, to capture the benefits natural to such automation - speed, uniformity and/or reliability. Automation would have constituted the use of a computer to make such automation possible, an argument buttressed by the use of a computer network, as disclosed by Stein. The outsourcing of this financial function, either the outsourcing of the manual or the computerized process, would have been obvious in light of Disclosed Prior Art. Finally, a supervision system that allowed management to oversee their agents and/or employees at their individual workstations, is disclosed by Stein, serving to monitor and provide transparency concerning the actions of the agents.

Applicant again traverses the continued use of *In re Venner* in the rejection of any of the claimed subject matter of the present Application. Applicant reiterates that, as a case decided in 1958, *In re Venner* fails to properly consider the Graham factors regarding obviousness. As such it is no longer binding precedent and has at least been superseded by *Graham*.

i) Improper Reliance on Stein as a Reference

A proper Office Action must be complete as to all matters, must provide a clear explanation of all actions taken, and **must answer in detail** the substance of each of Applicant's submitted arguments (emphasis added). *See* MPEP 707.07(f).

In the Office Action Reply dated 11 April 2006, Applicant respectfully stated, at Page 30, "[s]imilarly, Applicant respectfully submits that Office Action presents no reasons, and certainly no "concrete evidence", that "the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select" anything from Stein. The Final Office Action is silent regarding this argument.

Stein allegedly recites, at the Abstract:

A supervisory control system for a networked multimedia computing system permits a teacher or network administrator to quickly and easily update system software on selected destination workstations with the system software currently residing on the master workstation. In one mode of operation, only basic system software is updated, while user-defined preferences are unchanged. In a second mode of operation, both the system software and all user-controlled settings are replaced, to permit the remote workstations to be configured in a desired manner.

No argument is advanced in either Office Action as to why one skilled in the art would select a reference directed to updating "basic system software" and "system software and all user-controlled settings" in a method relating to financial risk management.

Since the Final Office Action is silent regarding the argument regarding Stein, Applicant submits that the Final Office Action concedes that "the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention" would not select anything from Stein.

j) Conclusion

For at least the reasons mentioned above, a reversal of the rejection of claim 136 is respectfully requested.

137. Claim 137**a) Claim Construction**

In the present Application, the customary meaning for the phrase “financial risk management function” is implicitly defined in the specification and the properly cited prior art. That definition must control examination of those claims that recite this phrase.

At least at page 1, lines 5-7, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]he present invention relates to the field of financial risk management and trading, and, **more particularly**, to a method and system for clients to outsource financial functions to an agent.”

At least at page 2, lines 16-17, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]ypical financial functions are treasury, credit management, risk management, and trading, together with several of their associated sub-functions.”

At least at page 3, lines 1-3, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]he activities that make up these financial functions are the relevant daily operations of the front-office trading departments and the associated middle-office risk management and back-office support departments.”

Thus, the phrase “financial risk management function” should be construed as one of ordinary skill in the relevant art would interpret the definition provided in the specification.

Applicant respectfully notes a discussion regarding lexicography on Pages 26-27 of the Final Office Action. Page 26 of the Final Office Action recites:

Although the argued elements are found as examples and/or embodiments in the specification, they were not claimed explicitly in the disputed claim(s). Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. Therefore although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed Cir.

1993) and MPEP §2111.01.

Furthermore, while applicants may be their own lexicographer, any special meaning assigned to a term ‘must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.’ See *Multiform Desiccants Inc v. Medzam Ltd.*, 133 F3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). Examiner asserts that the specification fails to indicate a clear or obvious departure from the common and ordinary definition of the disputed claim term, and, therefore, the common and ordinary definition of the disputed claim term was properly utilized for application of prior art.

Applicant respectfully notes that *Phillips*, as an *en banc* decision, supersedes any prior or subsequent Federal Circuit case adjudicated by any panel that is not *en banc*. As a result, to the extent that *In re Van Geuns*, *Multiform*, or *In re Prater* differs from *Phillips*, they have been superseded thereby. The Final Office Action further alleges at pages 26-27:

For example, the specification states ‘[t]he present invention relates to the field of financial risk management and trading, and, more particularly, to a method and system for clients to outsource financial functions to an agent.’ (see p. 1, lines 5 - 7). Such statements indicate that the “financial functions” are a subset of “financial risk management” functions. However, the specification also states “[t]ypical financial functions are treasury, credit management, risk management, and trading, together with several of their associated sub-functions.” (emphasis added - see p 2, lines 16 - 17). Such statement indicates that “risk management” functions are a subset of “financial functions.” Such a contradiction falls far short of a clearly expressed desire to define claim terminology.

Applicant respectfully traverses this argument as fallacious. It is not necessarily follow that the phrase “[t]he present invention relates to the field of financial risk management and trading, and, more particularly, to a method and system for clients to outsource financial functions to an agent” necessarily means that “financial functions” are a

subset of “financial risk management” or of “financial risk management” functions. Thus, the above-recited allegation of the Final Office Action lacks a proper foundation and is not valid.

Accordingly, Applicant respectfully submits that claim construction regarding the phrase “financial risk management function” must be construed as one of ordinary skill in the relevant art would interpret that phrase as defined and/or guided by the specification. Since the Final Office Action fails to provide such a construction, Applicant respectfully requests a reversal of the rejection of claim 137.

b) Official Notice

The Final Office Action alleges, at Pages 27-28, that Applicants Office Action Reply dated 11 April 2006:

In response to the applicant's traversal of Official Notice finding(s) in previous office action, examiner asserts that the traversal is inadequate Adequate traversal is a two-step process. First, applicant(s) must state their traversal on the record. Second and in accordance with 37 C.F.R. 1.111(b) which requires applicant(s) to specifically point out the supposed errors in the Office Action, applicant(s) must state why the Official Notice statement(s) are not to be considered common knowledge or well known in the art.

In this application, while applicant(s) have clearly met step (1), applicant(s) have failed step (2) since they have failed to argue why the Official Notice statement(s) are not to be considered common knowledge or well known in the art. Because Applicant(s)' traversal is inadequate, the Official Notice statement(s) are taken to be admitted as prior art. See MPEP 2144.03.

In the applicant's response, the applicant merely made a blanket statement that '(to the extent that Official Notice is explicitly or implicitly utilized to support any rejection' and failed to even specify which claims the applicant is contesting, never mind articulating a basis for the applicant's arguments against the taking of Official Notice.

For example, should the applicant decide to traverse the taking of Official Notice in regards to Claim 39, applicant should argue that it is not common

knowledge nor well known in the art to utilize financial information including financial guidelines when making a financial decision. Or should the applicant decide to traverse the taking of Official Notice in regards to Claim 48, applicant should argue that it is not common knowledge nor well known in the art that financial management, either manual or automated financial management, involves cashflow management

Applicant respectfully traverses these allegations. Applicant respectfully notes that the phrase "Official Notice" does not appear whatsoever in any of the claim rejections of the Final Office Action or the prior Office Action dated 13 January 2006. Applicant respectfully submits that if, indeed, it was the intention of either Office Action to take Official Notice regarding any of the articulated grounds of rejection, that both Office Actions utterly fail to comply with the requirements of MPEP § 707.07(d) since neither provides "ground[s] of rejection [that are] fully and clearly stated". For example, if either Office Action intended to rely upon Official Notice for rejecting claim 39 and/or claim 48, as implied on Page 28 of the Final Office Action, each respective Office Action based thereupon was required to clearly state Official Notice as a grounds of rejection for each of those claims. Applicant respectfully notes that neither 37 C.F.R. 1.111 nor the MPEP require Applicant to be clairvoyant regarding the grounds of rejection of an Office Action.

Applicant respectfully submits that the Office Action Reply dated 11 April 2006 was "reduced to a writing" and "distinctly and specifically point[ed] out the supposed errors in the examiner's action" and "repl[ied] to every ground of objection and rejection in the prior Office action." As such, the Office Action Reply dated 11 April 2006 fully complied with 37 C.F.R. 1.111(b). Applicant respectfully submits that the allegations of the Final Office Action such as, *inter alia*, "should the applicant decide to traverse the taking of Official Notice in regards to Claim 39, applicant should argue that it is not common knowledge nor well known in the art to utilize financial information including financial guidelines when making a financial decision", are without legal basis under 37 C.F.R. 1.111(b).

In addition, since Applicant has traversed the use of Official Notice, to the extent that Official Notice was used in rejecting the claims, "the examiner **must provide documentary evidence in the next Office Action** if the rejection is to be maintained. *See* 37 CFR 1.104(c)(2)

and MPEP 2144.03C. *See also In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Since the Final Office Action utterly fails to provide any such reference for any claim, and appears to indicate that Official Notice was used in the rejections (at least of claims 27-32, 34-37, 39-111, 131, and 132, *see* Page 33), Applicant respectfully submits that each rejection based upon Official Notice must be reversed for at least that reason.

c) Inherency

To the extent that either Office Action relied on inherency to support a claim rejection, Applicant respectfully traverses and requests a reversal of each rejection based thereon since a detailed explanation has not been provided demonstrating that the “missing descriptive material is necessarily present, not merely probably or possibly present”, in any prior art reference cited to supporting such rejection.

d) Allegedly “Disclosed Prior Art”

The Final Office Action asserts, “applicant’s specification, pp. 1-2” is “Disclosed Prior Art”. Applicant respectfully traverses this assertion.

Although Applicant has submitted multiple Information Disclosure Statements that potentially list “prior art”, Applicant does **not** admit that pages 1-2 of Applicant’s specification describe “prior art”, nor has any evidence been presented that any aspect of pages 1-2 of Applicant’s specification can be used as prior art. Thus, no statement on pages 1-2 of Applicant’s specification can serve as a proper basis for claim rejections under 35 U.S.C. 103(a) and the attempt to do so in the Final Office Action is improper and should be withdrawn.

The Final Office Action alleges, at Page 28:

In response to the applicant's argument that the specification does not constitute Disclosed Prior Art, the MPEP states that when “the specification's background of the invention describes information as being known or conventional, [it] may be considered as an admission of prior art.” MPEP § 704.11 (a). To that end, the background does utilize terminology that indicates the disclosed information is known or conventional through the use of language such as “commonly”, “frequently”, “conventionally” and/or “traditionally.” Therefore,

examiner asserts that information contained within the specification under the title “Background of the Invention” is an admission of prior art and, therefore, Disclosed Prior Art.

With all due respect, the Federal Circuit has held that “[o]ne's own work may **not** be considered prior art in the absence of a statutory basis”. The MPEP is not a statute, nor does it have sufficient legal authority to overcome a Federal Circuit holding. Applicant respectfully submits that the Final Office Action provides no statutory basis for the use of Applicant's disclosure as prior art.

e) Missing *Claim* Limitations

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d).

For example, claim 137 states, *inter alia*, that “providing financial information on one or more financial risk management functions of each client to a computer of the agent”. The omnibus rejection of claim groups by the references relied upon in the Office Action makes no mention of “providing financial information on one or more financial risk management functions of each client to a computer of the agent”, and fails to point out where, in any of the references, that limitation is disclosed.

In addition, claim 137 states, *inter alia*, that “enabling the agent to determine an action based on an analysis of risk management information created from the financial information”. The omnibus rejection of claim groups by the references relied upon in the Office Action makes no mention of “enabling the agent to determine an action based on an analysis of risk management information created from the financial information”, and fails to point out where, in any of the references, that limitation is disclosed.

In addition, claim 137 states, *inter alia*, that “allowing the agent to facilitate the implementation of the action”. The omnibus rejection of claim groups by the references relied upon in the Office Action makes no mention of “allowing the agent to facilitate the implementation of the action”, and fails to point out where, in any of the references, that limitation is disclosed.

Claim 137 recites, *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach or suggest, expressly or inherently, an “apparatus for a client to **outsource financial risk management functions to an agent** representing a plurality of institutional or corporate clients”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

f) No Motivation or Suggestion to Combine the Applied References

Instead, regarding selected proffered combinations, the Final Office Action improperly states that “McMenamin discloses a method for providing financial functions (financial management)”. This is a mischaracterization of McMenamin and the claimed subject matter. At most, the cited portions of McMenamin allegedly provide an “introduction” to “financial management”. The cited portions of McMenamin do not teach or disclose any “computer-assisted methods” for providing “financial risk management functions” by “an agent”, and Applicant respectfully submits that Office Action presents no reasons, and certainly no “concrete evidence” that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from McMenamin.

The Final Office Action asserts, at Page 4:

McMenamin does not teach that providing financial functions comprising said steps is automated. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine

skill in the art. *In re Venner*, 120 USPQ 192.

Applicant respectfully points out that *In re Venner* was decided in 1958. As such, *In re Venner* did not apply the *Graham* test, *see supra*, regarding obviousness. As a result, Applicant respectfully submits that no evidence is presented that the proposition for which *In re Venner* is cited is still valid law. Applicant respectfully notes that the Federal Circuit has failed to cite *In re Venner* in any case whatsoever. Moreover, even if *In re Venner* were still valid for the point of law for which it is presented, no *prima facie* case is presented that the claimed subject matter of the present application is disclosed in any of the applied portions of the relied upon references as a “manual activity that accomplishes the same result.”

Moreover, Applicant respectfully submits that Office Action presents no reasons that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from Heath. Instead, it seems quite likely that one of skill in the art would instantly reject Heath as completely irrelevant, since Heath is a reference allegedly directed to the “public policy challenges” facing “organizations”, rather than “financial risk management functions”. Heath explains that “the heart of issues management ‘is reconciliation of conflicting internal interests on public policy issues of strategic importance in order to make a coherent external advocacy’”. Applicant respectfully asks how the “reconciliation of conflicting internal interests on public policy issues” relates in the least to the claimed subject matter? Applicant also respectfully asks where is the concrete evidence that Heath is “within the field of the inventor's endeavor”, and if not, “is reasonably pertinent to the **particular problem** with which the inventor was involved”?

Similarly, Applicant respectfully submits that Office Action presents no reasons, and certainly no “concrete evidence”, that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from Stein.

Furthermore, even assuming, *arguendo*, that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” McMenamin, Heath, and Stein, the Office Action presents no concrete evidence of a suggestion, motivation, or teaching **in the prior art** that would have led a person of ordinary skill in the art to combine these references in the manner claimed.

In addition, Applicant respectfully notes that the Final Office Action impermissibly relies

on Applicant's disclosure on Page 5 in rejecting claim 137. As noted, supra, Applicant does not admit that any of contents of the present Application is prior art. Accordingly, Applicant respectfully traverses the impermissible use of "p. 2, lines 4-9) of the present Application as prior art by the Final Office Action.

The Final Office Action asserts at Pages 30 and 31:

In response to applicant's argument that there is no suggestion to combine the references, the Courts have stated that "[a] suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references ... The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art ... there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (emphasis added). *In re Kahn*, 78 USPQ2d 1329, 1336 (CA FC 2006). Examiner asserts that he can and/or has provided such "articulated reasoning to support the legal conclusion of obviousness.

Applicant respectfully submits that the legal analysis presented in *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006), requires that "underlying factual findings" of the USPTO, "including a finding of a motivation to combine" must be supported by "substantial evidence *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000)). Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence. *Id.* at 1312 (citing *Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229-30 (1938)). According to the Federal Circuit "[t]he presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact." *Alza Corp. v. Mylan Laboratories, Inc.*, 2006 U.S. App. LEXIS 22616 (Fed. Cir. 2006) (citing *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000)); accord *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 (Fed. Cir. 2000). Likewise, the presence or absence of a "reasonable expectation of success" from making such a combination is also a pure question of fact. *Alza Corp. v. Mylan Laboratories, Inc.*, 2006 U.S. App. LEXIS 22616 (Fed. Cir. 2006) (citing *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006)).

The allegations of the Final Office Action regarding the alleged suggestions or motivations for modifying and/or combining references comprise little more than bald assertions and do not appear to be supported by even a “mere scintilla of evidence”. That is, the Final Office Action presents **no factual basis** upon which the allegations regarding suggestions or motivations to combine references are based. Applicant respectfully reiterates that a “bald assertion of knowledge generally available to one of ordinary skill in the art to bridge the evidentiary gap is improper. Such unfounded assertions are not permissible substitutes for evidence. *See In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). In other words, deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.*

For at least this reason, Applicant respectfully submits that the allegations responding to Applicant’s argument presented in the Office Action Reply dated 11 April 2006 are unsupported and fail to provide any evidentiary support regarding any suggestion or motivation to combine the applied portions of the relied upon references.

g) No Reasonable Expectation of Success

The Final Office Action attempts to, impermissibly, combine portions of Applicants own disclosure and three additional references in rejecting claim 1, McMenamin, Heath, and Stein.

Applicant respectfully submits that McMenamin is allegedly directed to an “introduction to the basic principles, practices and concepts of modern financial management.” *See* Page 1.

By contrast, Heath is allegedly directed toward “issues management”, which is described as “the product of turbulent criticism and change that angry publics seek to impose on business policies and practices.” *See* Page 1.

In further contrast, Stein’s Abstract allegedly recites that:

[a] supervisory control system for a networked multimedia computing system permits a teacher or network administrator to quickly and easily update system software on selected destination workstations with the system software currently residing on the master workstation. In one mode of operation, only basic system

software is updated, while user-defined preferences are unchanged. In a second mode of operation, both the system software and all user-controlled settings are replaced, to permit the remote workstations to be configured in a desired manner.

Applicant's disclosure is not available as a reference and even if it was, doesn't overcome the deficiencies of the applied portions of the remaining relied upon references.

The Final Office Action presents no evidence that one having ordinary skill in the art would have had any expectation of success, let alone a reasonable expectation of success, in combining the applied portions of the relied upon references. At most, the applied portions of the relied upon references provide "only general guidance as to the particular form of the claimed invention or how to achieve it."

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, expressly or inherently teach or suggest **every** limitation of claim 1 (another assumption that is respectfully traversed), there is still no evidence indicating a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action, and consequently, the Office Action fails to establish a *prima facie* case of obviousness.

h) Improper Reliance on *In re Venner*

The Final Office Action recites, at Pages 33-34:

Now to the argued claim limitations specifically, a known manual financial decision-making methodology was disclosed by McMenamin. Such prior art reference was modified through automation via *In re Venner*, to capture the benefits natural to such automation - speed, uniformity and/or reliability. Automation would have constituted the use of a computer to make such automation possible, an argument buttressed by the use of a computer network, as disclosed by Stein. The outsourcing of this financial function, either the outsourcing of the manual or the computerized process, would have been obvious in light of Disclosed Prior Art. Finally, a supervision system that

allowed management to oversee their agents and/or employees at their individual workstations, is disclosed by Stein, serving to monitor and provide transparency concerning the actions of the agents.

Applicant again traverses the continued use of *In re Venner* in the rejection of any of the claimed subject matter of the present Application. Applicant reiterates that, as a case decided in 1958, *In re Venner* fails to properly consider the Graham factors regarding obviousness. As such it is no longer binding precedent and has at least been superseded by *Graham*.

i) Improper Reliance on Stein as a Reference

A proper Office Action must be complete as to all matters, must provide a clear explanation of all actions taken, and **must answer in detail** the substance of each of Applicant's submitted arguments (emphasis added). *See* MPEP 707.07(f).

In the Office Action Reply dated 11 April 2006, Applicant respectfully stated, at Page 30, "[s]imilarly, Applicant respectfully submits that Office Action presents no reasons, and certainly no "concrete evidence", that "the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select" anything from Stein. The Final Office Action is silent regarding this argument.

Stein allegedly recites, at the Abstract:

A supervisory control system for a networked multimedia computing system permits a teacher or network administrator to quickly and easily update system software on selected destination workstations with the system software currently residing on the master workstation. In one mode of operation, only basic system software is updated, while user-defined preferences are unchanged. In a second mode of operation, both the system software and all user-controlled settings are replaced, to permit the remote workstations to be configured in a desired manner.

No argument is advanced in either Office Action as to why one skilled in the art would select a reference directed to updating "basic system software" and "system software and all user-controlled settings" in a method relating to financial risk management.

Since the Final Office Action is silent regarding the argument regarding Stein, Applicant submits that the Final Office Action concedes that "the skilled artisan, confronted with the same

problems as the inventor and with no knowledge of the claimed invention” would not select anything from Stein.

j) Conclusion

For at least the reasons mentioned above, a reversal of the rejection of claim 137 is respectfully requested.

138. Claim 138

a) Claim Construction

In the present Application, the customary meaning for the phrase “financial risk management function” is implicitly defined in the specification and the properly cited prior art. That definition must control examination of those claims that recite this phrase.

At least at page 1, lines 5-7, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]he present invention relates to the field of financial risk management and trading, and, **more particularly**, to a method and system for clients to outsource financial functions to an agent.”

At least at page 2, lines 16-17, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]ypical financial functions are treasury, credit management, risk management, and trading, together with several of their associated sub-functions.”

At least at page 3, lines 1-3, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]he activities that make up these financial functions are the relevant daily operations of the front-office trading departments and the associated middle-office risk management and back-office support departments.”

Thus, the phrase “financial risk management function” should be construed as one of ordinary skill in the relevant art would interpret the definition provided in the specification.

Applicant respectfully notes a discussion regarding lexicography on Pages 26-27 of the Final Office Action. Page 26 of the Final Office Action recites:

Although the argued elements are found as examples and/or embodiments in

the specification, they were not claimed explicitly in the disputed claim(s). Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. Therefore although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed Cir. 1993) and MPEP §2111.01.

Furthermore, while applicants may be their own lexicographer, any special meaning assigned to a term ‘must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.’ *See Multiform Desiccants Inc v. Medzam Ltd.*, 133 F3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). Examiner asserts that the specification fails to indicate a clear or obvious departure from the common and ordinary definition of the disputed claim term, and, therefore, the common and ordinary definition of the disputed claim term was properly utilized for application of prior art.

Applicant respectfully notes that *Phillips*, as an *en banc* decision, supersedes any prior or subsequent Federal Circuit case adjudicated by any panel that is not *en banc*. As a result, to the extent that *In re Van Geuns*, *Multiform*, or *In re Prater* differs from *Phillips*, they have been superseded thereby. The Final Office Action further alleges at pages 26-27:

For example, the specification states ‘[t]he present invention relates to the field of financial risk management and trading, and, more particularly, to a method and system for clients to outsource financial functions to an agent.’ (see p. 1, lines 5 - 7). Such statements indicate that the “financial functions” are a subset of “financial risk management” functions. However, the specification also states “[t]ypical financial functions are treasury, credit management, risk management, and trading, together with several of their associated sub-functions.” (emphasis added - see p 2, lines 16 - 17). Such statement indicates that “risk management” functions are a subset of “financial functions.” Such a

contradiction falls far short of a clearly expressed desire to define claim terminology.

Applicant respectfully traverses this argument as fallacious. It is not necessarily follow that the phrase “[t]he present invention relates to the field of financial risk management and trading, and, more particularly, to a method and system for clients to outsource financial functions to an agent” necessarily means that “financial functions” are a subset of “financial risk management” or of “financial risk management” functions. Thus, the above-recited allegation of the Final Office Action lacks a proper foundation and is not valid.

Accordingly, Applicant respectfully submits that claim construction regarding the phrase “financial risk management function” must be construed as one of ordinary skill in the relevant art would interpret that phrase as defined and/or guided by the specification. Since the Final Office Action fails to provide such a construction, Applicant respectfully requests a reversal of the rejection of claim 138.

b) Official Notice

The Final Office Action alleges, at Pages 27-28, that Applicants Office Action Reply dated 11 April 2006:

In response to the applicant's traversal of Official Notice finding(s) in previous office action, examiner asserts that the traversal is inadequate Adequate traversal is a two-step process. First, applicant(s) must state their traversal on the record. Second and in accordance with 37 C.F.R. 1.111(b) which requires applicant(s) to specifically point out the supposed errors in the Office Action, applicant(s) must state why the Official Notice statement(s) are not to be considered common knowledge or well known in the art.

In this application, while applicant(s) have clearly met step (1), applicant(s) have failed step (2) since they have failed to argue why the Official Notice statement(s) are not to be considered common knowledge or well known in the art. Because Applicant(s)' traversal is inadequate, the Official Notice statement(s) are taken to be admitted as prior art. See MPEP 2144.03.

In the applicant's response, the applicant merely made a blanket statement that '(to the extent that Official Notice is explicitly or implicitly utilized to support any rejection' and failed to even specify which claims the applicant is contesting, never mind articulating a basis for the applicant's arguments against the taking of Official Notice.

For example, should the applicant decide to traverse the taking of Official Notice in regards to Claim 39, applicant should argue that it is not common knowledge nor well known in the art to utilize financial information including financial guidelines when making a financial decision. Or should the applicant decide to traverse the taking of Official Notice in regards to Claim 48, applicant should argue that it is not common knowledge nor well known in the art that financial management, either manual or automated financial management, involves cashflow management

Applicant respectfully traverses these allegations. Applicant respectfully notes that the phrase "Official Notice" does not appear whatsoever in any of the claim rejections of the Final Office Action or the prior Office Action dated 13 January 2006. Applicant respectfully submits that if, indeed, it was the intention of either Office Action to take Official Notice regarding any of the articulated grounds of rejection, that both Office Actions utterly fail to comply with the requirements of MPEP § 707.07(d) since neither provides "ground[s] of rejection [that are] fully and clearly stated". For example, if either Office Action intended to rely upon Official Notice for rejecting claim 39 and/or claim 48, as implied on Page 28 of the Final Office Action, each respective Office Action based thereupon was required to clearly state Official Notice as a grounds of rejection for each of those claims. Applicant respectfully notes that neither 37 C.F.R. 1.111 nor the MPEP require Applicant to be clairvoyant regarding the grounds of rejection of an Office Action.

Applicant respectfully submits that the Office Action Reply dated 11 April 2006 was "reduced to a writing" and "distinctly and specifically point[ed] out the supposed errors in the examiner's action" and "repl[ied] to every ground of objection and rejection in the prior Office action." As such, the Office Action Reply dated 11 April 2006 fully complied with 37 C.F.R. 1.111(b). Applicant respectfully submits that the allegations of the Final Office Action such as,

inter alia, “should the applicant decide to traverse the taking of Official Notice in regards to Claim 39, applicant should argue that it is not common knowledge nor well known in the art to utilize financial information including financial guidelines when making a financial decision”, are without legal basis under 37 C.F.R. 1.111(b).

In addition, since Applicant has traversed the use of Official Notice, to the extent that Official Notice was used in rejecting the claims, “the examiner **must provide documentary evidence in the next Office Action** if the rejection is to be maintained. *See* 37 CFR 1.104(c)(2) and MPEP 2144.03C. *See also In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Since the Final Office Action utterly fails to provide any such reference for any claim, and appears to indicate that Official Notice was used in the rejections (at least of claims 27-32, 34-37, 39-111, 131, and 132, *see* Page 33), Applicant respectfully submits that each rejection based upon Official Notice must be reversed for at least that reason.

c) Inherency

To the extent that either Office Action relied on inherency to support a claim rejection, Applicant respectfully traverses and requests a reversal of each rejection based thereon since a detailed explanation has not been provided demonstrating that the “missing descriptive material is necessarily present, not merely probably or possibly present”, in any prior art reference cited to supporting such rejection.

d) Allegedly “Disclosed Prior Art”

The Final Office Action asserts, “applicant’s specification, pp. 1-2” is “Disclosed Prior Art”. Applicant respectfully traverses this assertion.

Although Applicant has submitted multiple Information Disclosure Statements that potentially list “prior art”, Applicant does **not** admit that pages 1-2 of Applicant’s specification describe “prior art”, nor has any evidence been presented that any aspect of pages 1-2 of Applicant’s specification can be used as prior art. Thus, no statement on pages 1-2 of Applicant’s specification can serve as a proper basis for claim rejections under 35 U.S.C. 103(a) and the attempt to do so in the Final Office Action is improper and should be withdrawn.

The Final Office Action alleges, at Page 28:

In response to the applicant's argument that the specification does not constitute Disclosed Prior Art, the MPEP states that when “the specification's background of the invention describes information as being known or conventional, [it] may be considered as an admission of prior art.” MPEP § 704.11 (a). To that end, the background does utilize terminology that indicates the disclosed information is known or conventional through the use of language such as “commonly”, “frequently”, “conventionally” and/or “traditionally.” Therefore, examiner asserts that information contained within the specification under the title “Background of the Invention” is an admission of prior art and, therefore, Disclosed Prior Art.

With all due respect, the Federal Circuit has held that “[o]ne's own work may **not** be considered prior art in the absence of a statutory basis”. The MPEP is not a statute, nor does it have sufficient legal authority to overcome a Federal Circuit holding. Applicant respectfully submits that the Final Office Action provides no statutory basis for the use of Applicant's disclosure as prior art.

e) Missing *Claim* Limitations

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d).

For example, claim 138 states, *inter alia*, “facilitating implementation, on behalf of the client, of an agent's action based on the analysis”. The omnibus rejection of claim groups by the references relied upon in the Office Action makes no mention of “facilitating implementation, on behalf of the client, of an agent's action based on the analysis”, and fails to point out where, in any of the references, that limitation is disclosed.

Claim 138 recites *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach or suggest, expressly or inherently, a “computer-assisted method for an agent to provide financial risk management functions to each of a plurality of institutional or corporate clients”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

f) No Motivation or Suggestion to Combine the Applied References

Instead, regarding selected proffered combinations, the Final Office Action improperly states that “McMenamin discloses a method for providing financial functions (financial management)”. This is a mischaracterization of McMenamin and the claimed subject matter. At most, the cited portions of McMenamin allegedly provide an “introduction” to “financial management”. The cited portions of McMenamin do not teach or disclose any “computer-assisted methods” for providing “financial risk management functions” by “an agent”, and Applicant respectfully submits that Office Action presents no reasons, and certainly no “concrete evidence” that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from McMenamin.

The Final Office Action asserts, at Page 4:

McMenamin does not teach that providing financial functions comprising said steps is automated. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Applicant respectfully points out that *In re Venner* was decided in 1958. As such, *In re Venner* did not apply the *Graham* test, *see supra*, regarding obviousness. As a result, Applicant respectfully submits that no evidence is presented that the proposition for which *In re Venner* is

cited is still valid law. Applicant respectfully notes that the Federal Circuit has failed to cite *In re Venner* in any case whatsoever. Moreover, even if *In re Venner* were still valid for the point of law for which it is presented, no *prima facie* case is presented that the claimed subject matter of the present application is disclosed in any of the applied portions of the relied upon references as a “manual activity that accomplishes the same result.”

Moreover, Applicant respectfully submits that Office Action presents no reasons that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from Heath. Instead, it seems quite likely that one of skill in the art would instantly reject Heath as completely irrelevant, since Heath is a reference allegedly directed to the “public policy challenges” facing “organizations”, rather than “financial risk management functions”. Heath explains that “the heart of issues management ‘is reconciliation of conflicting internal interests on public policy issues of strategic importance in order to make a coherent external advocacy’”. Applicant respectfully asks how the “reconciliation of conflicting internal interests on public policy issues” relates in the least to the claimed subject matter? Applicant also respectfully asks where is the concrete evidence that Heath is “within the field of the inventor's endeavor”, and if not, “is reasonably pertinent to the **particular problem** with which the inventor was involved”?

Similarly, Applicant respectfully submits that Office Action presents no reasons, and certainly no “concrete evidence”, that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from Stein.

Furthermore, even assuming, *arguendo*, that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” McMenamin, Heath, and Stein, the Office Action presents no concrete evidence of a suggestion, motivation, or teaching **in the prior art** that would have led a person of ordinary skill in the art to combine these references in the manner claimed.

In addition, Applicant respectfully notes that the Final Office Action impermissibly relies on Applicant's disclosure on Page 5 in rejecting claim 138. As noted, *supra*, Applicant does not admit that any of contents of the present Application is prior art. Accordingly, Applicant respectfully traverses the impermissible use of “p. 2, lines 4-9) of the present Application as prior art by the Final Office Action.

The Final Office Action asserts at Pages 30 and 31:

In response to applicant's argument that there is no suggestion to combine the references, the Courts have stated that “[a] suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references ... The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art ... there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (emphasis added). *In re Kahn*, 78 USPQ2d 1329, 1336 (CA FC 2006). Examiner asserts that he can and/or has provided such “articulated reasoning to support the legal conclusion of obviousness.

Applicant respectfully submits that the legal analysis presented in *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006), requires that “underlying factual findings” of the USPTO, “including a finding of a motivation to combine” must be supported by “substantial evidence *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000)). Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence. *Id.* at 1312 (citing *Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229-30 (1938)). According to the Federal Circuit “[t]he presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact.” *Alza Corp. v. Mylan Laboratories, Inc.*, 2006 U.S. App. LEXIS 22616 (Fed. Cir. 2006) (citing *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000)); accord *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 (Fed. Cir. 2000). Likewise, the presence or absence of a “reasonable expectation of success” from making such a combination is also a pure question of fact. *Alza Corp. v. Mylan Laboratories, Inc.*, 2006 U.S. App. LEXIS 22616 (Fed. Cir. 2006) (citing *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006)).

The allegations of the Final Office Action regarding the alleged suggestions or motivations for modifying and/or combining references comprise little more than bald assertions and do not appear to be supported by even a “mere scintilla of evidence”. That is, the Final Office Action presents **no factual basis** upon which the allegations regarding suggestions or

motivations to combine references are based. Applicant respectfully reiterates that a “bald assertion of knowledge generally available to one of ordinary skill in the art to bridge the evidentiary gap is improper. Such unfounded assertions are not permissible substitutes for evidence. *See In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). In other words, deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.*

For at least this reason, Applicant respectfully submits that the allegations responding to Applicant’s argument presented in the Office Action Reply dated 11 April 2006 are unsupported and fail to provide any evidentiary support regarding any suggestion or motivation to combine the applied portions of the relied upon references.

g) No Reasonable Expectation of Success

The Final Office Action attempts to, impermissibly, combine portions of Applicants own disclosure and three additional references in rejecting claim 1, McMenamin, Heath, and Stein.

Applicant respectfully submits that McMenamin is allegedly directed to an “introduction to the basic principles, practices and concepts of modern financial management.” *See* Page 1.

By contrast, Heath is allegedly directed toward “issues management”, which is described as “the product of turbulent criticism and change that angry publics seek to impose on business policies and practices.” *See* Page 1.

In further contrast, Stein’s Abstract allegedly recites that:

[a] supervisory control system for a networked multimedia computing system permits a teacher or network administrator to quickly and easily update system software on selected destination workstations with the system software currently residing on the master workstation. In one mode of operation, only basic system software is updated, while user-defined preferences are unchanged. In a second mode of operation, both the system software and all user-controlled settings are replaced, to permit the remote workstations to be configured in a desired manner.

Applicant’s disclosure is not available as a reference and even if it was, doesn’t overcome

the deficiencies of the applied portions of the remaining relied upon references.

The Final Office Action presents no evidence that one having ordinary skill in the art would have had any expectation of success, let alone a reasonable expectation of success, in combining the applied portions of the relied upon references. At most, the applied portions of the relied upon references provide “only general guidance as to the particular form of the claimed invention or how to achieve it.”

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, expressly or inherently teach or suggest every limitation of claim 1 (another assumption that is respectfully traversed), there is still no evidence indicating a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action, and consequently, the Office Action fails to establish a *prima facie* case of obviousness.

h) Improper Reliance on *In re Venner*

The Final Office Action recites, at Pages 33-34:

Now to the argued claim limitations specifically, a known manual financial decision-making methodology was disclosed by McMenamin. Such prior art reference was modified through automation via *In re Venner*, to capture the benefits natural to such automation - speed, uniformity and/or reliability. Automation would have constituted the use of a computer to make such automation possible, an argument buttressed by the use of a computer network, as disclosed by Stein. The outsourcing of this financial function, either the outsourcing of the manual or the computerized process, would have been obvious in light of Disclosed Prior Art. Finally, a supervision system that allowed management to oversee their agents and/or employees at their individual workstations, is disclosed by Stein, serving to monitor and provide transparency concerning the actions of the agents.

Applicant again traverses the continued use of *In re Venner* in the rejection of any of the

claimed subject matter of the present Application. Applicant reiterates that, as a case decided in 1958, *In re Venner* fails to properly consider the Graham factors regarding obviousness. As such it is no longer binding precedent and has at least been superseded by *Graham*.

i) Improper Reliance on Stein as a Reference

A proper Office Action must be complete as to all matters, must provide a clear explanation of all actions taken, and **must answer in detail** the substance of each of Applicant's submitted arguments (emphasis added). *See* MPEP 707.07(f).

In the Office Action Reply dated 11 April 2006, Applicant respectfully stated, at Page 30, “[s]imilarly, Applicant respectfully submits that Office Action presents no reasons, and certainly no “concrete evidence”, that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from Stein. The Final Office Action is silent regarding this argument.

Stein allegedly recites, at the Abstract:

A supervisory control system for a networked multimedia computing system permits a teacher or network administrator to quickly and easily update system software on selected destination workstations with the system software currently residing on the master workstation. In one mode of operation, only basic system software is updated, while user-defined preferences are unchanged. In a second mode of operation, both the system software and all user-controlled settings are replaced, to permit the remote workstations to be configured in a desired manner.

No argument is advanced in either Office Action as to why one skilled in the art would select a reference directed to updating “basic system software” and “system software and all user-controlled settings” in a method relating to financial risk management.

Since the Final Office Action is silent regarding the argument regarding Stein, Applicant submits that the Final Office Action concedes that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention” would not select anything from Stein.

j) Conclusion

For at least the reasons mentioned above, a reversal of the rejection of claim 138 is respectfully requested.

139. Claim 139**a) Claim Construction**

In the present Application, the customary meaning for the phrase “financial risk management function” is implicitly defined in the specification and the properly cited prior art. That definition must control examination of those claims that recite this phrase.

At least at page 1, lines 5-7, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]he present invention relates to the field of financial risk management and trading, and, **more particularly**, to a method and system for clients to outsource financial functions to an agent.”

At least at page 2, lines 16-17, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]ypical financial functions are treasury, credit management, risk management, and trading, together with several of their associated sub-functions.”

At least at page 3, lines 1-3, the specification of the present Application implicitly defines the term “financial risk management function” by stating that: “[t]he activities that make up these financial functions are the relevant daily operations of the front-office trading departments and the associated middle-office risk management and back-office support departments.”

Thus, the phrase “financial risk management function” should be construed as one of ordinary skill in the relevant art would interpret the definition provided in the specification.

Applicant respectfully notes a discussion regarding lexicography on Pages 26-27 of the Final Office Action. Page 26 of the Final Office Action recites:

Although the argued elements are found as examples and/or embodiments in the specification, they were not claimed explicitly in the disputed claim(s). Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence

to indicate that these limitations must be imported into the claims to give meaning to disputed terms. Therefore although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed Cir. 1993) and MPEP §2111.01.

Furthermore, while applicants may be their own lexicographer, any special meaning assigned to a term ‘must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.’ *See Multiform Desiccants Inc v. Medzam Ltd.*, 133 F3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). Examiner asserts that the specification fails to indicate a clear or obvious departure from the common and ordinary definition of the disputed claim term, and, therefore, the common and ordinary definition of the disputed claim term was properly utilized for application of prior art.

Applicant respectfully notes that *Phillips*, as an *en banc* decision, supersedes any prior or subsequent Federal Circuit case adjudicated by any panel that is not *en banc*. As a result, to the extent that *In re Van Geuns*, *Multiform*, or *In re Prater* differs from *Phillips*, they have been superseded thereby. The Final Office Action further alleges at pages 26-27:

For example, the specification states ‘[t]he present invention relates to the field of financial risk management and trading, and, more particularly, to a method and system for clients to outsource financial functions to an agent.’ (see p. 1, lines 5 - 7). Such statements indicate that the “financial functions” are a subset of “financial risk management” functions. However, the specification also states “[t]ypical financial functions are treasury, credit management, risk management, and trading, together with several of their associated sub-functions.” (emphasis added - see p 2, lines 16 - 17). Such statement indicates that “risk management” functions are a subset of “financial functions.” Such a contradiction falls far short of a clearly expressed desire to define claim terminology.

Applicant respectfully traverses this argument as fallacious. It is not necessarily follow that the phrase “[t]he present invention relates to the field of financial risk management and trading, and, more particularly, to a method and system for clients to outsource financial functions to an agent” necessarily means that “financial functions” are a subset of “financial risk management” or of “financial risk management” functions. Thus, the above-recited allegation of the Final Office Action lacks a proper foundation and is not valid.

Accordingly, Applicant respectfully submits that claim construction regarding the phrase “financial risk management function” must be construed as one of ordinary skill in the relevant art would interpret that phrase as defined and/or guided by the specification. Since the Final Office Action fails to provide such a construction, Applicant respectfully requests a reversal of the rejection of claim 139.

b) Official Notice

The Final Office Action alleges, at Pages 27-28, that Applicants Office Action Reply dated 11 April 2006:

In response to the applicant's traversal of Official Notice finding(s) in previous office action, examiner asserts that the traversal is inadequate Adequate traversal is a two-step process. First, applicant(s) must state their traversal on the record. Second and in accordance with 37 C.F.R. 1.111(b) which requires applicant(s) to specifically point out the supposed errors in the Office Action, applicant(s) must state why the Official Notice statement(s) are not to be considered common knowledge or well known in the art.

In this application, while applicant(s) have clearly met step (1), applicant(s) have failed step (2) since they have failed to argue why the Official Notice statement(s) are not to be considered common knowledge or well known in the art. Because Applicant(s)' traversal is inadequate, the Official Notice statement(s) are taken to be admitted as prior art. See MPEP 2144.03.

In the applicant's response, the applicant merely made a blanket statement that '(to the extent that Official Notice is explicitly or implicitly utilized to support any rejection' and failed to even specify which claims the applicant is

contesting, never mind articulating a basis for the applicant's arguments against the taking of Official Notice.

For example, should the applicant decide to traverse the taking of Official Notice in regards to Claim 39, applicant should argue that it is not common knowledge nor well known in the art to utilize financial information including financial guidelines when making a financial decision. Or should the applicant decide to traverse the taking of Official Notice in regards to Claim 48, applicant should argue that it is not common knowledge nor well known in the art that financial management, either manual or automated financial management, involves cashflow management

Applicant respectfully traverses these allegations. Applicant respectfully notes that the phrase "Official Notice" does not appear whatsoever in any of the claim rejections of the Final Office Action or the prior Office Action dated 13 January 2006. Applicant respectfully submits that if, indeed, it was the intention of either Office Action to take Official Notice regarding any of the articulated grounds of rejection, that both Office Actions utterly fail to comply with the requirements of MPEP § 707.07(d) since neither provides "ground[s] of rejection [that are] fully and clearly stated". For example, if either Office Action intended to rely upon Official Notice for rejecting claim 39 and/or claim 48, as implied on Page 28 of the Final Office Action, each respective Office Action based thereupon was required to clearly state Official Notice as a grounds of rejection for each of those claims. Applicant respectfully notes that neither 37 C.F.R. 1.111 nor the MPEP require Applicant to be clairvoyant regarding the grounds of rejection of an Office Action.

Applicant respectfully submits that the Office Action Reply dated 11 April 2006 was "reduced to a writing" and "distinctly and specifically point[ed] out the supposed errors in the examiner's action" and "repl[ied] to every ground of objection and rejection in the prior Office action." As such, the Office Action Reply dated 11 April 2006 fully complied with 37 C.F.R. 1.111(b). Applicant respectfully submits that the allegations of the Final Office Action such as, *inter alia*, "should the applicant decide to traverse the taking of Official Notice in regards to Claim 39, applicant should argue that it is not common knowledge nor well known in the art

to utilize financial information including financial guidelines when making a financial decision”, are without legal basis under 37 C.F.R. 1.111(b).

In addition, since Applicant has traversed the use of Official Notice, to the extent that Official Notice was used in rejecting the claims, “the examiner **must provide documentary evidence in the next Office Action** if the rejection is to be maintained. *See* 37 CFR 1.104(c)(2) and MPEP 2144.03C. *See also In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Since the Final Office Action utterly fails to provide any such reference for any claim, and appears to indicate that Official Notice was used in the rejections (at least of claims 27-32, 34-37, 39-111, 131, and 132, *see* Page 33), Applicant respectfully submits that each rejection based upon Official Notice must be reversed for at least that reason.

c) Inherency

To the extent that either Office Action relied on inherency to support a claim rejection, Applicant respectfully traverses and requests a reversal of each rejection based thereon since a detailed explanation has not been provided demonstrating that the “missing descriptive material is necessarily present, not merely probably or possibly present”, in any prior art reference cited to supporting such rejection.

d) Allegedly “Disclosed Prior Art”

The Final Office Action asserts, “applicant’s specification, pp. 1-2” is “Disclosed Prior Art”. Applicant respectfully traverses this assertion.

Although Applicant has submitted multiple Information Disclosure Statements that potentially list “prior art”, Applicant does **not** admit that pages 1-2 of Applicant’s specification describe “prior art”, nor has any evidence been presented that any aspect of pages 1-2 of Applicant’s specification can be used as prior art. Thus, no statement on pages 1-2 of Applicant’s specification can serve as a proper basis for claim rejections under 35 U.S.C. 103(a) and the attempt to do so in the Final Office Action is improper and should be withdrawn.

The Final Office Action alleges, at Page 28:

In response to the applicant's argument that the specification does not constitute Disclosed Prior Art, the MPEP states that when “the specification's background

of the invention describes information as being known or conventional, [it] may be considered as an admission of prior art.” MPEP § 704.11 (a). To that end, the background does utilize terminology that indicates the disclosed information is known or conventional through the use of language such as “commonly”, “frequently”, “conventionally” and/or “traditionally.” Therefore, examiner asserts that information contained within the specification under the title “Background of the Invention” is an admission of prior art and, therefore, Disclosed Prior Art.

With all due respect, the Federal Circuit has held that “[o]ne's own work may **not** be considered prior art in the absence of a statutory basis”. The MPEP is not a statute, nor does it have sufficient legal authority to overcome a Federal Circuit holding. Applicant respectfully submits that the Final Office Action provides no statutory basis for the use of Applicant's disclosure as prior art.

e) Missing *Claim* Limitations

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d).

For example, claim 139 states, *inter alia*, “analyzing risk management information created from, and in the context of, the financial information”. The omnibus rejection of claim groups by the references relied upon in the Office Action makes no mention of “analyzing risk management information created from, and in the context of, the financial information”, and fails to point out where, in any of the references, that limitation is disclosed.

In addition, claim 139 states, *inter alia*, “facilitating implementation of a decision of the agent that is based on the analysis”. The omnibus rejection of claim groups by the references relied upon in the Office Action makes no mention of “facilitating implementation of a decision of the agent that is based on the analysis”, and fails to point out where, in any of the references, that limitation is disclosed.

Moreover, claim 139 states, *inter alia*, “enabling the client to monitor through a network activities of the agent”. The omnibus rejection of claim groups by the references relied upon in

the Office Action makes no mention of “enabling the client to monitor through a network activities of the agent”, and fails to point out where, in any of the references, that limitation is disclosed.

Claim 139 recites *inter alia*, yet the combined applied portions of McMenamin, Heath, and Stein do not teach or suggest, expressly or inherently, a “computer-assisted method for an agent to provide financial risk management functions to each of a plurality of institutional or corporate clients”.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, still do not expressly or inherently teach or suggest every limitation of the claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reversal of these rejections is respectfully requested.

f) No Motivation or Suggestion to Combine the Applied References

Instead, regarding selected proffered combinations, the Final Office Action improperly states that “McMenamin discloses a method for providing financial functions (financial management)”. This is a mischaracterization of McMenamin and the claimed subject matter. At most, the cited portions of McMenamin allegedly provide an “introduction” to “financial management”. The cited portions of McMenamin do not teach or disclose any “computer-assisted methods” for providing “financial risk management functions” by “an agent”, and Applicant respectfully submits that Office Action presents no reasons, and certainly no “concrete evidence” that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from McMenamin.

The Final Office Action asserts, at Page 4:

McMenamin does not teach that providing financial functions comprising said steps is automated. However, it would have been obvious to one of ordinary skill

in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Applicant respectfully points out that *In re Venner* was decided in 1958. As such, *In re Venner* did not apply the *Graham* test, *see supra*, regarding obviousness. As a result, Applicant respectfully submits that no evidence is presented that the proposition for which *In re Venner* is cited is still valid law. Applicant respectfully notes that the Federal Circuit has failed to cite *In re Venner* in any case whatsoever. Moreover, even if *In re Venner* were still valid for the point of law for which it is presented, no *prima facie* case is presented that the claimed subject matter of the present application is disclosed in any of the applied portions of the relied upon references as a “manual activity that accomplishes the same result.”

Moreover, Applicant respectfully submits that Office Action presents no reasons that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from Heath. Instead, it seems quite likely that one of skill in the art would instantly reject Heath as completely irrelevant, since Heath is a reference allegedly directed to the “public policy challenges” facing “organizations”, rather than “financial risk management functions”. Heath explains that “the heart of issues management ‘is reconciliation of conflicting internal interests on public policy issues of strategic importance in order to make a coherent external advocacy’”. Applicant respectfully asks how the “reconciliation of conflicting internal interests on public policy issues” relates in the least to the claimed subject matter? Applicant also respectfully asks where is the concrete evidence that Heath is “within the field of the inventor's endeavor”, and if not, “is reasonably pertinent to the **particular problem** with which the inventor was involved”?

Similarly, Applicant respectfully submits that Office Action presents no reasons, and certainly no “concrete evidence”, that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” anything from Stein.

Furthermore, even assuming, *arguendo*, that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select” McMenamin, Heath, and Stein, the Office Action presents no concrete evidence of a suggestion,

motivation, or teaching **in the prior art** that would have led a person of ordinary skill in the art to combine these references in the manner claimed.

In addition, Applicant respectfully notes that the Final Office Action impermissibly relies on Applicant's disclosure on Page 5 in rejecting claim 139. As noted, *supra*, Applicant does not admit that any of contents of the present Application is prior art. Accordingly, Applicant respectfully traverses the impermissible use of "p. 2, lines 4-9) of the present Application as prior art by the Final Office Action.

The Final Office Action asserts at Pages 30 and 31:

In response to applicant's argument that there is no suggestion to combine the references, the Courts have stated that "[a] suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references ... The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art ... there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (emphasis added). *In re Kahn*, 78 USPQ2d 1329, 1336 (CA FC 2006). Examiner asserts that he can and/or has provided such "articulated reasoning to support the legal conclusion of obviousness.

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absence of a “reasonable expectation of success” from making such a combination is also a pure question of fact. *Alza Corp. v. Mylan Laboratories, Inc.*, 2006 U.S. App. LEXIS 22616 (Fed. Cir. 2006) (citing *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006)).

The allegations of the Final Office Action regarding the alleged suggestions or motivations for modifying and/or combining references comprise little more than bald assertions and do not appear to be supported by even a “mere scintilla of evidence”. That is, the Final Office Action presents **no factual basis** upon which the allegations regarding suggestions or motivations to combine references are based. Applicant respectfully reiterates that a “bald assertion of knowledge generally available to one of ordinary skill in the art to bridge the evidentiary gap is improper. Such unfounded assertions are not permissible substitutes for evidence. *See In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). In other words, deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.*

For at least this reason, Applicant respectfully submits that the allegations responding to Applicant’s argument presented in the Office Action Reply dated 11 April 2006 are unsupported and fail to provide any evidentiary support regarding any suggestion or motivation to combine the applied portions of the relied upon references.

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In further contrast, Stein’s Abstract allegedly recites that:

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permits a teacher or network administrator to quickly and easily update system software on selected destination workstations with the system software currently residing on the master workstation. In one mode of operation, only basic system software is updated, while user-defined preferences are unchanged. In a second mode of operation, both the system software and all user-controlled settings are replaced, to permit the remote workstations to be configured in a desired manner.

Applicant's disclosure is not available as a reference and even if it was, doesn't overcome the deficiencies of the applied portions of the remaining relied upon references.

The Final Office Action presents no evidence that one having ordinary skill in the art would have had any expectation of success, let alone a reasonable expectation of success, in combining the applied portions of the relied upon references. At most, the applied portions of the relied upon references provide "only general guidance as to the particular form of the claimed invention or how to achieve it."

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined by the Office Action, expressly or inherently teach or suggest every limitation of claim 1 (another assumption that is respectfully traversed), there is still no evidence indicating a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action, and consequently, the Office Action fails to establish a *prima facie* case of obviousness.

h) Improper Reliance on *In re Venner*

The Final Office Action recites, at Pages 33-34:

Now to the argued claim limitations specifically, a known manual financial decision-making methodology was disclosed by McMenamin. Such prior art reference was modified through automation via *In re Venner*, to capture the benefits natural to such automation - speed, uniformity and/or reliability. Automation would have constituted the use of a computer to make such automation possible, an argument buttressed by the use of a computer network,

as disclosed by Stein. The outsourcing of this financial function, either the outsourcing of the manual or the computerized process, would have been obvious in light of Disclosed Prior Art. Finally, a supervision system that allowed management to oversee their agents and/or employees at their individual workstations, is disclosed by Stein, serving to monitor and provide transparency concerning the actions of the agents.

Applicant again traverses the continued use of *In re Venner* in the rejection of any of the claimed subject matter of the present Application. Applicant reiterates that, as a case decided in 1958, *In re Venner* fails to properly consider the Graham factors regarding obviousness. As such it is no longer binding precedent and has at least been superseded by *Graham*.

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A proper Office Action must be complete as to all matters, must provide a clear explanation of all actions taken, and **must answer in detail** the substance of each of Applicant's submitted arguments (emphasis added). *See* MPEP 707.07(f).

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Stein allegedly recites, at the Abstract:

A supervisory control system for a networked multimedia computing system permits a teacher or network administrator to quickly and easily update system software on selected destination workstations with the system software currently residing on the master workstation. In one mode of operation, only basic system software is updated, while user-defined preferences are unchanged. In a second mode of operation, both the system software and all user-controlled settings are replaced, to permit the remote workstations to be configured in a desired manner.

No argument is advanced in either Office Action as to why one skilled in the art would select a reference directed to updating “basic system software” and “system software and all user-controlled settings” in a method relating to financial risk management.

Since the Final Office Action is silent regarding the argument regarding Stein, Applicant submits that the Final Office Action concedes that “the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention” would not select anything from Stein.

j) Conclusion

For at least the reasons mentioned above, a reversal of the rejection of claim 139 is respectfully requested.

VIII. CLAIMS APPENDIX

Appendix A sets forth all pending claims in the state in which they were appealed.

IX. EVIDENCE APPENDIX

Appendix B sets forth copies of any evidence submitted pursuant to 37 C.F.R. § 1.130, 37 C.F.R. § 1.131, or 37 C.F.R. § 1.132 or of any other evidence entered by the examiner and relied upon by appellant in this appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner.

X. RELATED PROCEEDINGS APPENDIX

Appendix C sets forth copies of decisions rendered by a court or the Board in any proceeding identified pursuant to 37 C.F.R. § 41.37(c)(1)(ii).

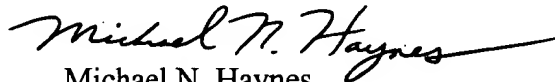
SUMMARY

In view of the above, Applicant submits that all claims on appeal are patentable over the cited art and respectfully requests that the Board of Patent Appeals and Interferences reverse the rejections of claims 1-139 and direct that the application be passed to issue.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



Michael N. Haynes
Registration No. 40,014

Date: 13 October 2006

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PATENT

Serial No. 09/650,733

Attorney Docket No. 1011-002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Alejandro M. Pilato
Application # : 09/650,733
Confirmation # : 2432
Filed : 30 August 2000
Application Title : METHOD AND SYSTEM FOR PROVIDING FINANCIAL
FUNCTIONS
Art Unit # : 3628
Latest Examiner : Borlinghaus, Jason M.

Mail Stop Appeal Brief-Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

APPENDIX A

IN THE CLAIMS:

1. A computer-assisted method for providing financial risk management functions by an agent for each of a plurality of institutional or corporate clients, comprising the activities of:

relating to a financial risk management function of each client:

demonstrating that more than one activity of the agent is transparent to the client;

receiving financial information at a computer of the agent;

creating risk management information relating to the financial information;

analyzing the risk management information in the context of the financial information;

determining an action based on the analysis;

facilitating implementation of the action on behalf of the client; and

communicating with the client through a network one or more activities of the

agent.

2. The method of claim 1, wherein the financial information is received through a network.
3. The method of claim 1, wherein said activity of facilitating the action includes implementing the action on behalf of the client.
4. The method of claim 1, wherein said activity of facilitating the action includes instructing the client to implement the action.
5. The method of claim 1, wherein said activity of facilitating the action includes recommending that the client implement the action.
6. The method of claim 1, further comprising notifying the client that an action will be implemented by the agent.
7. The method of claim 1, further comprising notifying the client of the action implemented by the agent.
8. The method of claim 1, further comprising receiving notification from the client of an action implemented by the client.
9. The method of claim 1, wherein the action includes providing a notification.
10. The method of claim 1, wherein the action includes providing a report.
11. The method of claim 1, wherein the action includes providing an analysis.
12. The method of claim 1, wherein the action includes providing information.

13. The method of claim 1, wherein said activity of communicating includes enabling the client to access information regarding one or more activities of the agent.
14. The method of claim 1, wherein said activity of communicating includes enabling the client to access information across a network regarding one or more activities of the agent.
15. The method of claim 1, wherein said activity of communicating includes allowing the client to monitor across a network one or more activities of the agent.
16. The method of claim 1, wherein said activity of communicating includes allowing the client to monitor in real-time across a network one or more activities of the agent.
17. The method of claim 1, wherein said activity of communicating includes allowing the client to monitor in near-real-time across a network one or more activities of the agent.
18. The method of claim 1, wherein said activity of communicating includes reporting to the client across a network one or more activities of the agent.
19. The method of claim 1, wherein said activity of communicating includes reporting to the client in real-time across a network one or more activities of the agent.
20. The method of claim 1, wherein said activity of communicating includes reporting to the client in near-real-time across a network one or more activities of the agent.
21. The method of claim 1, further comprising reporting one or more effects of the agent's action on the risk management information.
22. The method of claim 1, further comprising reporting one or more effects of an alternative

action to the agent's action on the risk management information.

23. The method of claim 1, further comprising reporting one or more reasons behind an action determined by the agent.
24. The method of claim 1, wherein said activity of communicating includes providing an audit log of one or more historical activities of the agent on behalf of the client.
25. The method of claim 1, wherein said activity of communicating includes informing the client of results of reviews of one or more of historical activities of the agent.
26. The method of claim 1, wherein said activity of communicating includes seeking feedback from the client on reviews of one or more of historical activities of the agent.
27. The method of claim 1, wherein the agent is conflict-free.
28. The method of claim 1, further comprising the agent receiving authority to implement the action on behalf of the client.
29. The method of claim 1, further comprising the client agreeing to implement actions recommended by the agent.
30. The method of claim 1, further comprising the client agreeing to implement actions instructed by the agent.
31. The method of claim 1, wherein facilitating the implementation of the action results in the negotiation of the terms of a trade.
32. The method of claim 1, wherein the determination of the action includes an identification of a

best rate or price at which the trade can be executed.

- 33. The method of claim 1, wherein said activity of determining the action is performed automatically.
- 34. The method of claim 1, wherein the implementation of the action results in execution of a trade.
- 35. The method of claim 1, wherein the implementation of the action results in execution of a trade with a third party.
- 36. The method of claim 1, wherein the implementation of the action results in execution of a trade by the agent.
- 37. The method of claim 1, wherein the implementation of the action results in execution of a trade by the client.
- 38. The method of claim 1, wherein the action is implemented automatically.
- 39. The method of claim 1, wherein the financial information includes financial guidelines.
- 40. The method of claim 1, wherein the financial information includes one or more benchmarks.
- 41. The method of claim 1, wherein the financial information includes action guidelines.
- 42. The method of claim 1, wherein the financial information includes market risk limits.
- 43. The method of claim 1, wherein the financial information includes credit risk limits.

- 44. The method of claim 1, wherein the financial information includes liquidity guidelines.
- 45. The method of claim 1, wherein the financial information includes maturity guidelines.
- 46. The method of claim 1, wherein the financial information includes credit guidelines.
- 47. The method of claim 1, wherein the financial risk management function includes short-term funding and cash management.
- 48. The method of claim 1, wherein the financial risk management function includes cashflow management.
- 49. The method of claim 1, wherein the financial risk management function includes liquidity management.
- 50. The method of claim 1, wherein the financial risk management function includes cash management.
- 51. The method of claim 1, wherein the financial risk management function includes investment management.
- 52. The method of claim 1, wherein the financial risk management function includes repo (repurchase agreement) funding.
- 53. The method of claim 1, wherein the financial risk management function includes debt management.
- 54. The method of claim 1, wherein the financial risk management function includes debt issuance.

- 55. The method of claim 1, wherein the financial risk management function includes asset and liability management.
- 56. The method of claim 1, wherein the financial risk management function includes asset and liability management and wherein the assets include insurance premia.
- 57. The method of claim 1, wherein the financial risk management function includes asset and liability management and wherein the liabilities include insurance claims.
- 58. The method of claim 1, wherein the financial risk management function includes asset and liability management and wherein the assets include life insurance premia.
- 59. The method of claim 1, wherein the financial risk management function includes asset and liability management and wherein the liabilities include life insurance claims.
- 60. The method of claim 1, wherein the financial risk management function includes asset and liability management and wherein the liabilities include pension claims.
- 61. The method of claim 1, wherein the financial risk management function includes asset and liability management and wherein the liabilities include legal claims.
- 62. The method of claim 1, wherein the financial risk management function includes asset and liability management wherein the assets include leases.
- 63. The method of claim 1, wherein the financial risk management function includes asset and liability management wherein the liabilities include leases.
- 64. The method of claim 1, wherein the financial risk management function includes asset and

liability management wherein the assets include operational cashflows.

65. the method of claim 1, wherein the financial risk management function includes asset and liability management wherein the liabilities include operational cashflows.

66. The method of claim 1, wherein the financial risk management function includes treasury management.

67. The method of claim 1, wherein the financial risk management function includes credit management.

68. The method of claim 1, wherein the financial risk management function includes credit spread trading.

69. The method of claim 1, wherein the financial risk management function includes loan portfolio management.

70. The method of claim 1, wherein the financial risk management function includes equity portfolio management.

71. The method of claim 1, wherein the financial risk management function includes fixed income portfolio management.

72. The method of claim 1, wherein the financial risk management function includes funding.

73. The method of claim 1, wherein the financial risk management function includes collateral management.

74. The method of claim 1, wherein the financial risk management function includes the lending

of securities.

- 75. The method of claim 1, wherein the financial risk management function includes the borrowing of securities.
- 76. The method of claim 1, wherein the financial risk management function includes counterparty credit exposure management.
- 77. The method of claim 1, wherein the financial risk management function includes financial risk management.
- 78. The method of claim 1, wherein the financial risk management function includes market risk management.
- 79. The method of claim 1, wherein the financial risk management function includes credit risk management.
- 80. The method of claim 1, wherein the financial risk management function includes commodity price risk management.
- 81. The method of claim 1, wherein the financial risk management function includes liquidity risk management.
- 82. The method of claim 1, wherein the financial risk management function includes operational risk management.
- 83. The method of claim 1, wherein the financial risk management function includes management of insurable risks.

- 84. The method of claim 1, wherein the financial risk management function includes electricity price risk management.
- 85. The method of claim 1, wherein the financial risk management function includes pension fund management.
- 86. The method of claim 1, wherein the financial risk management function includes real estate management.
- 87. The method of claim 1, wherein the financial risk management function includes hedging.
- 88. The method of claim 1, wherein the financial risk management function includes dynamic hedging.
- 89. The method of claim 1, wherein the financial risk management function includes mortgage pre-payment risk management.
- 90. The method of claim 1, wherein the financial risk management function includes front-office activities.
- 91. The method of claim 1, wherein the financial risk management function includes middle-office activities.
- 92. The method of claim 1, wherein the financial risk management function includes back-office activities.
- 93. The method of claim 1, wherein the financial risk management function includes front-office and middle-office activities.

- 94. The method of claim 1, wherein the financial risk management function includes middle-office and back-office activities.
- 95. The method of claim 1, wherein the financial risk management function includes front-office, middle-office and back-office activities.
- 96. The method of claim 1, wherein the financial information includes detailed information on financial instruments relevant to a financial risk management function.
- 97. The method of claim 1, wherein the financial information includes historical market data relevant to the financial risk management function.
- 98. The method of claim 1, wherein the financial information includes current market data relevant to the financial risk management function.
- 99. The method of claim 1, wherein the financial information includes economic information relevant to the financial risk management function.
- 100. The method of claim 1, wherein the financial information includes information relevant to the financial risk management function.
- 101. The method of claim 1, wherein the financial information includes strategic financial objectives.
- 102. The method of claim 1, wherein the client includes departments of the client.
- 103. The method of claim 1, wherein the client includes subsidiaries of the client.
- 104. The method of claim 1, wherein the client includes affiliates of the client.

105. The method of claim 1, wherein the client includes clients of the client.
106. The method of claim 1, wherein the client includes regulators of the client.
107. The method of claim 1, wherein the client includes auditors of the client.
108. The method of claim 1, wherein the client includes agents of the client.
109. The method of claim 1, wherein the client includes advisors of the client.
110. The method of claim 1, wherein the client includes counterparties of the client.
111. The method of claim 1, wherein the client includes shareholders of the client.
112. A computer-readable medium storing instructions that, when executed by one or more processors, cause the one or more processors to perform activities comprising:
 - relating to a financial risk management function of each of a plurality of institutional or corporate clients:
 - demonstrating that more than one activity of the agent is transparent to the client;
 - receiving financial information at the agent;
 - creating risk management information relating to the financial information;
 - analyzing the risk management information in the context of the financial information;
 - determining an action based on the analysis;
 - facilitating implementation of the action on behalf of the client; and
 - communicating through a network with the client one or more activities of

the agent.

113. An apparatus for providing financial risk management functions by an agent for each of a plurality of institutional or corporate clients, comprising:

relating to a financial function of each client:

means for demonstrating that more than one activity of the agent is transparent to the client;

means for receiving financial information at a computer of the agent;

means for creating risk management information relating to the financial information;

means for analyzing the risk management information in the context of the financial information;

means for determining an action based on the analysis;

means for facilitating implementation of the action on behalf of the client; and

means for communicating to the client through a network one or more activities of the agent.

114. A computer-assisted method for a client to outsource financial risk management functions to an agent representing a plurality of institutional or corporate clients, comprising the activities of:

providing financial information on one or more financial risk management functions of each client to a computer of the agent;

enabling the agent to determine an action based on an analysis of risk management information created from the financial information; and

allowing the agent to facilitate the implementation of the action.

115. The method of claim 114, further comprising receiving risk management information generated by the agent at the client.

- 116. The method of claim 114, further comprising receiving the agent's analysis at the client.
- 117. The method of claim 114, further comprising receiving an action instruction at the client.
- 118. The method of claim 114, further comprising receiving an action recommendation at the client.
- 119. The method of claim 114, further comprising receiving a notification at the client of an action that will be implemented by the agent.
- 120. The method of claim 114, further comprising receiving a notification at the client of an implemented action.
- 121. The method of claim 114, further comprising accessing information across a network on one or more of the agent's activities.
- 122. The method of claim 114, further comprising monitoring across a network one or more of the agent's activities.
- 123. The method of claim 114, further comprising silently monitoring across a network one or more of the agent's activities.
- 124. The method of claim 114, further comprising requesting notification of an effect of one or more actions of the agent on the risk management analysis.
- 125. The method of claim 114, further comprising requesting notification of the effect of one or more alternative actions of the agent on the risk management information.
- 126. The method of claim 114, further comprising requesting information on one or more

reasons behind an action determined by the agent.

127. The method of claim 114, further comprising requesting an audit log of one or more of historical activities of the agent on behalf of the client.
128. The method of claim 114, further comprising requesting a review of one or more of historical activities of the agent.
129. The method of claim 114, further comprising providing financial information to the agent.
130. The method of claim 114, providing new financial information to the agent based on a review of one or more of historical activities of the agent.
131. The method of claim 114, further comprising removing the agent's authority to undertake any action on behalf of the client.
132. The method of claim 114, further comprising removing the authority of the agent in connection with one or more actions.
133. The method of claim 114, further comprising requesting the agent to halt one or more actions.
134. The method of claim 114, further comprising requesting, through a network, the agent to halt one or more actions.
135. The method of claim 114, wherein the financial information is provided through a network.

136. A computer-readable medium storing instructions that, when executed by one or more processors, cause the one or more processors to perform activities comprising:
- providing financial information on one or more financial risk management functions of an institutional or corporate client to an agent;
 - enabling the agent to determine an action based on an analysis of risk management information created from the financial information; and
 - allowing the agent to facilitate the implementation of the action.
137. An apparatus for a client to outsource financial risk management functions to an agent representing a plurality of institutional or corporate clients, comprising:
- means for providing financial information on one or more financial risk management functions of a client to a computer of an agent;
 - means for enabling the agent to determine an action based on an analysis of risk management information created from the financial information; and
 - means for allowing the agent to facilitate the implementation of the action.
138. A computer-assisted method for an agent to provide financial risk management functions to each of a plurality of institutional or corporate clients, comprising the activities of:
- regarding a financial risk management function of a client from the plurality of clients:
 - demonstrating to the client the potential transparency of activities of the agent;
 - receiving financial information at a computer of the agent;
 - analyzing risk management information created from, and in the context of, the financial information; and
 - facilitating implementation, on behalf of the client, of an agent's action based on the analysis.
139. A computer-assisted method for an agent to provide financial risk management functions

to each of a plurality of institutional or corporate clients, comprising the activities of:

- regarding a financial risk management function of each client from the plurality of clients:
 - receiving financial information at a computer of the agent;
 - analyzing risk management information created from, and in the context of, the financial information;
 - facilitating implementation of a decision of the agent that is based on the analysis; and
 - enabling the client to monitor through a network activities of the agent.



PATENT

Serial No. 09/650,733

Attorney Docket No. 1011-002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Alejandro M. Pilato
Application # : 09/650,733
Confirmation # : 2432
Filed : 30 August 2000
Application Title : METHOD AND SYSTEM FOR PROVIDING FINANCIAL
FUNCTIONS
Art Unit # : 3628
Latest Examiner : Borlinghaus, Jason M.

Mail Stop Appeal Brief-Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

APPENDIX B

Appendix B contains the Declaration of Dr. William W. Sihler, which was submitted pursuant to 37 CFR 1.132 on 7 July 2004, was stamped as received by the OIPE on 7 July 2004, is presented and listed under 7 July 2004 and 28 October 2004 as part of the Image File Wrapper in the USPTO's electronic Patent Application Information Retrieval (PAIR) system, which states that "[t]his application is **officially maintained** in electronic form", and was considered by the examiner in at least the Advisory Action dated 24 August 2004 (see item 5).



PATENT

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Commissioner for Patents

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APPENDIX C

There are no decisions in any related proceedings.



10-16-06

AF/IFW
AA

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Effective on 12/08/2004.

Paid pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL

For FY 2005

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) **250.00**

Complete if Known

Application Number	09/650,733
Filing Date	30 August 2000
First Named Inventor	Pilato, Alejandro M.
Examiner Name	Borlinghaus, Jason M.
Art Unit	3628
Attorney Docket No.	1011-002

METHOD OF PAYMENT (check all that apply)

☐ Check ☒ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☒ Deposit Account Deposit Account Number: 50-2504 Deposit Account Name: Michael N. Haynes

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	0
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims	Fee (\$)	Fee Paid (\$)
- 20 or HP = 0	x 25	= 0				
HP = highest number of total claims paid for, if greater than 20						
Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)			
- 3 or HP = 0	x 100	= 0				
HP = highest number of independent claims paid for, if greater than 3						

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/ 50 = 0	(round up to a whole number) x	125	0

4. OTHER FEE(S)

	Fees Paid (\$)
Non-English Specification, \$130 fee (no small entity discount)	0
Other: Filing a Brief in Support of an Appeal	250

SUBMITTED BY		
Signature	<i>Michael N. Haynes</i>	Registration No. 40,014 (Attorney/Agent)
Name (Print/Type)	Michael N. Haynes	Telephone 434-972-9988
		Date 13 Oct 2006

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.